

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

Baxley

Mailed: September 25, 2008

Opposition No. **91173189**

MonsterCommerce, LLC and
Network Solutions, LLC (joined
as a party plaintiff)

v.

Igor Lognikov

By the Trademark Trial and Appeal Board:

This case now comes up for consideration of: 1) MonsterCommerce, LLC's ("Monster") motion (filed April 7, 2008) to strike affirmative defenses from applicant's answer to the second amended notice of opposition; and 2) Monster's motion (filed May 9, 2008) to join its parent company, Network Solutions, LLC ("Network"), as a party plaintiff. The motions have been fully briefed.

The Board turns first to the motion to join Network as a party plaintiff. Monster's motion is based on the assignment of pleaded Registration No. 2947268 from Monster to its parent company Network during the pendency of this proceeding. A document reflecting that assignment is recorded with the USPTO's Assignment Branch at Reel 3767, Frame 0954.

The Board is not persuaded by applicant's assertion that joinder of Network is improper because the registration issue is not relied upon in support of the claims herein. Although the second amended notice of opposition could have been more clearly drafted, the Board construes the second amended notice of opposition as including the MONSTERCOMMERCE mark, which is subject of that registration, among opposer's pleaded family of marks. Further, opposer expressly relies upon that registration to allege priority.

In view of the assignment of pleaded Registration No. 2947268 to Network during the pendency of this proceeding and the recordation of a document reflecting that assignment with the USPTO's Assignment Branch at Reel 3767, Frame 0954, the Board finds that joinder of Network as a party plaintiff is appropriate. See TBMP Section 512.01 (2d ed. rev. 2004). Accordingly, the motion to join Network is granted.

The Board will next consider the motion to strike affirmative defenses from applicant's answer to the second notice of opposition. Those affirmative defenses are set forth in relevant part as follows:

1. The Second Amended Notice of Opposition fails to state a claim upon which relief can be granted.
2. [Monster] is barred from filing or prosecuting the Second Amended Notice of Opposition pursuant to the defense of equitable estoppel, in that [Monster] has had an active business relationship with [sic] since at least as early as 2002, when [Monster] purchased product from

www.templatemonster.com, and later, in 2003 became an affiliate of www.templatemonster.com...

3. [] Corbis and the Corbis Action court were at all times aware of the pending trademark application to Lognikov.

4. The TTAB lacks subject matter jurisdiction over the Second Amended Notice of Opposition.

5. [Monster] has committed fraud in connection with this Second Amended Notice of Opposition 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 Serial No. 76/658,138), and MONSTERMARKETPLACE, U.S. Reg. No. 3,361,201, as both marks are identified by the [USPTO] as being owned by Network Solutions LLC; and as a result of this fraud, [Monster] has committed unclean hands.

Upon motion, or upon its own initiative, the Board may order stricken from a pleading any insufficient claim or defense or any redundant, immaterial, impertinent, or scandalous matter. See Fed. R. Civ. P. 12(f). A defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. See TBMP Section 506.01 (2d ed. rev. 2004).

Regarding the first affirmative defense of failure to state a claim upon which relief can be granted, the Board notes initially that it determined in a February 13, 2008 that the second amended notice of opposition sets forth legally sufficient claims. See also *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221

(TTAB 1995). Accordingly, the Board incorporates the earlier determination by reference and hereby strikes the first affirmative defense.

Regarding the second affirmative defense of equitable estoppel, to set forth a sufficient 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). Even if we assume that opposer and applicant had a business and later affiliate relationship, that by itself is an insufficient pleading of an affirmative defense of equitable estoppel because it does not specifically identify conduct in the course of their relationship that would have led applicant to infer that opposer would not oppose registration of the involved mark. Accordingly, the Board hereby strikes the second affirmative defense.

Though not clearly set forth, the Board construes the third affirmative defense as asserting that opposer is precluded from pursuing this opposition because the United States District Court for the Southern District of Florida, in which the civil action styled *Corbis Corp. v. Lognikov, et al*, Case No. 06-21643, was filed and the plaintiff in that civil action both were aware of applicant's involved

application.¹ The Board notes initially that the parties do not assert that Corbis Corporation is in privity with either opposer. In addition, the claims in that civil action were based on allegations of copyright infringement and Racketeer Influenced And Corrupt Organizations Act (RICO) violations and did not ask for denial of registration of the mark in applicant's application. Because the civil action involved different parties, different claims, and a different set of transactional facts, the doctrine of *res judicata* or claim preclusion is inapplicable. See *Jet Inc. v. Sewage Aeration Systems*, 55 USPQ2d 1854 (Fed. Cir. 2000). Further, because no issues regarding the registrability of applicant's involved mark were litigated in the civil action, the doctrine of collateral estoppel or issue preclusion is also inapplicable. See *Polaroid Corp. v. C & E Vision Services Inc.*, 52 USPQ2d 1954 (TTAB 1999). Based on the foregoing, the Board hereby strikes the third affirmative defense.

We turn next to the fourth affirmative defense that the Board lacks subject matter jurisdiction over the second

¹ The nonownership claim that opposer added by way of the second amended notice of opposition is based on certain representations that applicant made in that civil action.

A copy of the complaint in the civil action was included as an exhibit to Monster's motion for leave to file a second amended notice of opposition. A review of the docket report for the civil action, which Monster included with its reply brief in support of the motion for leave to file a second amended notice of opposition indicates that all claims against applicant, as one of the defendants in the civil action, were dismissed with prejudice on October 3, 2006 by stipulation of the parties.

amended notice of opposition. The Board already determined in a December 13, 2006 order that it has subject matter jurisdiction over this proceeding in view of Monster's timely filing of the notice of opposition. The Board further determined in the February 13, 2008 order that opposer's second amended notice of opposition is the operative complaint herein. Accordingly, we incorporate the earlier determinations by reference and hereby strike the fourth affirmative defense.

Further, in view of our joinder of Network, of which Monster is a wholly-owned subsidiary, as a party plaintiff earlier in this order, the fifth affirmative defense of unclean hands based on Network's allegedly false claim of ownership of Registration No. 3361201 and pleaded application Serial No. 76658138 is moot and therefore stricken.²

In view thereof, opposer's motion to strike is granted. Proceedings herein are resumed. Discovery and testimony periods are reset as follows.

DISCOVERY PERIOD TO CLOSE:

December 5, 2008

² To the extent that applicant, by way of the fifth affirmative defense, challenges the validity of Network's registration for the MONSTERMARKETPLACE mark, the Board notes that such mark is the subject of Registration No. 3361203, not Registration No. 3361201, and that opposers do not rely upon that registration in support of their claims herein. Further, any challenge to the validity of that registration is a collateral attack on that registration, which can only be raised through a counterclaim or a separate petition to cancel that registration. See Trademark Rule 2.106(b)(2)(c); TBMP Section 313.01 (2d ed. rev. 2004).

Plaintiff's 30-day testimony period to close: **March 5, 2009**

Defendant's 30-day testimony period to close: **May 4, 2009**

Plaintiff's 15-day rebuttal testimony period to close: **June 18, 2009**

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.