

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

Baxley

Mailed: February 13, 2008

Opposition No. 91173189

Monstercommerce, LLC

v.

Igor Lognikov (by amendment
from Igor Logniko)

Before Walters, Grendel and Wellington,
Administrative Trademark Judges

By the Board:

The following motions are pending in this proceeding:

1) applicant's motion (filed December 20, 2006) to amend his name in involved application Serial No. 78612360; 2) opposer's motion (filed January 31, 2007) for partial judgment on the pleadings; 3) applicant's motion (filed February 12, 2007) to compel discovery; 4) opposer's motion (filed February 20, 2007) for leave to file an amended notice of opposition; and 5) applicant's motion (filed May 8, 2007) to dismiss in view of opposer's allegedly fraudulent claim of ownership of the pleaded marks.¹

¹ On October 17, 2006, applicant 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 can be granted. Therein, applicant alleged that: 1) the opposition was untimely because it was filed during an extension of time to oppose that was granted to Network Solutions, LLC ("Network") and not opposer; and 2) opposer lacks

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The Board will first consider applicant's motion to amend his name in the involved application. Although opposer did not file a brief in opposition thereto, the Board, in its discretion, elects to decide that motion on the merits. See Trademark Rule 2.127(a).

In the involved application, applicant is identified as "Igor Logniko." However, as the Board noted in a December 13, 2006 order, applicant has identified himself in his submissions in this case as "Igor Lognikov."² By his motion to amend, applicant seeks to change the name of the applicant in the involved application to conform with the name under which he previously filed submissions. The record herein indicates that applicant is merely seeking to correct a one-letter error in his name as set forth in the involved application and that applicant is not seeking to designate another individual as the applicant. Accordingly, the proposed amendment is acceptable, and the motion to

standing to pursue this opposition because Monster Commerce, Inc., and not opposer, is the record owner of pleaded Registration No. 2947268. In a December 13, 2006 order, the Board denied applicant's motion finding that 1) opposer, as a wholly owned subsidiary of Network, was in privity therewith; and 2) opposer's allegations of prior use of its pleaded marks were sufficient to allege its standing.

On October 12, 2006, opposer filed a motion to amend the pleaded registration to identify it as the registrant therein. On July 17, 2007, the USPTO issued an updated certificate for the pleaded registration which identifies opposer as the registrant.

² In that order, the Board advised applicant that, unless he sought to amend the name of the applicant in the involved application, the Board would continue to identify him in this case as "Igor Logniko."

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amend the involved application is granted. See TMEP Sections 803.06 and 1201.02(c) (5th ed. 2007).

The Board will next consider opposer's motion for leave to file a second amended notice of opposition. Inasmuch as applicant has filed his answer herein, opposer may file a second amended notice of opposition only by written consent of applicant or by leave of the Board; and leave is to be freely granted when justice so requires. See Fed. R. Civ. P. 15(a); TBMP Section 507.02(a) (2d ed. rev. 2004). The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law, be prejudicial to the rights of the adverse party or parties, or be futile. See *id.*

By the second amended notice of opposition, opposer seeks to add three grounds for opposing registration of applicant's involved TEMPLATEMONSTER mark, namely, that: 1) in view of applicant's statements in a civil action styled *Corbis Corporation v. Lognikov, et al*, Case No. 06-21643, filed in the United States District Court for the Southern District of Florida, applicant is not the owner of such mark; 2) applicant committed fraud upon the USPTO by asserting in the involved application that he owns such mark; and 3) because applicant's mark, as used in commerce, is TEMPLATE MONSTER, not TEMPLATEMONSTER, applicant should

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be required to amend the mark in the drawing to TEMPLATE MONSTER and disclaim the generic wording TEMPLATE.

