

ESTTA Tracking number: **ESTTA122642**

Filing date: **01/31/2007**

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

Proceeding	91173189
Party	Plaintiff MONSTERCOMMERCE, LLC MONSTERCOMMERCE, LLC 10715 Norton Lane , IL 62286
Correspondence Address	Brian J. Winterfeldt Ballard Spahr Andrews & Ingersoll, LLP 601 13th Street, N.W. Washington, DC 20005-3807 UNITED STATES
Submission	Other Motions/Papers
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Signature	/Hara K. Jacobs/
Date	01/31/2007
Attachments	Motion for Judgment on Pleadings.pdf (36 pages)(675715 bytes)

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

In the matter of Application Serial No. 78/612,360
Published in the *Official Gazette* on May 30, 2006

TEMPLATEMONSTER

MONSTERCOMMERCE, LLC,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91173189
)	
IGOR LOGNIKO,)	
)	
Applicant.)	
_____)	

OPPOSER’S MOTION FOR PARTIAL JUDGMENT ON THE PLEADINGS

Opposer, MonsterCommerce LLC (“MonsterCommerce” or “Opposer”), hereby moves for partial judgment on the pleadings seeking to dismiss the affirmative defenses of laches, equitable estoppel and legal estoppel asserted by Applicant Igor Logniko (“Applicant”).

PRELIMINARY STATEMENT

Applicant’s affirmative defenses of laches and equitable estoppel, which require a showing of inexcusable delay in asserting rights against the registration of a mark, cannot be raised in this proceeding because Opposer promptly opposed the instant application. Further, Applicant’s affirmative defense of legal estoppel should be dismissed because it is a patent doctrine concerning the right to use a patent and has no applicability to a trademark opposition proceeding in which the sole issue is the right to register a trademark.

FACTUAL BACKGROUND

Applicant is seeking to register the mark TEMPLATEMONSTER for software for developing websites using pre-formatted templates and for website design services. (Amended Notice of Opposition at ¶ 6, Exh. A; Applicant's Answer and Affirmative Defenses to Amended Notice of Opposition ("Answer") at ¶ 6, Exh. B.) Applicant's claimed date of first use is April 15, 2002. (TARR Record for TEMPLATEMONSTER, Exh. C.)

Opposer is the owner of a federal registration for the mark MONSTERCOMMERCE for, *inter alia*, software enabling users to build an e-commerce website. (Amended Notice of Opposition at ¶ 2, Exh. A.) Opposer's date of first use is at least as early as October 2001, six months prior to Applicant's claimed date of first use. (Exhibit A to Amended Notice of Opposition, Exh. A hereto.) Opposer is also the owner of a family of MONSTER marks for its e-commerce services, including e-commerce design software and systems, website design, promotion and hosting, merchant accounts, and domain name services. (Amended Notice of Opposition at ¶ 2, Exh. A.) MonsterCommerce has opposed Applicant's service mark application for TEMPLATEMONSTER on the ground that it is likely to cause confusion with Opposer's federally registered MONSTERCOMMERCE mark and Opposer's family of MONSTER marks. (*Id.* at ¶ 7.)

The application for TEMPLATEMONSTER was published for opposition on May 30, 2006. (Amended Notice of Opposition at ¶ 6, Exh. A.) Opposer timely filed its Notice of Opposition on September 27, 2006, after receiving a ninety-day extension of time from the Trademark Trial and Appeal Board. (TTAB Order dated December 13, 2006 at p. 1, Exh. D.) Opposer subsequently filed an Amended Notice of Opposition, which is the operative pleading in this matter. (*Id.* at p. 10.) Applicant filed its Answer to the Amended Notice of Opposition on

December 20, 2006. (Answer, Exh. B.) In its Answer, Applicant sets forth five “affirmative defenses,” including “laches,” “equitable estoppel” and “legal estoppel.” (Id. at p. 2, Exh. B.)

ARGUMENT

A motion for judgment on the pleadings will be granted where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved and the moving party is entitled to judgment as a matter of law. TBMP § 504.02. Opposer’s motion for judgment on the pleadings seeking to dismiss the affirmative defenses of laches and equitable estoppel should be granted because there is no basis for these defenses where, as here, Opposer promptly opposed the registration of Applicant’s mark. See Callaway Vineyard & Winery v. Endsley Capital Group, Inc., 63 U.S.P.Q.2d 1919, 1923 (TTAB 2002). Applicant’s affirmative defense of “legal estoppel” should likewise be dismissed because it is a patent concept used to imply a license and has no applicability in the trademark registration context.

