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

Proceeding	91173189
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were adopted by the court and ultimately staved off a contempt order against him, cannot be contradicted by Applicant in this proceeding under the doctrine of judicial estoppel. Because Applicant is not the owner of the mark he seeks to register, his application is void and judgment should be entered sustaining this Opposition proceeding.

Second, Applicant committed fraud on the Trademark Office when he misrepresented the fundamentally material facts that he was the owner of the TEMPLATEMONSTER mark and that he was using the mark in commerce. Having represented the exact opposite facts to the federal district court in Florida, it is incontrovertible that Applicant knew or should have known that his representations to the Trademark Office were false. Applicant's fraudulent conduct on the Trademark Office voids his application for the TEMPLATEMONSTER mark and necessitates entry of judgment sustaining this Opposition.

II. STATEMENT OF UNDISPUTED FACTS

Applicant, Igor Lognikov, filed the application for the TEMPLATEMONSTER mark on April 19, 2005, claiming himself as the "applicant" and "owner." (Lognikov Application Serial No. 78612360 ("Application"), Exh. 1 to Jacobs Declaration which is attached hereto as Exhibit A.) The Application states, "The Applicant, or the applicant's related company or licensee, is using the mark in commerce" (*Id.*) As the specimen for the Application, Lognikov submitted a digital image of the home page from the website www.templatemonster.com with the following declaration: "The applicant is submitting one specimen for each class showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a digital image of a webpage that is currently used in commerce." (*Id.*) Applicant declared the following in his application:

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false

statements, and the like, may jeopardize the validity of the application or any resulting registration, **declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered**, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that **all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.**

(Id.) (emphasis added).

Based on Applicant's representation that he was the owner of the mark TEMPLATEMONSTER and that Applicant or a related company or licensee was using the mark in commerce on the website located at www.templatemonster.com, the Trademark Office approved the application for publication. (Notice of Publication, Exh. 2 to Jacobs Decl.)

On June 28, 2006, Corbis Corporation ("Corbis"), filed a Complaint and motion for preliminary injunctive relief in the United States District Court for the Southern District of Florida against Lognikov, templatemonster.com, and various other website entities alleging that they had engaged in a vast conspiracy to pirate Corbis' copyrighted photographic images (the "Corbis Action"). (Corbis Complaint, Exh. 3 to Jacobs Decl.) Richard S. Ross, counsel for Applicant in this proceeding, represented Lognikov, templatemonster.com, and some of the other defendants in the Corbis Action.

On July 6, 2006, the court granted Corbis' motion for a temporary restraining order and preliminary injunction (the "Order"). (Order dated July 6, 2006, Exh. 4 to Jacobs Decl.) As part of the Order, the court froze defendants' assets, including those of Lognikov and

templatemonster.com, and ordered the defendants to take down all of the images owned by Corbis from the www.templatemonster.com website. (*Id.* at pp. 2-7, Exh. 4. to Jacobs Decl.)

On July 25, 2006, Corbis filed a motion for order to show cause why the defendants were not in contempt of the court's Order, alleging multiple violations of the court's extant Order.¹ (Motion for Order to Show Cause, Exh. 5 to Jacobs Decl.) Corbis' alleged violations of the court's Order included: (1) defendants continued to market and publish pirated copies of Corbis' images on the www.templatemonster.com website, and (2) defendants transferred the TEMPLATEMONSTER.COM domain name to a registrar in Russia. (Mem. of Points and Auth. in Support of Corbis Motion at p. 15, Exh. 6 to Jacobs Decl.)

Lognikov, [templatemonster.com](http://www.templatemonster.com) and certain of the other defendants filed their response to Corbis' motion on August 7, 2006 ("Lognikov Response"). (Lognikov Response, Exh. 7 to Jacobs Decl.) The responding defendants urged the court to group the responding defendants into two categories because, they argued, it would be inappropriate to penalize some defendants for noncompliance by other defendants. (Lognikov Response at p. 1, Exh. 7 to Jacobs Decl.) The first category, the "Lognikov Defendants," consisted of **Lognikov**, Web Design Library and Artvertex, Inc. (*Id.*) The second category, the "Template Defendants," consisted of **templatemonster.com**; [templatetuning](http://templatetuning.com); template-help.com; templatedelivery.com; mytemplatestorage.com; site2you.com; and Callaway Alliance, Inc. (*Id.*) A critical aspect of Lognikov's strategy was separating himself from [templatemonster.com](http://www.templatemonster.com) and the other Template Defendants. This strategy enabled Lognikov to defend the contempt allegation by arguing that he had no control over the www.templatemonster.com website or the

¹ The court treated the motion "as one seeking a finding of contempt and the imposition of sanctions (as opposed to one seeking an order to show cause)." (Order Denying Corbis Motion at p. 8, Exh. 10 to Jacobs Decl.)

