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

Proceeding	91173189
Party	Plaintiff MONSTERCOMMERCE, LLC
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**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 LOGNIKOV,)	
)	
Applicant.)	
)	

**MOTION TO STRIKE APPLICANT’S AFFIRMATIVE DEFENSES
IN ITS ANSWER TO THE SECOND AMENDED NOTICE OF OPPOSITION**

Opposer, MonsterCommerce, LLC (“MonsterCommerce” or “Opposer”) by its counsel, hereby moves to strike Affirmative Defenses 1-5 asserted by Applicant, Igor Lognikov (“Lognikov” or “Applicant”).

PRELIMINARY STATEMENT

In his answer to MonsterCommerce’s Second Amended Notice of Opposition, Applicant has burdened the Board and MonsterCommerce with groundless and insufficient affirmative defenses in an effort to delay and complicate the proceedings. Applicant’s affirmative defenses were already twice rejected by the Board, or are otherwise not legally sufficient, and should be stricken from the pleadings. Applicant has raised the following affirmative defenses: (1) failure to state a claim upon which relief can be granted; (2) lack of subject matter jurisdiction; (3) fraud; (4) equitable estoppel; and (5) “that the Corbis and the

Corbis Action court were at all times aware of the pending trademark application to Lognikov.” Applicant’s affirmative defenses of failure to state a claim upon which relief can be granted, lack of subject matter jurisdiction, and fraud have already been rejected by the Board. Applicant’s affirmative defense of equitable estoppel is not available in an opposition proceeding because the defense does not begin to run until the date the mark is published for opposition. Finally, Applicant’s affirmative defense “that the Corbis and the Corbis Action court were at all times aware of the pending trademark application to Lognikov” is vague, does not state a recognized affirmative defense, and does not even amount to an amplification of a denial under TBMP § 311.02(d).

FACTUAL BACKGROUND

Applicant seeks to register the mark TEMPLATEMONSTER for software for developing websites using pre-formatted templates and for website design services. MonsterCommerce is the owner of a federal registration for the mark MONSTERCOMMERCE for, inter alia, software enabling users to build an e-commerce website. MonsterCommerce uses the MONSTERCOMMERCE mark and 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. MonsterCommerce initially instituted this Opposition on the ground that the mark TEMPLATEMONSTER is likely to cause confusion with the MONSTERCOMMERCE mark and its family of MONSTER marks. MonsterCommerce has since amended the Opposition to assert that Applicant is not the owner of the TEMPLATEMONSTER mark and cannot be the owner of the mark based on express admissions made by him to a federal district court in Florida.

PROCEDURAL HISTORY

MonsterCommerce instituted this Opposition in September 2006. Applicant filed its first motion to dismiss in October 2006. As grounds for the motion, Applicant alleged that the Board lacked subject matter jurisdiction over the proceeding because Network Solutions, LLC (“Network Solutions”), not MonsterCommerce, had filed the Request for an Extension of Time to File the Opposition. Additionally, Applicant argued that MonsterCommerce lacked standing to maintain the proceeding because its pleaded federal registration for the MONSTERCOMMERCE mark was in the name of MonsterCommerce, Inc. not MonsterCommerce, LLC. Applicant also alleged that MonsterCommerce had failed to state a claim upon which relief can be granted.

MonsterCommerce opposed Applicant’s motion to dismiss and filed an Amended Notice of Opposition with its responsive brief. MonsterCommerce explained that it is a wholly owned subsidiary of Network Solutions and, as such, is in privity with Network Solutions. Because Network Solutions is in privity with MonsterCommerce, the Opposition was timely filed and the Board has subject matter jurisdiction over the Opposition. MonsterCommerce further explained that the federal registration for the MONSTERCOMMERCE mark, which issued in the name of MonsterCommerce, Inc. instead of MonsterCommerce LLC, is a correctable clerical error and does not affect MonsterCommerce’s standing.