I. APPLICANT’S DEFENSES OF LACHES AND EQUITABLE ESTOPPEL FAIL AS A MATTER OF LAW

The defense of laches requires a showing of inexcusable delay in asserting rights against the registration of a mark and prejudice resulting therefrom. National Cable Television Assn, Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 19 U.S.P.Q.2d 1424, 1431 (Fed. Cir. 1991). Equitable estoppel requires proof of: (1) misleading conduct leading another to reasonably infer that rights will not be asserted; (2) reliance upon this conduct; and (3) due to this reliance, material prejudice if the delayed assertion of such rights is permitted. Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc., 971 F.2d 732, 734 (Fed. Cir. 1992). “As applied in trademark opposition or cancellation proceedings, these defenses must be tied to a party’s registration of mark, not to a party’s use of the mark.” Id. (emphasis in original). Thus, the defenses of laches and equitable estoppel do not start running until the date the application was

published for opposition. National Cable, 19 U.S.P.Q.2d at 1432; Callaway Vineyard, 63 U.S.P.Q.2d at 1923. Opposer's conduct between the time an applicant begins using its mark and the time the mark is published for opposition is irrelevant. See National Cable, 19 U.S.P.Q.2d at 1431-32.

Applicant's mark was published for opposition on May 30, 2006. Opposer timely filed its Notice of Opposition on September 27, 2006. "[I]nasmuch as opposer promptly opposed registration of applicant's mark, applicant has no basis for the defenses of laches, estoppel, or acquiescence." Callaway Vineyard, 63 U.S.P.Q.2d at 1923; see also Krause v. Krause Publications, Inc., 76 U.S.P.Q.2d 1904, 1914 (TTAB 2005) (dismissing affirmative defense of estoppel because Petitioner's six-month delay in filing its Petition to Cancel "cannot be viewed as unreasonably delay"). The same principle holds true here. Applicant has no basis to assert the defenses of laches and equitable estoppel because Opposer promptly opposed the application to register the mark TEMPLATEMONSTER. Accordingly, the affirmative defenses of laches and equitable estoppel should be dismissed.

II. THE DEFENSE OF "LEGAL ESTOPPEL" DOES NOT EXIST IN A TRADEMARK OPPOSITION PROCEEDING

"Legal estoppel" is a seldom invoked equitable doctrine in the patent context used to imply a license to use a patent where a patentee licenses a right, receives consideration, and seeks to derogate from that right. Rachel Clark Hughey, Implied Licenses by Legal Estoppel, 14 Alb. L.J. Sci. & Tech. 53, 57 (2003); see, e.g., Spindelfabrik Suessen-Schurr Stahlecker & Grill GmbH et al. v. Schubert & Salzer Maschinenfabrik Aktiengesellschaft, 829 F.2d 1075, 1080 (Fed. Cir. 1987). This doctrine is manifestly inapposite in proceedings before the Trademark Trial and Appeal Board because the sole issue to be decided in an opposition proceeding is the

right to register a mark, not the right to use a mark.¹ See National Cable, 19 U.S.P.Q.2d at 1432 (stating that the objection in an opposition or cancellation proceeding is to the rights which flow from registration of the mark and not to use of the mark, which is legally distinct). Simply put, Applicant cannot claim a right to register the TEMPLATEMONSTER mark based on an equitable doctrine that, at most, merely implies a license to use intellectual property. Accordingly, Applicant's affirmative defense of legal estoppel should be dismissed.

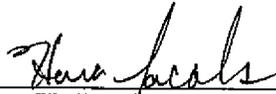
CONCLUSION

For all the foregoing reasons, Opposer respectfully requests that the Board grant its motion for partial judgment on the pleadings and dismiss Applicant's affirmative defenses of laches, equitable estoppel, and legal estoppel. Additionally, Opposer requests that the Board suspend the proceedings pending the disposition of Opposer's Motion to Amend.

