

ESTTA Tracking number: **ESTTA146110**

Filing date: **06/15/2007**

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	Reply in Support of Motion
Filer's Name	RICHARD S. ROSS, ESQ.
Filer's e-mail	prodp@ix.netcom.com
Signature	/richard ross/
Date	06/15/2007
Attachments	Lognikov Reply.pdf (19 pages)(553820 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 REPLY TO OPPOSER’S OPPOSITION TO RENEWED MOTION TO
DISMISS¹**

COMES NOW, the Applicant, IGOR LOGNIKOV (“Applicant”), by and through his undersigned counsel, who respectfully replies to Opposer’s, MONSTERCOMMERCE, LLC (“Opposer”), memorandum of law in opposition to the pending motion, and states that Opposer misses the point. The motion is directed not to standing as the response argues, but rather to Opposer’s fraudulent representation of ownership of the Monster Marks².

Pointedly absent from Opposer’s opposition is any record fact, affidavit, attachment or other evidence supporting Opposer’s pleaded allegation that it owns the Monster Marks. Opposer had the opportunity to provide that record evidence with its response, and failed to do so. Rather,

¹The Board’s Order of May 11, 2007 treats the Applicant’s pending motion for relief based upon fraud as a renewed motion to dismiss.

²MONSTERLOCAL, MONSTERMARKETPLACE, MONSTER, MONSTER WEB PROMOTION, MONSTER WEB DESIGN, MONSTER DOMAIN REGISTRATION, MONSTERSMALLBUSINESS, MONSTER SELLERS, the MONSTER logo, and the MONSTER EYE logo, including the registration for MONSTERCOMMERCE, U.S. Reg. No. 2,947,268.

Opposer's response retreats from its allegations of ownership, *see* First Amended Notice of Opposition ¶¶2, 3, by asserting throughout the responsive paper that Opposer only "uses" the Monster Marks. Also patently absent is any affidavit from Network Solutions LLC ("Network") refuting ownership as the record now unequivocally establishes through Network's Notice of Opposition to Applicant's sister Community Trademark Application, CTM App. No. 005074761, filed before the Office for Harmonization in the Internal Market ("OHIM"). Network could easily have provided that affidavit, as it provided an affidavit earlier in this proceeding, (DE7, Ex. A), through its Senior Vice President and General Counsel, Mr. Bobby N. Turnage, Jr.³ But, of course, Network cannot claim that it does not own the Monster Marks because to do so would render the Notice of Opposition in the OHIM proceeding fraudulent. So, the only thing Opposer could state in its opposition to the present motion regarding ownership of the Monster Marks is to state nothing at all, which is exactly what it has done. This leads the Board to the thrust of the issue argued in the motion which is whether Opposer's fraudulent allegations of ownership of the Monster Marks is cause to dismiss the opposition. Pursuant to law and the record, the answer is yes.

The impact of the fraud committed by Opposer is substantial since an opposition proceeding is one based in equity.

[T]he opposer, to establish [its] right to protection, must come into court with clean hands. In other words, one seeking to prevent the registration of a trade-mark must be **guiltless of any false representations, either in the mark relied upon as a basis for opposition**, or in the advertising of goods on which the mark is used, and, **if it appears that absolute honesty in either of these particulars is lacking, the opposition should be dismissed.**

³Opposer cannot be heard to complain that it did not know it was not the owner of the Monster Marks since Mr. Turnage, in addition to being Senior Vice President and General Counsel of Network, is also the General Counsel of Opposer (DE7, Ex.C).

Federal Products Co. v. Lewis, 23 F.2d 759, 760 (C.A.D.C. 1927)(Emphasis Added); *T. Charles, Inc. v. Inecto, Inc.*, 48 U.S.P.Q. 428 (Com'r of Pats. 1941). Opposer has not come into this proceeding with clean hands. Opposer has falsely represented itself to be the owner of the Monster Marks. Opposer has submitted no proof to dispel the commission of its fraud on the Board, and has not acted with “absolute honesty” in filing and pursuing the opposition. Opposer’s continued insistence that it “uses” the Monster Marks is completely irrelevant to the issue of fraud and its allegation of ownership of the marks at issue. Under the authority of *Federal Products*, the opposition should be dismissed.⁴

The egregiousness of Opposer’s fraud is compounded by that of its counsel sufficient for an award of sanctions against the Opposer and/or its counsel under Fed.R.Civ.P. 11. Brian J. Winterfeldt, Esq., counsel for Opposer, prepared and filed both the Notice and Amended Notice of Opposition asserting that Opposer was the owner of, among other marks, MONSTERLOCAL and MONSTERMARKETPLACE. However, Mr. Winterfeldt, on April 10, 2006 and July 6, 2006, respectively, filed U.S. trademark applications for these marks on behalf of Network as the owner, not Opposer. (See attached Ex. A). Therefore, Mr. Winterfeldt knew the owner of at least these two marks was not the Opposer when he so fraudulently alleged that it was in the original Notice of