In an Order dated December 13, 2006, the Board held that it had subject matter jurisdiction over the proceeding and that MonsterCommerce had standing to maintain the Opposition. (December 13th Order at pp. 6, 9, attached hereto as Exhibit A.) The Board agreed that because MonsterCommerce provided uncontradicted evidence that, prior to the filing of the Notice of Opposition, it was a wholly owned subsidiary of Network Solutions and that Network Solutions controlled MonsterCommerce’s assets, MonsterCommerce was in privity with

Network Solutions, thus the Notice of Opposition was timely filed. (Id. at p. 5.) On the issue of standing, the Board provided a full legal analysis, enunciating the statutory and judicially created requirements, and their applicability to this proceeding. (Id. at pp. 7-8.) The Board held that MonsterCommerce had standing, not because it alleged ownership of a federal trademark registration, but because it alleged prior use of a family of MONSTER marks in connection with a broad range of online services, which “demonstrate[ed] a real interest in the outcome of the proceeding and a reasonable basis for a belief of damage.” (Id. at pp. 8-9.) In reaching its holding, the Board expressly stated that it assumed, for the sake of argument, that MonsterCommerce did not own the pleaded registration. (Id. at p. 8.) The Board denied Applicant’s motion to dismiss for failure to state a claim with regard to MonsterCommerce’s Section 2(d) claim. (Id. at p. 9).

On January 31, 2007, MonsterCommerce filed a motion for partial judgment on the pleadings seeking dismissal of the affirmative defenses of laches, equitable estoppel and legal estoppel because there is no legal basis to assert these defenses in this Opposition proceeding.

On February 20, 2007, MonsterCommerce filed a second motion to amend the opposition on the ground that Applicant is not the owner of the TEMPLATEMONSTER mark based on express admissions made by him to a federal court in Florida in a civil action captioned Corbis Corporation v. Lognikov, et al, Case No. 06-21643 (the “Corbis Action”), which MonsterCommerce had recently uncovered. On March 5, 2007, the Board suspended the proceedings pending the outcome of the pending motions and instructed the parties not to file any papers that were not germane to the three motions.

On May 8, 2007, Applicant filed a motion “for relief from order based on fraud.” Shortly thereafter, on May 11, 2007, the Interlocutory Attorney issued an Order in response to

Applicant's motion. (Order dated May 11, 2007, attached hereto as Exhibit B.) The Order stated that to the extent Applicant sought relief from the December 13th Order, the motion was untimely. (Id. at p. 1.) The Order further explained that because the motion presented new arguments and evidence in support of Applicant's contention that the Opposition should be dismissed, the motion for relief was actually a renewed motion to dismiss and that the Board would treat it accordingly. (Id. at p. 1.)

On February 13, 2008, the Board decided all remaining pending motions, including (1) Applicant's motion to amend his name; (2) MonsterCommerce's motion for partial judgment on the pleadings; (3) Applicant's motion to compel discovery; (4) MonsterCommerce's motion for leave to file an amended notice of opposition; and (5) Applicant's motion to dismiss in view of MonsterCommerce's allegedly fraudulent claim of ownership of the pleaded marks. (Order dated Feb. 13, 2008, attached hereto as Exhibit C).

The Board granted Applicant's motion to amend his name. (Id. at p. 2.)

The Board granted MonsterCommerce's motion for leave to file a second amended notice of opposition to add as grounds that in view of Applicant's statements in the Corbis Action, Applicant is not the owner of the TEMPLATEMONSTER mark, and that Applicant committed fraud upon the Patent and Trademark Office by asserting that he is the owner of the applied-for mark. (Id. at p. 3-6.) MonsterCommerce's Second Amended Notice of Opposition was deemed the operative complaint, and Applicant was given thirty days from the date of the Order to file his answer.

The Board found MonsterCommerce's motion for partial judgment on pleadings moot as result of the amended notice of opposition being granted. (Id. at p. 6.)

The Board denied Applicant's motion to dismiss for relief from order based on fraud, holding that "the second motion to dismiss is not well-taken and is therefore denied." (Id. at 7-10.) In denying Applicant's motion, the Board reaffirmed its "findings in its 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 MonsterCommerce has set forth a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6)." (Id. at p. 8.)

Finally, the Board denied Applicant's motion to compel because Applicant failed to make a good faith effort to resolve by agreement the issues raised in his motion to compel. (Id. at p. 10-12.)

On March 13, 2008, Applicant filed his Answer and Affirmative Defenses to Second Amended Notice of Opposition. This motion followed.

ARGUMENT

A motion to strike will be granted where an affirmative defense is legally insufficient. See TBMP § 506.01; Order Sons of Italy v. Profumi Fratelli Nostra AG, 36 U.S.P.Q.2d 1221, 1222 (TTAB 1995). Applicant has alleged five affirmative defenses, none of which are legally sufficient.