Respectfully submitted,

Date: January 31, 2007

By: _____


Hara K. Jacobs
Brian J. Winterfeldt
Tricia McDermott Thompkins
BALLARD SPAHR ANDREWS & INGERSOLL, LLP
601 13th Street, NW, Suite 1000 South
Washington, D.C. 20005
(202) 661-2200

ATTORNEYS FOR OPPOSER

¹ Opposer is not aware of a single case decided by the Trademark Trial and Appeal Board applying the doctrine of legal estoppel in an opposition proceeding.

EXHIBIT A

Pursuant to 15 U.S.C. §§ 1052, 1063, and 1125 of the Lanham Act and 37 C.F.R. §§ 2.101 and 2.104, and predicated upon the following grounds, Opposer alleges as follows:

1. Opposer, MonsterCommerce, LLC, is a limited liability company duly organized and existing under the laws of California, having its principal place of business at One BronzePoint, Belleville, Illinois 62226.

2. Opposer is the owner of the MONSTERCOMMERCE mark, the subject of a federal registration, Registration No. 2,947,268 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, in International Class 42.

A copy of the registration is attached as **Exhibit A**.¹

Opposer is also the owner of a family of MONSTER marks, including MONSTERLOCAL (U.S. Application Serial No. 76/658,138), MONSTER MARKETPLACE, MONSTER, MONSTER WEB PROMOTION, MONSTER WEB DESIGN, MONSTER DOMAIN REGISTRATION, MONSTERSMALLBUSINESS, MONSTER SELLERS, the MONSTER logo, and the MONSTER EYE logo (the "MONSTER Family of Marks").

3. As a wholly owned subsidiary, Opposer is in privity Network Solutions, LLC, which timely filed the extension of time to oppose ("EOT") the registration of the subject application. *See*, Declaration of Bobby N. Turnage, Jr., Senior Vice President and General Counsel of Network Solutions, LLC, attached as **Exhibit B**.

¹ Note that the registration certificate mistakenly issued in the name of a non-existent entity, MonsterCommerce, Inc. A copy of the declaration attesting to the misidentification as defined by Rule 2.102(b) is also attached to **Exhibit A**.

4. Opposer offers, *inter alia*, a broad range of online services, including providing use of e-commerce storefront software and systems, website design, promotion and hosting, merchant accounts, and domain name registration services.

Its on-line services include, but are not limited to, 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.

The Opposer, having been established in 1998, is a single-source e-commerce provider offering e-business clients the components needed to sell successfully online: e-commerce store building tools, design services, merchant accounts, and web site promotion services. The Opposer, therefore, is one of the leading providers of storefront and e-commerce solutions for on-line businesses.

4. Opposer is the owner of a federal registration for the MONSTERCOMMERCE mark and began promoting its services under the MONSTER Family of Marks as early as October 2001. Therefore, Opposer's first use of the MONSTER Family of Marks pre-dates Applicant's first use of the TEMPLATEMONSTER Mark, inasmuch as Applicant asserts dates of first use of April 15, 2002.

5. Since its initial adoption and use of the MONSTER Family of Marks, Opposer has made a substantial investment in advertising and marketing its services under the mark. Opposer has extensively used, advertised, promoted and offered for sale

Opposer's services under the MONSTER Family of Marks through various channels of trade and commerce. As a result of Opposer's extensive use and promotion of the MONSTER Family of Marks and the extensive sales of services under the MONSTER Family of Marks, the Opposer has established valuable good will in the marks.

6. On information and belief, on April 19, 2005, Applicant filed Application Serial No. 78/612,360 for the mark TEMPLATEMONSTER pursuant to Lanham Act Section 1(a) for the following services:

Online retail services featuring downloadable software for website development comprising pre-formatted modifiable templates., in International Class 35.

Website development services, namely, providing website design services for others., in International Class 42.

The application was published for opposition in the *Official Gazette* on May 30, 2006.

7. Applicant's mark so closely resembles the MONSTER Family of Marks that Applicant's mark, when used in connection with the services set forth in Applicant's application, it is likely to cause confusion, or to cause mistake, or to deceive purchasers and potential purchasers of Applicant's services into erroneously believing that there is some relationship between Opposer and Applicant, or that Opposer has authorized, sponsored or licensed Applicant's use of the mark TEMPLATEMONSTER, in violation of 15 U.S.C. § 1052(d).