Applicant's argument that he is prejudiced because opposer delayed in raising the new grounds is not well-taken. Prejudice must be more than the mere inconvenience and delay caused by the movant's previous failure to act sooner. Rather, prejudice contemplates an adverse impact on the nonmovant's ability to litigate the case, e.g., where the movant's delay has resulted in lost evidence or unavailable witnesses. See *Pratt v. Philbrook*, 109 F.3d 18 (1st Cir. 1997); TBMP Section 509.01(b)(1) (2d ed. rev. 2004). Applicant has pointed to no such adverse impact.

In addition, applicant's contention that opposer can raise the new grounds in a cancellation proceeding should applicant's mark become registered is unpersuasive. The issue here is not whether opposer could assert the new claims in a later cancellation proceeding, but rather whether allowing the proposed amendment in the current proceeding would violate settled law, be prejudicial to applicant, or be futile. We find that it would not.

A review of the second amended notice of opposition indicates that opposer's claims of nonownership, as set forth in paragraphs 14-23, and fraud, as set forth in paragraphs 24-27, are legally sufficient. See Trademark Act

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Section 1(a), 15 U.S.C. Section 1051(a); Fed. R. Civ. P. 9(b).

However, regarding opposer's proposed claim that, because applicant uses his mark in commerce as TEMPLATE MONSTER, not TEMPLATEMONSTER, applicant should be required to amend the mark in the drawing to TEMPLATE MONSTER and insert a disclaimer of TEMPLATE, the fact that applicant uses his mark in a different form is not, by itself, a basis for opposing registration. Opposer has not set forth a claim of nonuse or abandonment of the TEMPLATEMONSTER mark, nor has opposer set forth specific facts constituting fraud. See Fed. R. Civ. P. 9(b); Trademark Act Section 45, 15 U.S.C. Section 1127. To the extent that opposer asks that the Board refuse registration of applicant's mark based on the specimen of use that was submitted in support of the application, the sufficiency of specimens is an *ex parte* examination issue which is not a basis for opposition. See *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034 (TTAB 1989). Based on the foregoing, opposer's proposed claim that applicant's mark, as used in commerce, is TEMPLATE MONSTER, not TEMPLATEMONSTER, is legally insufficient, and we *sua sponte* strike paragraphs 28-33 from the second amended notice of opposition.

In its second amended notice of opposition, opposer has reasserted a dilution claim. However, opposer's pleading of

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such claim remains insufficient for the reason stated by the Board in its previous order dismissing the claim. That is, opposer still has failed to allege an essential element of a dilution claim, i.e., that its pleaded mark(s) became famous prior to applicant's application filing date or date of first use. See *Toro Co. v. Torohead, Inc.*, 61 USPQ2d 1164 (TTAB 2001). In view thereof, we *sua sponte* strike Paragraph 12 of the second amended notice of opposition pursuant to Fed. R. Civ. P. 12(f), and we shall give opposer's purported dilution claim no further consideration.

Based on the foregoing, opposer's motion for leave to file a second amended notice of opposition is granted. The second amended notice of opposition is the operative complaint herein. Applicant is allowed until thirty days from the mailing date set forth in the caption of this order to file an answer to the second amended notice of opposition. However, inasmuch as we have stricken paragraphs 12 and 28-33 from the second amended notice of opposition, applicant need not answer those allegations."

Inasmuch as the second notice of opposition is now the operative complaint herein and no answer thereto has been filed, opposer's motion for partial judgment on the pleadings is moot.³

³ In that motion, opposer sought entry of judgment in its favor on applicant's pleaded affirmative defenses of laches, equitable estoppel, and legal estoppel. For purposes of preparing his answer to the second amended notice of opposition, applicant is