A. Applicant's First Affirmative Defense for Failure to State a Claim Should be Stricken Because the Board Has Twice Denied Applicant's Motions for Failure to State a Claim

Where Opposer has stated a claim upon which relief can be granted, it is proper for the Board to strike such an affirmative defense from the pleadings. S.C. Johnson & Sons, Inc. v. GAF Corp., 177 U.S.P.Q. 720 (TTAB 1973).

The Board has twice denied Applicant's motions to dismiss for failure to state a claim upon which relief can be granted. (Order of Dec. 13, 2006 at pp. 6-9; and Order of Feb. 13, 2008 at p. 8.) "...[E]fficient disposition of the case demands that each stage of the litigation

build on the last, and not afford an opportunity to reargue every previous ruling.” Stocker v. General Conference Corp. of Seventh-day Adventists, 39 U.S.P.Q.2d 1385, 1403, n.7 (TTAB 1996); see also AM General Corp. v. DaimlerChrysler Corp., 246 F.Supp.2d 1030, 1033 (N.D. Ind. 2003) (“Under the law of the case doctrine... ‘when a court decided upon a rule of law, that decision should continue to govern the same issue in subsequent stages of the same case.’”) (quoting United States v. Story, 137 F.3d 518, 520 (7th Cir. 1998)).

The Board has already held, twice, that MonsterCommerce has stated a claim upon which relief can be granted. Indeed, in its February 13, 2008 Order, the Board specifically declined to modify its finding with respect to MonsterCommerce’s Second Amended Notice of Opposition “that opposer has set forth a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6).” (Order of Feb. 13, 2008 at p. 8.) Accordingly, the Board should strike the affirmative defense of failure to state a claim upon which relief can be granted from the pleadings.

B. Applicant’s Fourth Affirmative Defense of Lack of Subject Matter Jurisdiction Should be Stricken Because the Board Has Twice Held that it Has Subject Matter Jurisdiction

The Board has twice denied Applicant’s motions to dismiss for lack of subject matter jurisdiction. (Order of Dec. 13, 2006 pp. 5-6; and Order of Feb. 13, 2008 at p. 8.) Specifically, in its February 13, 2008 Order, the Board declined to modify its finding with respect to MonsterCommerce’s Second Amended Notice of Opposition, explicitly stating that “the Board has subject matter jurisdiction over the involved application under Fed. R. Civ. P. 12(b)(1). . .” Applicant’s attempt to secure yet a third bite of the apple to make meritless arguments contesting the TTAB’s subject matter jurisdiction over this proceeding is a waste of the Board’s and the parties’ resources and should be rejected. Accordingly, the Board should strike Applicant’s affirmative defense of lack of subject matter jurisdiction from the pleadings.

C. Applicant's Fifth Affirmative Defense of Fraud Should be Stricken Because the Board Has Twice Rejected Applicant's Fraud Defense

Applicant's Fifth Affirmative Defense based on fraud states:

"[MonsterCommerce] has committed fraud in connection with this Second Amended Notice of Opposition by alleging ownership of the cited registration, and/or the "MONSTER Family of Marks" in that, at the very least, it is not the owner of MONSTERLOCAL (U.S. Application No. 76/658,138), and MONSTERMARKETPLACE (U.S. Reg. No. 3,361,201), as both marks are identified by the United States Patent and Trademark Office as being owned by Network Solutions LLC; and as a result of this fraud, [MonsterCommerce] has committed unclean hands."

The Board has already twice rejected Applicant's fraud defense based on the parent-subsidary relationship between MonsterCommerce and Network Solutions. (Order of Dec. 13, 2006 pp. 5-6; Order of Feb. 13, 2008 at pp.7-10). In its first motion to dismiss, Applicant argued that the Board lacked standing because MonsterCommerce's parent company filed the extension of time to oppose, but that MonsterCommerce actually opposed the application. The Board rejected this argument because MonsterCommerce provided uncontradicted evidence that MonsterCommerce was a wholly-owned subsidiary of Network Solutions, and that Network Solutions controlled MonsterCommerce's assets. The Board properly held that the opposition was timely filed because the opposition was filed by a company in privity with the party that filed the extension of time to oppose.