TEMPLATEMONSTER.COM domain name, and therefore, could not be responsible for failing removing images from the website or transferring the domain name. (Lognikov Response at p. 9, 10 n. 8, 12, 15, Exh. 7 to Jacobs Decl.)

To support his argument that the Lognikov Defendants were not responsible for the alleged violations of the Order, Lognikov made several pointed representations to the federal district court about his relationship (or lack thereof) with templatemonster.com and the other Template Defendants. Corbis alleged that defendants violated the court's Order by continuing to market and publish pirated copies of Corbis' images on the www.templatemonster.com website. (Mem. of Points and Auth. in Support of Corbis Motion at 15, Exh. 6 to Jacobs Decl.; Pirri Decl. ¶ 27, Exh. 8 to Jacobs Decl.). Lognikov opposed Corbis' motion arguing that Lognikov had no business relationship with templatemonster.com and the other Template Defendants:

Corbis is absolutely incorrect in its allegation in Paragraph 14 regarding the Lognikov Defendants. Mr. Lognikov is a writer, and does not have a business relationship with the Template Defendants, other than to link his Web Design Library to the Template Defendants website.

(Lognikov Response at p. 9, Exh. 7 to Jacobs Decl.)

Corbis also alleged that the Lognikov Defendants and Template Defendants were in violation of the provision of the court's Order freezing their assets because the TEMPLATEMONSTER.COM domain name was transferred from one register to another in Russia. (Mem. of Points and Auth. in Support of Corbis Motion at 14-15, Exh. 6 to Jacobs Decl.; Pirri Decl. ¶¶ 2-4, Exh. 8 to Jacobs Decl.) Lognikov opposed Corbis' motion arguing that he had no control over the TEMPLATEMONSTER.COM domain name and no control over its registration. (Lognikov Response at p. 12, Exh. 6 to Jacobs Decl.) ("The Defendants explained to Corbis on July 13, 2006, Exhibit E, that they did not own the domain name, and had no

control over its registration.”) To support this representation, Lognikov attached a copy of an email from his counsel Richard Ross, Esq. to Corbis’ counsel Laura Pirri, Esq., which states:

The domain name www.templatemonster.com was transferred by its owner, a non party. Our clients have no control over the owner. . . . You also need to be made aware that the Template Defendants are wholly distinct from Ultravertex, and Mr. Lognikov has no business involvement with either the Template Defendants or Ultravertex.

(Perri E-Mail, Exhibit E to Lognikov Response, Exh. 9 to Jacobs Decl.)

Taken together, Lognikov’s representations to the federal district court attest that Lognikov has no business relationship or involvement with the website located at www.templatemonster.com and that Lognikov is not the registrant of and exercises no control over the domain name TEMPLATEMONSTER.COM.

On August 11, 2006, the United States District Court for the Southern District of Florida denied Corbis’ motion for order to show cause why the defendants were not in contempt of the court’s Order. (Order Denying Corbis Motion, Exh. 10 to Jacobs Decl.) Relying on Lognikov’s representations, the court noted that “regardless of the nature of Defendants’ relationships, there is no clear and convincing evidence that all of the Defendants are capable of controlling the actions of all other Defendants.” (Order Denying Corbis Motion, at p. 10, n. 5, Exh. 10.)

III. ARGUMENT

The Board may grant summary judgment where “the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c); TBMP § 528.01. The moving party’s burden is to demonstrate the absence of any genuine issue of material fact, and that it is entitled to judgment

as a matter of law. TBMP § 528.01. Where the moving party meets its burden, “the non-moving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial.” Id.

There is no genuine issue of material fact to preclude summary judgment because the undisputed facts establish that Applicant is not the owner of the TEMPLATEMONSTER mark, and that Applicant committed fraud on the Trademark Office when he misrepresented to the Trademark Office that he was the owner of the mark. Accordingly, MonsterCommerce is entitled to judgment sustaining the opposition as a matter of law.

A. Applicant’s Application is Void Because He Is Not the Rightful Owner of the Applied for Mark

The Trademark Act requires that an application to register a mark be filed with the Trademark Office by the owner thereof. 15 U.S.C. § 1051(a)(1). The Board cannot waive this statutory requirement, and cannot excuse noncompliance with it. Huang v. Tzu Chen Food Co. Ltd., 7 U.S.Q.P.2d 1335, 1336 (Fed. Cir. 1988). An application that is not filed by the owner is void. 37 C.F.R. 2.71(d); TMEP § 1201.02(b).