8. Applicant's mark, when used in association with the services identified in Applicant's application, is likely to cause dilution of Opposer's MONSTER Family of Marks in violation of 15 U.S.C. § 1125(c).

9. Registration of Applicant's mark will damage Opposer, as such registration will give color of exclusive statutory rights to the mark

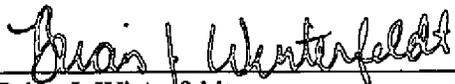
TEMPLATEMONSTER to Applicant in derogation and violation of the prior and superior rights of Opposer.

WHEREFORE, Opposer, MonsterCommerce, LLC, believes that it will be damaged by registration of U.S. Application Serial No. 78/612,360, and therefore respectfully requests that the Trademark Trial and Appeals Board sustain this opposition and refuse registration of Applicant's mark.

All correspondence should be addressed to Brian J. Winterfeldt, Esq., c/o Ballard Spahr Andrews & Ingersoll, LLP, 601 13th Street, NW, Suite 1000, Washington, DC 20005.

Respectfully submitted,

MONSTERCOMMERCE, LLC

By: 

Brian J. Winterfeldt
Tricia McDermott Thompkins
Ballard Spahr Andrews & Ingersoll, LLP
601 13th Street, NW,
Suite 1000 South
Washington, DC 20005

(202) 661-7650 Telephone
(202) 626-9065 Fax

Attorneys for MONSTERCOMMERCE, LLC

Dated: November 6, 2006

EXHIBIT A



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Typed Drawing

Word Mark MONSTERCOMMERCE
Goods and Services IC 042. US 100 101. G & S: 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. FIRST USE: 20011005. FIRST USE IN COMMERCE: 20011005
Mark Drawing Code (1) TYPED DRAWING
Design Search Code
Serial Number 76445524
Filing Date August 29, 2002
Current Filing Basis 1A
Original Filing Basis 1A
Published for Opposition March 25, 2003
Registration Number 2947268
Registration Date May 10, 2005
Owner (REGISTRANT) MONSTERCOMMERCE, INC. CORPORATION CALIFORNIA 10715 Norton Lane Sparta ILLINOIS 62286
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record H. JAY SPIEGEL
Type of Mark SERVICE MARK
Register PRINCIPAL

**Live/Dead
Indicator** LIVE

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EXHIBIT B

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

MONSTERCOMMERCE, LLC

Opposer,

v.

IGOR LOGNIKOV

Applicant.

Opposition No. 91173189

Commissioner for Trademarks
Box: TTAB
P. O. Box 1451
Alexandria, VA 22313-1451

DECLARATION

The undersigned, Bobby N. Turnage, Jr., Senior Vice President and General Counsel of Network Solutions, LLC, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, declares that he is properly authorized to execute this declaration on behalf of the Opposer. The undersigned further declares that Network Solutions, LLC acquired MonsterCommerce, LLC on January 4, 2005, and that Network Solutions, LLC owns and controls the assets of MonsterCommerce, LLC.

Date: November 6, 2006

By

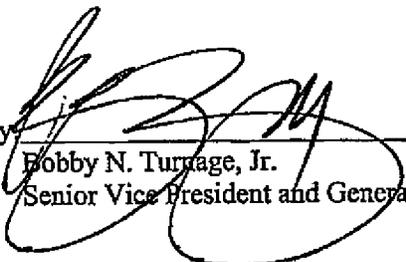

Bobby N. Turnage, Jr.
Senior Vice President and General Counsel

EXHIBIT B

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

In the matter of application Serial No. 78/612,360 **TEMPLATEMONSTER**

MONSTERCOMMERCE, LLC

Opposer,

v

Opposition No. 91173189

IGOR LOGNIKOV

Applicant.

