

ESTTA Tracking number: **ESTTA128557**

Filing date: **03/07/2007**

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

Proceeding	91173189
Party	Defendant Logniko, Igor Logniko, Igor Apt. 2a, Brooklyn 7115 3rd Ave. , NY 11209
Correspondence Address	Richard S. Ross, Esq. 4801 South University Drive Suite 237 Ft. Lauderdale, FL 33328 UNITED STATES prodp@ix.netcom.com
Submission	Opposition/Response to Motion
Filer's Name	RICHARD S. ROSS, ESQ.
Filer's e-mail	prodp@ix.netcom.com
Signature	/richard ross/
Date	03/07/2007
Attachments	opp7.il.pdf ( 5 pages )(57563 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    TEMPLATEMONSTER

MONSTERCOMMERCE, LLC

Opposer,

v

Opposition No. 91173189

IGOR LOGNIKOV

Applicant.

\_\_\_\_\_ /

**APPLICANT’S RESPONSE IN OPPOSITION TO OPPOSER’S SECOND MOTION TO  
AMEND NOTICE OF OPPOSITION**<sup>1</sup>

COMES NOW, the Applicant, IGOR LOGNIKOV (“Applicant”), by and through his undersigned counsel, who respectfully responds to Opposer’s, MONSTERCOMMERCE, LLC (“Opposer”), second motion to amend its notice of opposition (“Motion”). Applicant opposes the Motion as it is prejudicial, futile and untimely.

Discretion is the basis for granting or denying a motion to amend. The Board needs to consider the relevant factors including, among others, prejudice, futility and timeliness. *See Guise v. BWM Mortgage, LLC*, 377 F.3d 795 (7<sup>th</sup> Cir. 2004); *United Association of Journeymen & Apprentices v. Georgia Power Co.*, 684 F.2d 721 (11<sup>th</sup> Cir. 1982). *See also* Motion, p. 10.

**I.     The Motion is prejudicial.**

The motion is prejudicial to Applicant because it unduly delays the issuance of the

\_\_\_\_\_

<sup>1</sup>On March 5, 2007, the Board entered an order suspending proceedings, and noted therein that “opposer’s motion for leave to file an amended notice of opposition should be fully briefed in accordance with Trademark Rule 2.127 (a).” Applicant believes that it was the intent of the Board to require Applicant to respond timely to opposer’s present **second** motion.

certificate of registration for TEMPLATEMONSTER. The Opposer has now engaged in three separate instances of delay. First, the Opposer sought and received an extension of time to oppose. Second, the Opposer filed a first motion to amend which caused an extension in the pre-trial discovery period. Now, Opposer has filed this second Motion, which has further delayed pre-trial discovery and contributed to the present suspension of proceedings.

The Opposer always has a right to seek cancellation of a registered mark, thus, the liberal application that is applicable under Fed.R.Civ.P. 15 is not as pressing in this type of Board proceeding. In other words, even if the motion to amend is not granted, Opposer will still have the right to obtain the relief it seeks by the proposed amendment through a cancellation proceeding. Should the Board continue to allow Opposer the right to amend before the close of discovery, as Opposer suggests, Motion p. 10, and to the extent the Board continues to extend the discovery period with every amendment, Opposer can use the procedure over and over again, like it has done, to prejudice Applicant and his right to obtain registration in a timely manner.

**II. The Motion is futile.**

**A. Assertion of fraud.**

The Motion is futile because even if the allegations contained in the proposed amendment are taken as true, they do not establish fraud, a position which Applicant vehemently denies. They also cannot support opposer's demand that the Applicant modifies his mark to the two word form TEMPLATE MONSTER.

Opposer seeks in part to amend the notice of opposition to recite a complaint for fraud. This proposal is based upon certain representations made by the Applicant in a lawsuit brought in the United States District Court for the Southern District of Florida by Corbis Corporation

against the Applicant and other named parties,<sup>2</sup> the “Corbis Action.”<sup>3</sup>

Even if Opposer’s amendment allegations relating to fraud are taken as true, they do not establish the cause of action. Nowhere in the proposed amendment does the Opposer assert that the Applicant’s representations in the Corbis Action claim that he does not control the quality of the services provided under the mark. Rather, the Opposer illogically jumps to this conclusion from the statement that Applicant does not control the owner of the website address www.templatemonster.com.<sup>4</sup> Opposer’s faulty deduction, that a licensor of a trademark is required to control his licensee when all the licensor really has a right to control is the quality of the goods or services provided under a mark by the license, cannot support a claim of fraud. Because Opposer relies in its proposed amendment on a statement that Applicant never made, i.e., lack control over the quality of the services provided under the mark, the amendment relating to fraud is futile, and in no way impacts Applicant’s ownership of the mark.

**B. Assertion that mark is not used as depicted in Application.**

Opposer also seeks to amend its amended notice of opposition, and compel Applicant to amend his mark from TEMPLATEMONSTER to TEMPLATE MONSTER. First, Opposer cites no law that permits it to dictate, in an opposition proceeding, the manner in which the Applicant uses his mark, or the manner in which he chooses to register it. Second, the specimen filed with the

---

<sup>2</sup>Case No. 06-21643-CIV-ALTONAGA/TURNOFF.

<sup>3</sup>It should be noted that in the Corbis Action, the “Template Defendants” consisted of non-legal entities. Principally, the Template Defendants were domain names, aside from Callaway Alliance, Inc. (Motion, p.4). It was as if plaintiff Corbis was suing a thing, and not the thing’s owner. Thus, Opposer’s reliance on a statement that Applicant did not have a business relationship with a thing is misplaced to establish fraud.

<sup>4</sup>Who was never a party to the Corbis Action.

application supports the actual use of the mark TEMPLATEMONSTER as one word.<sup>5</sup> Because there is no basis to permit Opposer to dictate to Applicant how he should register his mark, the proposed amendment doing so should be rejected as futile.

### **III. The Motion is not timely.**

The Corbis Action was filed on June 28, 2006.<sup>6</sup> While Opposer argues that information required to plead fraud is “usually obtainable only through discovery,” Motion, p. 10, here Opposer concedes that the information upon which it relies to allege fraud was known, or could have been known, well before the time in which it filed the notice of opposition. Specifically, Opposer relies on statements allegedly made in July and August, 2006. Yet, Opposer filed its notice of opposition afterward, in September. Opposer candidly admits that it is not relying on any discovery produced by Applicant to support its proposed amendment, and states no reason why it could not have relied upon the Corbis Action before it filed the original notice of opposition.<sup>7</sup> Opposer’s five (5) month delay in alleging fraud based upon facts that were public and readily available renders the proposed second amendment untimely.

WHEREFORE, the Motion is prejudicial to the Applicant, futile in content, and untimely. For these reasons, the Motion should be denied.

---

<sup>5</sup>Exhibit D of Exhibit 10 to the Motion shows use of the mark as one word in the lower left hand corner of the specimen (“Templatemonster Online Help”), and the upper right hand corner (“Roll Over To See Templatemonster’s Family Sites”).

<sup>6</sup>Within a few months time, the Corbis Action was dismissed **with prejudice** against the Applicant and all represented defendants, and all orders relating to injunctive relief and restraint against them were affirmatively vacated by subsequent court order.

<sup>7</sup>In fact, Opposer sought an extension of time the notice of opposition, the same month the Corbis Action was filed, to investigate whether it wanted to oppose the subject mark.

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](mailto: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 13<sup>th</sup> Street, NW,  
Suite 1000 South  
Washington, DC 20005

this 7<sup>th</sup> day of March, 2007.

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