⁴The registered mark that Opposer claims it owns, MONSTERCOMMERCE, U.S. Reg. No. 2,947,268, does not insulate it from its commission of fraud in connection with the unregistered common law marks at issue. Further, it is likely, in light of Network’s claims of ownership, that Opposer also committed fraud in the procurement of the registered mark. *See Hank Thorp, Inc. v. Minilite, Inc.*, 474 F. Supp. 228 (D.C. Del. 1979)(registration canceled for fraud where applicant knew that it did not own the mark at the time of application); *Global Maschinen GmbH v. Global Banking Systems, Inc.*, 227 U.S.P.Q. 862 (TTAB 1985)(relying on *Hank Thorp*).

Opposition filed on September 27, 2006 and the Amended Notice filed on November 6, 2006.⁵

Finally, Opposer's assertion that Applicant is "lash[ing] out" at Opposer for alleging fraud against the Applicant is a non issue. Opposer, or as it deems appropriate, Network, is free to re-allege fraud, if it chooses, if and when Applicant's registration issues, in a cancellation proceeding. Such allegation will be subject to the rules of court, and Applicant does not waive any rights provided by them.

In conclusion, the issue is fraud, and not standing as Opposer has framed it in the response. This is a proceeding in equity. Because Opposer has not been absolutely honest regarding its allegation of the marks' ownership and has completely failed to provide any evidence dispelling the fraud, this opposition should be dismissed with prejudice. Further, sanctions under Rule 11 are appropriate against the Opposer for fraudulently alleging ownership when it had known of an inconsistent position of ownership previously taken before the United States Patent and Trademark Office.

⁵In addition, as Exhibit A exemplifies, Opposer also fraudulently alleged prior use in this proceeding. See DE 7 ¶4 of Amended Notice. Opposer alleged first use of the "MONSTER Family of Marks" at least as early as October, 2001. However, Network's MONSTERLOCAL application filed in 2006 is a 15 USC §1051(b) application and recites no actual use, while the MONSTERMARKETPLACE application recites a first use no earlier than February, 2003. Applicant's first use is at least as early as April, 2002. Moreover, both declarations in these applications, made under penalty of perjury under 18 U.S.C. §1001, assert that "no other person, firm, corporation or association has the right to use the same mark in commerce...." Mr. Turnage, on behalf of Network, made the declaration in the MONSTERLOCAL application. Unless the declaration is false, he knows absolutely that Opposer is fraudulently alleging ownership of this mark in the present opposition proceeding.

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 15th day of June, 2007.

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

EXHIBIT A

Attorney Docket No. 42896.00.077127

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Actual Use Service Mark Application For Limited Liability Company, Principal Register
(With Declaration and Power of Attorney)

Mark: **MONSTERMARKETPLACE**
Classes: 35 and 42

Applicant: Network Solutions, LLC
a Limited Liability Company of Delaware

Address: 13861 Sunrise Valley Drive, Suite 300
Herndon, Virginia 20171

Box New Applications (FEE)
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

To The Commissioner for Trademarks:

Applicant requests registration of the service mark shown in the accompanying drawing in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et seq., as amended) for the following services:

Advertising and promotional services for others, namely, placing advertisements and promotional displays for others in electronic sites accessed via computer networks; dissemination of advertising matter, namely, providing advertising and graphic; promoting the goods and services of others by means of operating an online shopping mall with links to the retail web sites of others; providing information via the Internet regarding the goods and services of others in the nature of a buyers' guide; compiling and maintaining online directories; providing an online commercial information directory on the Internet; providing online directory information services also featuring hyperlinks to other websites; comparison shopping services, in International Class 35; and

Searching and retrieving information, sites, and other resources available on computer networks for others; computer services, namely, providing search engines for obtaining data on a global computer network, in International Class 42.

The mark was first used to provide the services in Class 35 at least as early as February 20, 2003; the mark was first used in interstate commerce to provide these services in Class 35 at least as early as November 18, 2003; and is now in use in such commerce.

The mark was first used to provide the services in Class 42 at least as early as February 20, 2003; the mark was first used in interstate commerce to provide these services in Class 42 at least as early as November 18, 2003; and is now in use in such commerce.

The mark is presented in standard character format without claim to any particular font style, size or color.