Not to be discouraged, Applicant filed a second motion to dismiss alleging that MonsterCommerce committed fraud by misrepresenting throughout this proceeding that it owns the pleaded marks and registrations when its parent company, Network Solutions, asserted ownership of the same mark and registration in foreign proceedings. The Board properly denied Applicant's request to dismiss the proceedings on these grounds because "the fact that the parent

company of which opposer is a wholly-owned subsidiary asserted ownership of the pleaded marks in a litigation in a foreign country has no bearing upon this opposition and does not provide a basis for dismissal thereof.” (Order of Feb. 13, 2008 at p. 10.)

Applicant now seeks to allege, for a third time, that MonsterCommerce has somehow committed fraud because it represented that it owns the MONSTER Family of Marks, while Network Solutions, its parent company, owns two of the MONSTER Family of Marks. The Board has already found that MonsterCommerce is a wholly-owned subsidiary of Network Solutions, and that Network Solutions controls MonsterCommerce’s assets. Further, the Patent and Trademark Office “will consider the filing of the application in the name of either the parent or the subsidiary to be the expression of the intention of the parties as to ownership in accord with the arrangements between them.” TMEP § 1201.03(c). The fact that MonsterCommerce is the owner of the registration for some of the marks of the MONSTER Family of Marks, and its parent company is the owner of the registration for other marks of the MONSTER Family of Marks, is of no moment. Such an arrangement between a parent and its wholly-owned subsidiary is proper, and does not constitute fraud, which the Board has already found -- twice.

For the forgoing reasons, the Board should strike Applicant’s Fifth Affirmative Defense from the pleadings.

D. Applicant’s Second Affirmative Defense of Equitable Estoppel Should Be Stricken Because MonsterCommerce Timely Opposed the Application

Applicant has asserted that MonsterCommerce “is barred from filing or prosecuting the Second Amended Notice of Opposition pursuant to the defense of equitable estoppel, in that [MonsterCommerce] has had an active business relationship with [sic] since at least as early as 2002, when [MonsterCommerce] purchased product from www.templatemonster.com, and later, in 2003 became an affiliate of

www.templatemonster.com, with the account being registered to the then president of [MonsterCommerce], Ryan Noble, whose e-mail address, at all relevant times, was ryan@monstercommerce.com.”

The defense of equitable estoppel¹ is a defense to the registration of a mark, not to the use of a mark. Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc., 971 F.2d 732, 734 (Fed. Cir. 1992); Callaway Vineyard & Winery v. Endsley Capital Group Inc., 63 U.S.P.Q.2d 1919, 1923 (TTAB 2002). Accordingly, the defense of estoppel does not start running until the date the application for registration was published for opposition. Lincoln Logs, 971 F.2d at 734; Callaway, 63 U.S.P.Q.2d at 1923. MonsterCommerce’s conduct between the time an applicant begins using its mark and the time the mark is published for opposition is irrelevant.

Applicant’s mark was published for opposition on May 30, 2006.

MonsterCommerce timely filed its Notice of Opposition on September 27, 2006, after securing proper and timely extensions of time in which to oppose. “[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. The same principle holds true here. Applicant has no basis to assert the defense of equitable estoppel because MonsterCommerce promptly opposed the application to register the mark TEMPLATEMONSTER. Additionally, Applicant’s affirmative defense of equitable estoppel fails because the alleged conduct giving rise to the Applicant’s equitable estoppel defense purportedly occurred between the time Applicant began using the TEMPLATEMONSTER mark

¹ 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).

and the time the application was published for opposition. Accordingly, the affirmative defense of equitable estoppel should be stricken from the pleadings.

E. Applicant’s Third Affirmative Defense Referring to the Alleged Knowledge of the “Corbis Action Court” Should Be Stricken Because it Does Not Provide Fair Notice of an Affirmative Defense.

Applicant’s Third Affirmative Defense that “the Corbis and the Corbis Action court were at all times aware of the pending trademark application to Lognikov” is vague and does not provide fair notice of an affirmative defense. An affirmative defense may be stricken if it is insufficient as a matter of law, is immaterial or if it does not fairly present a question of law or fact which the Board ought to hear. See Fed. R. Civ. P. 12(f).