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The Board turns next to applicant's second motion to dismiss.⁴ Applicant seeks relief from the Board's December 13, 2006 order under Fed. R. Civ. P. 60(b)(3) and asks that the Board dismiss this opposition under Fed. R. Civ. P. 12(b)(1) and Fed. R. Civ. P. 12(b)(6) because opposer committed fraud by misrepresenting throughout this proceeding that it owns the pleaded marks and registration. As support for this position, applicant notes that Network, opposer's parent company, filed a notice of opposition to applicant's Community Trademark Application No. 005074761 in the Office for Harmonization in the Internal Market and

advised that laches is not a viable defense in an opposition proceeding because opposer's time in which to assert its rights against applicant ran from the date of publication of the application for opposition rather than from the date of first knowledge of use. See *National Cable Television Ass'n v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991). Further, to provide fair notice of an affirmative defense of equitable estoppel, applicant must allege, among other things, specific action or inaction by opposer which led applicant to infer reasonably that opposer would not assert rights against it. See *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701 (Fed. Cir. 1992). Moreover, legal estoppel is a doctrine usually applied in patent litigation which refers to "conduct encompassing scenarios where a patentee has licensed or assigned a right, received consideration, and then sought to derogate from the right granted." See *Wang Laboratories Inc. v. Mitsubishi Electronics America Inc.*, 41 USPQ2d 1263, 1272 (Fed. Cir. 1997).

⁴ The Board suspended proceedings pending its decision on all pending motions in a March 5, 2007 order. In that order, the Board advised the parties that they should not file any submissions which are not germane to the pending motions.

Notwithstanding the clear language of the March 5, 2007 order, applicant filed his second motion to dismiss on May 8, 2007. However, because the motion to dismiss could potentially be dispositive of this case and would render the remaining pending motions moot, the Board, in a May 11, 2007 order, allowed that

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asserted therein that it, rather than opposer, owns the pleaded marks, including the MONSTERCOMMERCE mark that is the subject of opposer's pleaded Registration No. 2947268.

As an initial matter, applicant's reliance upon Fed. R. Civ. P. 60(b)(3) is inappropriate because the December 13, 2006 order was interlocutory in nature and not final. To the extent that applicant requests reconsideration of that order, such request was filed more than one month after the issuance of that order and is thus denied as untimely. See Trademark Rule 2.127(b); TBMP Section 518 (2d ed. rev. 2004). As such, we decline to modify our findings in the December 13, 2006 order 1) that the Board has subject matter jurisdiction over the involved application under Fed. R. Civ. P. 12(b)(1); and 2) that opposer has set forth a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6).

To the extent that applicant is alleging that this opposition should be dismissed on his affirmative defense of unclean hands that was pleaded in his answer to the first amended notice of opposition, applicant's motion is based solely on the pleadings in this proceeding and the complaint that opposer's parent company filed in the foreign litigation. However, because trademark rights are territorial in nature, the mere fact that opposer's parent

motion to be fully briefed, but directed the parties not to file

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company asserted ownership of the pleaded marks in a foreign country does not, by itself, make false, let alone fraudulent, opposer's claim of ownership of those marks in the United States. See *Person's Co., Ltd. v. Christman*, 900 F.2d 1565 (Fed. Cir. 1990). Accordingly, dismissal of the opposition on the basis of unclean hands is unwarranted.

Further, to the extent that applicant's second motion is based on the doctrine of judicial estoppel,⁵ that doctrine does not apply to prior inconsistent statements, such as those of opposer's parent company, made before a foreign tribunal concerning trademark rights within that country. See *Boston Chicken Inc. v. Boston Pizza International Inc.*, 53 USPQ2d 1053 (TTAB 1999). Protection of trademark rights in a particular country depends exclusively on the laws of that country. See *Person's Co., Ltd. v. Christman*, *supra*; *International Diagnostic Technology, Inc. v. Miles Laboratories, Inc.*, 223 USPQ 977 (Fed. Cir. 1984). We have consistently held that information and decisions relative to trademark disputes in foreign jurisdictions are not controlling in determining trademark rights in the United States. See *Faberge, Inc v. Dr. Bador GmbH & Co.*, 219 USPQ 848 (TTAB 1983); *Hiram Walker*

any further motions until all pending motions have been decided.
⁵ Applicant did not expressly set forth an affirmative defense of judicial estoppel in his answer to the first amended notice of opposition. See TBMP Sections 311.02(c) and 528.07(a) (2d ed. rev. 2004).