Applicant hereby appoints: **Brian J. Winterfeldt**, Deepika R. Allana, Benita P. Collier, Dinisa H. Folmar, and all attorneys with the firm of Ballard Spahr Andrews & Ingersoll, LLP, to prosecute this application, to transact all business in the U.S. Patent and Trademark Office connected therewith and to receive the Registration Certificate if one should issue. Please direct all future correspondence to:

Brian J. Winterfeldt, Esq.
Ballard Spahr Andrews & Ingersoll, LLP
601 13th Street, NW
Suite 1000 South
Washington, DC 20005-3807
Phone: (202) 661-7650
Fax: (202) 626-9065
E-mail: winterfeldtb@ballardspahr.com

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom, declares: that he/she is authorized to execute this declaration; that he/she believes Applicant to be the owner of the mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes Applicant to be entitled to use such mark in commerce; that to the best of his/her knowledge and belief no other person, firm, corporation or association has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the goods and/or services of such other person, to cause confusion, or to cause mistake, or to deceive; that the facts set forth in this application are true; and that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true as of the filing date of this application.

NETWORK SOLUTIONS, LLC

By: 

Jeff Grossman
Senior Vice President, Marketing

Date: June 22, 2006



07-06-2006

U.S. Patent & TMO/c/TM Mail Rcpt Dt: #

Drawing Page

Applicant: Network Solutions, LLC
a Limited Liability Company of Delaware
Address: 13861 Sunrise Valley Drive, Suite 300
Herndon, Virginia 20171

Date of First Use: Class 35: at least as early as February 20, 2003
Class 42: at least as early as February 20, 2003

Date of First Use in
Interstate Commerce: Class 35: at least as early as November 18, 2003
Class 42: at least as early as November 18, 2003

Services: Advertising and promotional services for others, namely, placing advertisements and promotional displays for others in electronic sites accessed via computer networks; dissemination of advertising matter, namely, providing advertising and graphic; promoting the goods and services of others by means of operating an online shopping mall with links to the retail web sites of others; providing information via the Internet regarding the goods and services of others in the nature of a buyers' guide; compiling and maintaining online directories; providing an online commercial information directory on the Internet; providing online directory information services also featuring hyperlinks to other websites; comparison shopping services, in International Class 35; and

Searching and retrieving information, sites, and other resources available on computer networks for others; computer services, namely, providing search engines for obtaining data on a global computer network, in International Class 42.

MONSTERMARKETPLACE





United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

Trademarks > Trademark Electronic Search System(Tess)

TESS was last updated on Tue Jun 5 04:07:11 EDT 2007

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#) | [Prev List](#) | [CURR LIST](#)
[NEXT LIST](#) | [First Doc](#) | [Prev Doc](#) | [NEXT DOC](#) | [LAST DOC](#)

[Logout](#) | Please logout when you are done to release system resources allocated for you.

[Start](#) | [List At:](#) OR [Jump](#) | to record: **Record 1 out of 2**

[TARR Status](#) | [ASSIGN Status](#) | [TDR](#) | [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)

MONSTERMARKETPLACE

Word Mark MONSTERMARKETPLACE

Goods and Services IC 035. US 100 101 102. G & S: Advertising and promotional services for others, namely, placing advertisements and promotional displays for others in electronic sites accessed via computer networks; dissemination of advertising matter, namely, providing advertising and graphic; promoting the goods and services of others by means of operating an online shopping mall with links to the retail web sites of others; providing information via the Internet regarding the goods and services of others in the nature of a buyers' guide; compiling and maintaining online directories; providing an online commercial information directory on the Internet; providing online directory information services also featuring hyperlinks to other websites; comparison shopping services. FIRST USE: 20030220. FIRST USE IN COMMERCE: 20031118

IC 042. US 100 101. G & S: Searching and retrieving information, sites, and other resources available on computer networks for others; computer services, namely, providing search engines for obtaining data on a global computer network. FIRST USE: 20030220. FIRST USE IN COMMERCE: 20031118

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Design Search Code

Serial Number 76662639
Filing Date July 6, 2006
Current Filing Basis 1A
Original Filing Basis 1A
Published for Opposition November 21, 2006
Owner (APPLICANT) **Network Solutions**, LLC LTD LIAB CO DELAWARE 13861 Sunrise Valley Drive, Suite 300 Herndon VIRGINIA 20171
Attorney of Record Brian J. Winterfeldt
Type of Mark SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT SEARCH OG TOP HELP PREV LIST CURR LIST
NEXT LIST FIRST DOC PREV DOC NEXT DOC LAST DOC

[|.HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)

Attorney Docket No. 42896.00.075301

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Intent-to-Use Service Mark Application For Corporation, Principal Register
(With Declaration and Power of Attorney)

Mark: **MONSTERLOCAL**
Class: 35

Applicant: Network Solutions, LLC
a Limited Liability Company of Delaware

Address: 13861 Sunrise Valley Drive, Suite 300
Herndon, Virginia 20171

Box New Applications (FEE)
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

To The Commissioner for Trademarks:

Applicant requests registration of the service mark shown in the accompanying drawing in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et seq., as amended) for the following services:

Providing on-line directory information services also featuring
hyperlinks to other web sites, International Class 35.