**APPLICANT’S ANSWER AND AFFIRMATIVE DEFENSES TO AMENDED NOTICE
OF OPPOSITION**

COMES NOW, the Applicant, IGOR LOGNIKOV (“Lognikov”), by and through his undersigned counsel, who respectfully answers the Amended Notice of Opposition of Opposer, MONSTERCOMMERCE, LLC (“MC”), and states as follows:

1. Lognikov does not have sufficient information to admit or deny the allegations of MC as they relate to this paragraph, and therefore denies the same.
2. Lognikov does not have sufficient information to admit or deny the allegations of MC as they relate to this paragraph, and therefore denies the same.
3. Lognikov does not have sufficient information to admit or deny the allegations of MC as they relate to this paragraph, and therefore denies the same.
4. (First Occurrence). Lognikov does not have sufficient information to admit or deny the allegations of MC as they relate to this paragraph, and therefore denies the same.
4. (Second Occurrence). Lognikov does not have sufficient information to admit or deny the allegations of MC as they relate to this paragraph, and therefore denies the same.

5. Lognikov does not have sufficient information to admit or deny the allegations of MC as they relate to this paragraph, and therefore denies the same.
6. Admit.
7. Denied.
8. Denied as dismissed.
9. Denied.

AFFIRMATIVE DEFENSES

1. The Amended Notice of Opposition fails to state a claim upon which relief can be granted.
2. MC is barred from filing or prosecuting the Amended Notice of Opposition pursuant to the defense of laches.
3. MC is barred from filing or prosecuting the Amended Notice of Opposition pursuant to the defense of unclean hands.
4. MC is barred from filing or prosecuting the Amended Notice of Opposition pursuant to the defense of equitable estoppel.
5. MC is barred from filing or prosecuting the Amended Notice of Opposition pursuant to the defense of legal estoppel.
6. The TTAB lacks subject matter jurisdiction over the Amended Notice of Opposition.

Respectfully submitted,

s/Richard S. Ross, Esq.
RICHARD S. ROSS, ESQ.
Fla. Bar. No. 436630
Attorney for Applicant
4801 South University Drive
Suite 237
Ft. Lauderdale, Florida 33328
Tel (954) 252-9110
Fax (954) 252-9192
E mail prodp@ix.netcom.com

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing has been served by United States Postal Service first class regular mail, and addressed to counsel for the Opposer:

Brian J. Winterfeldt
Tricia McDermott Thompkins
Ballard Spahr Andrews & Ingersoll, LLP
601 13th Street, NW,
Suite 1000 South
Washington, DC 20005

this 20th day of December, 2006.

s/Richard S. Ross, Esq.
Richard S. Ross, Esq.

EXHIBIT C



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Templatemonster

Word Mark	TEMPLATEMONSTER
Goods and Services	IC 042. US 100 101. G & S: Website development services, namely, providing website design services for others. FIRST USE: 20020412. FIRST USE IN COMMERCE: 20020415
	IC 035. US 100 101 102. G & S: Online retail services featuring downloadable software for website development comprising pre-formatted modifiable templates. FIRST USE: 20020412. FIRST USE IN COMMERCE: 20020415
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Design Search Code	
Serial Number	78612360
Filing Date	April 19, 2005
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	May 30, 2006
Owner	(APPLICANT) Logniko, Igor INDIVIDUAL UKRAINE Apt. 2a, Brooklyn 7115 3rd Ave. New York NEW YORK 11209
Attorney of Record	RICHARD S. ROSS, ESQ.

Type of Mark SERVICE MARK
Register PRINCIPAL
Live/Dead
Indicator LIVE

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EXHIBIT D

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 42.¹

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

¹ 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.

Opposition No. 91173189

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.² 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

² 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).

Opposition No. 91173189

can be granted.³ 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

³ 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).

Opposition No. 91173189

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

Opposition No. 91173189

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*

Opposition No. 91173189

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.⁴ 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.⁵ 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

⁴ 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).

⁵ 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,⁶ 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

⁶ 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:	6/15/07
Plaintiff's 30-day testimony period to close:	9/13/07
Defendant's 30-day testimony period to close:	11/12/07
Plaintiff's 15-day rebuttal testimony period to close:	12/27/07

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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.

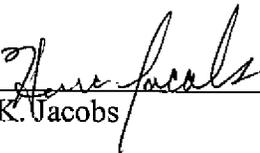
Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

CERTIFICATE OF SERVICE

I, Hara K. Jacobs, hereby certify that on today's date, I caused a copy of the foregoing Opposer's Motion for Partial Judgment on the Pleadings to be served by United States First Class mail, postage prepaid, on counsel for Applicant as set forth below:

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Dated: January 31, 2007



Hara K. Jacobs