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& Sons, Inc. v. Canadian Distilleries Ltd., 176 USPQ 156 (TTAB 1972). Accordingly, the fact that the parent company of which opposer is a wholly-owned subsidiary asserted ownership of the pleaded marks in litigation in a foreign country has no bearing upon this opposition and does not provide a basis for dismissal thereof.

Moreover, to the extent that applicant alleges that, in view of the assertions of opposer's parent company in the foreign litigation, opposer does not own the pleaded registration,⁶ that allegation is a collateral attack on the pleaded registration. Any such collateral attack must be raised by way of a compulsory counterclaim. See Trademark Rule 2.106(b)(2)(i); TBMP Section 313.04 (2d ed. rev. 2004).

In view thereof, the second motion to dismiss is not well-taken and is therefore denied.

We will next consider applicant's motion to compel discovery. The Board agrees with opposer that applicant did not satisfy its obligation under Trademark Rule 2.120(e) to make a good faith effort to resolve discovery disputes before seeking the Board's intervention.⁷ Contrary to

⁶ The underlying application for Registration No. 2947268 was filed based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), only and was not reliant upon any foreign application or registration. See Trademark Act Section 44, 15 U.S.C. Section 1126.

⁷ To the extent that applicant requests that the Board enter judgment based on opposer's alleged dilatory conduct in

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applicant's apparent belief, the Board expects parties to discuss specific deficiencies in individual discovery responses prior to seeking Board intervention. See *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666 (TTAB 1986).

In view of applicant's failure to discuss with opposer specific discovery responses that he believed to be deficient, the Board finds that applicant has failed to make a good faith effort to resolve by agreement the issues raised in his motion to compel. See Trademark Rule 2.120. At least some of the problems herein should be resolved without Board intervention, and the Board suggests greater effort to avoid or resolve such controversies. Applicant must adhere to the strictures set forth in *Sentrol, Inc. v. Sentex Systems, Inc.*, *supra*, and repeated below:

[W]here the parties disagree as to the propriety of certain requests for discovery, they are under an obligation to get together and attempt in good faith to resolve their differences and to present to the Board for resolution only those remaining requests for discovery, if any, upon which they have been unable, despite their best efforts, to reach an agreement. Inasmuch as the Board has neither the time nor the personnel to handle motions to compel involving substantial numbers of requests for discovery which require tedious examination, it is generally the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that the parties have in fact followed the aforesaid process and have narrowed the amount of disputed requests for discovery, if any, down to a reasonable number.

discovery, that request is premature. See Trademark Rule 2.120(g); TBMP Section 527.01 (2d ed. rev. 2004).

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Based on the foregoing, applicant's motion to compel is denied without prejudice.⁸

Proceedings herein are resumed. The parties are allowed until thirty days from the mailing date set forth in the caption of this order to serve responses to any outstanding written discovery requests. Discovery and testimony periods are reset as follows.

DISCOVERY PERIOD TO CLOSE: June 13, 2008

Plaintiff's 30-day testimony period to close: **September 11, 2008**

Defendant's 30-day testimony period to close: **November 10, 2008**

Plaintiff's 15-day rebuttal testimony period to close: **December 25, 2008**

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.

⁸ Further, inasmuch as the Board's standard form protective agreement has been imposed on the parties by operation of Trademark Rule 2.116(a), as amended on August 1, 2007, opposer's request that the Board enter the proposed protective order that it enclosed with its brief in response to the motion to compel is moot.

Notwithstanding the foregoing, opposer is reminded that a party that has responded to a discovery request has a duty to supplement or correct that response. See Fed. R. Civ. P. 26(e). Opposer is also reminded that, when a party, without substantial justification, fails to disclose information required, or fails to amend or supplement a prior response, as required, that party may be prohibited from using as evidence the information not so disclosed. See Fed. R. Civ. P. 37(c)(1).

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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.

New TTAB rules

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>