Applicant has a bona fide intention to use the mark in commerce in connection with the above identified services (15 U.S.C. 1051(b), as amended).

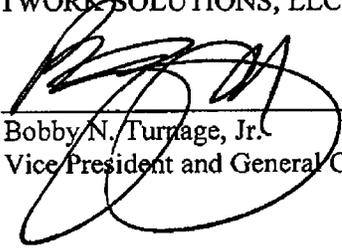
The mark is presented in standard character format without claim to any particular font style, size or color.

Applicant hereby appoints: **Brian J. Winterfeldt**, Benita P. Collier, Dinisa H. Folmar, Deepika R. Allana, and all attorneys with the firm of Ballard Spahr Andrews & Ingersoll, LLP, to prosecute this application, to transact all business in the U.S. Patent and Trademark Office connected therewith and to receive the Registration Certificate if one should issue. Please direct all future correspondence to:

Brian J. Winterfeldt, Esq.
Ballard Spahr Andrews & Ingersoll, LLP
601 13th Street, NW
Suite 1000 South
Washington, DC 20005-3807
Phone: (202) 661-7650
Fax: (202) 626-9065
E-mail: winterfeldtb@ballardspahr.com

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom, declares: that he is authorized to execute this declaration; that he believes Applicant to be the owner of the mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he believes applicant to be entitled to use such mark in commerce; that to the best of his knowledge and belief no other person, firm, corporation or association has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the services of such other person, to cause confusion, or to cause mistake, or to deceive; that the facts set forth in this application are true; and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true as of the filing date of this application.

NETWORK SOLUTIONS, LLC

By: 

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

Date: March 31, 2006



04-10-2006

U.S. Patent & TMOfo/TM Mail ReptDt. #61

Drawing Page

Applicant: NETWORK SOLUTIONS, LLC
Address: 13861 Sunrise Valley Drive, Suite 300
Herndon, Virginia 20171
Date of First Use: Intent-to-Use
Date of First Use in
Interstate Commerce: Intent-to-Use
Services: Providing on-line directory information services also featuring
hyperlinks to other web sites, International Class 35.

MONSTERLOCAL

U.S. Patent & TM Ofo/TM



76658138



United States Patent and Trademark Office

Home|Site Index|Search|FAQ|Glossary|Guides|Contacts|eBusiness|eBiz alerts|News|Help

Trademarks > Trademark Electronic Search System(Tess)

TESS was last updated on Tue Jun 5 04:07:11 EDT 2007

TESS HOME **NEW USER** **STRUCTURED** **FREE FORM** **BROWSE DICT** **SEARCH OG** **BOTTOM** **HELP** **PREV LIST** **CURR LIST**

NEXT LIST **FIRST DOC** **PREV DOC** **NEXT DOC** **LAST DOC**

Logout Please logout when you are done to release system resources allocated for you.

Start List At: **OR** Jump to record: **Record 2 out of 2**

TARR Status **ASSIGH Status** **TDR** **TTAB Status** (Use the "Back" button of the Internet Browser to return to TESS)

MONSTERLOCAL

Word Mark MONSTERLOCAL
Goods and Services IC 035. US 100 101 102. G & S: Providing on-line directory information services also featuring hyperlinks to other web sites
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Design Search Code
Serial Number 76658138
Filing Date April 10, 2006
Current Filing Basis 1B
Original Filing Basis 1B
Published for Opposition November 14, 2006
Owner (APPLICANT) **Network Solutions, LLC** LTD LIAB CO DELAWARE 13861 Sunrise Valley Drive, Suite 300 Herdon VIRGINIA 20171
Attorney of Record Brian J. Winterfeldt
Type of Mark SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

TESS HOME **NEW USER** **STRUCTURED** **FREE FORM** **BROWSE DICT** **SEARCH OG** **TOP** **HELP** **PREV LIST** **CURR LIST**

NEXT LIST **FIRST DOC** **PREV DOC** **NEXT DOC** **LAST DOC**

[|.HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)