Applicant’s Third Affirmative Defense appears to relate to MonsterCommerce’s claim that Applicant is not the owner of the TEMPLATEMONSTER mark, and that Applicant committed fraud upon the Patent and Trademark Office by asserting in the Application that he is the owner of the mark, as evidenced by his statements to the federal district court in the Corbis Action. At best, Applicant’s Third Affirmative Defense is an argument in support of Applicant’s denial that he is not the owner of the applied-for mark. Even this, however, seems tenuous since the federal district court’s awareness of Applicant’s pending application for the TEMPLATEMONSTER mark is irrelevant to whether Applicant is truly the owner of the mark and whether the Application was executed fraudulently. MonsterCommerce is puzzled by Applicant’s Third Affirmative Defense, and submits that it is insufficient as a matter of law, is immaterial and does not fairly present a question of law or fact. Accordingly, Applicant’s Third Affirmative Defense should be stricken from the pleadings.²

² To the extent that Applicant argues that the “affirmative defense” amounts to an amplified denial under TBMP § 311.02(d) in the nature of an argument in support of a denial, it should not be treated as an affirmative defense, and should be stricken

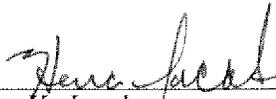
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CONCLUSION

To reargue and re-litigate issues that have already been resolved is a waste of both the resources of the Board and of the parties. Accordingly, Applicant's Affirmative Defenses 1-5 should be stricken and Applicant should be prohibited from rearguing any of these issues during the remainder of the proceeding. Additionally, MonsterCommerce respectfully requests that the proceedings be suspended pending the Board's decision on the instant motion.

Respectfully submitted,

Date: April 7, 2008

By:  _____
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(...continued)

accordingly. See Humana Inc. v. Humanomics Inc., 3 U.S.P.Q.2d 1696, 1697 n.5 (TTAB 1987); The Maytag Co. v. Luskin's, Inc., 228 U.S.P.Q. 747, 747 n.3 (TTAB 1986).

CERTIFICATE OF SERVICE

I, Troy E. Larson, hereby certify that on today's date, I caused a copy of the foregoing MonsterCommerce's Motion to Strike Applicant's Affirmative Defenses in its Answer to the Second Amended Notice of Opposition to be served by United States First Class mail, postage prepaid, on counsel for Applicant as set forth below:

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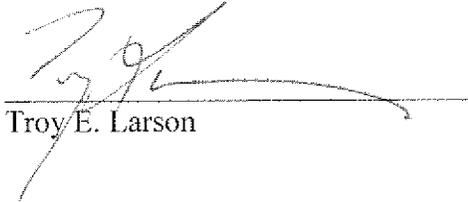

Troy E. Larson

EXHIBIT A

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.

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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.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 TEMP Section 206.02 (2d ed. rev. 2004).

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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).

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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.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.

EXHIBIT B

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

Baxley

Mailed: May 11, 2007

Opposition No. 91173189

Monstercommerce, LLC

v.

Igor Logniko

Andrew P. Baxley, Interlocutory Attorney:

On March 5, 2007, the Board issued an order wherein it suspended this case pending disposition of applicant's motion to amend involved application Serial No. 78612360, opposer's motion for partial judgment on the pleadings, opposer's motion to compel discovery, and opposer's motion for leave to file a second amended notice of opposition. In that order, the Board indicated that the parties should not file any submission which is not germane to those motions.

On May 8, 2007, applicant filed a motion for relief from the Board's December 13, 2006 order. To the extent that applicant requests relief from the December 13, 2006 order, the motion is untimely because any request for reconsideration of that order was due by not later than January 16, 2007. See Trademark Rules 2.127(b) and 2.196. Further, because the motion for relief presents new arguments and evidence in support of applicant's contention

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that this proceeding should be dismissed, the motion for relief is actually a renewed motion to dismiss under Fed. R. Civ. P. 12(b)(1). See TBMP Section 518 (2d ed. rev. 2004). The Board will treat the renewed motion to dismiss accordingly.

A review of the renewed motion to dismiss indicates that it involves different issues from those in the motions which prompted the March 5, 2007 suspension order. As such, it is not germane to those motions and was thus filed in contravention of the suspension order. Nonetheless, inasmuch as the renewed motion to dismiss is potentially dispositive of this proceeding and could render moot all of the remaining pending motions herein, the Board finds that, in the interest of judicial economy, the renewed motion to dismiss should be fully briefed prior to the Board's decision on the remaining pending motions. Accordingly, opposer is allowed until twenty days from the mailing date of this order to file a brief in response to the renewed motion to dismiss. Applicant's reply brief is due in accordance with Trademark Rules 2.119(c) and 2.127(a).

The parties are directed, however, not to file any further motions until the motions currently pending before the Board in this proceeding have been decided. See TBMP Section 527.03 (2d ed. rev. 2004).

EXHIBIT C

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>