The owner of a mark is either the person who applies the mark to goods that he or she produces, or uses the mark in the sale or advertising of services that he or she performs.

TMEP § 803.01. An applicant may base its claim of ownership of a mark on: (1) its own exclusive use of the mark; (2) use of the mark solely by a related company whose use inures to the applicant’s benefit; or (3) use of the mark by both the applicant and by a related company.

TMEP § 1201.01. A related company is any person whose use of the mark is controlled by the owner with respect to the nature and quality of the goods and services on or in connection with which the mark is used. 15 U.S.C. § 1127.

The Board will sustain an opposition where the applicant is not (and was not at the time of the filing of its application for registration) the rightful owner of the applied for mark. TBMP § 309.03(c)(8); Great Seats, Ltd. v. Great Seats, Inc., 84 U.S.P.Q.2d 1235, 1244 (TTAB 2007) (petition to cancel granted where application was not filed by the owner of the mark and was deemed void *ab initio* under 15 U.S.C. §1551(a)); American Forests v. Barbara Sanders, 54 U.S.P.Q.2d 1860 (TTAB 1999) (opposition sustained where ITU application filed by individual was deemed void because actual entity possessing bona fide intent to use the mark was partnership, not individual).

In Great Seats, the ‘410 Corporation began using the GREAT SEATS mark in 1995. Great Seats, 84 U.S.P.Q.2d at 1237-38. Two years later, a separate company called the ‘660 Corporation filed an application for GREAT SEATS. Id. at 1238. All use of the mark as of the filing date of the application was use by the ‘410 Corporation, not the ‘660 Corporation. Id. at 1238-39. There was no evidence that the ‘410 Corporation’s use of the mark was controlled by the ‘660 Corporation. Id. at 1241. Because the ‘660 Corporation did not use the mark, and did not control the ‘410 Corporation’s use of the mark, the Board held that “the applicant ‘660 Corporation was not the owner of the mark as of the application filing date, and the application it filed therefore is void *ab initio* under Section 1(a).” Id. at 1244.

Similarly, in American Forests, the Board found that the applicant, an individual, could not have been the owner of the mark because, as applicant admitted, the only bona fide intent was for the mark to be used by applicant in partnership with another person, and not by applicant alone as an individual. American Forests, 54 U.S.P.Q.2d at 1864. Accordingly, the Board found the application void *ab initio*. Id.

Applicant's representations to the federal district court in the Corbis Action conclusively establish that he is not the owner of the TEMPLATEMONSTER mark. Applicant represented to the federal district court that he does not operate the www.templatemonster.com website, does not control the domain name TEMPLATEMONSTER.COM, and has no affiliation with the entities that do operate the website and control the domain name. (Lognikov Response at p. 9, 10, n. 8, 12, 15, Exh. 7 to Jacobs Decl.; Perri E-Mail, Exh. 9 to Jacobs Decl.) Because Applicant does not operate the www.templatemonster.com website or control the TEMPLATEMONSTER.COM domain name, he himself cannot be using the TEMPLATEMONSTER mark in commerce. Because Applicant is not affiliated with the entities that operate the website and control the domain name, Applicant cannot be using the mark through a related company or licensee. Simply put, Applicant has no use of the TEMPLATEMONSTER mark on which to base a claim of ownership.

Like the applicants in Great Seats and American Forests, Applicant is not and cannot be, the rightful owner of the mark. Huang, 849 F.2d at 1460; Great Seats, 84 U.S.P.Q.2d at 1244; American Forests, 54 U.S.P.Q.2d at 1864. As a result, the application filed by Applicant is void *ab initio*, and summary judgment should be entered sustaining the opposition. 37 C.F.R. 2.71(d); TMEP § 1201.02(b).

B. Applicant Committed Fraud on the Trademark Office in Attempting to Procure a Registration for a Mark Applicant Did Not Own and Did Not Use

“A trademark applicant commits fraud in procuring a registration when it makes material representations of fact in its declaration which it knows or should know to be false or misleading.” Medinol Ltd. v. Neuro Vasx Inc., 67 U.S.P.Q.2d 1205, 1209 (TTAB 2003). Both knowingly inaccurate statements and knowingly misleading statements constitute fraud. Metro Traffic Control, Inc. v. Shadow Network, Inc., 41 U.S.P.Q.2d 1369, 1373 (Fed. Cir. 1997).

“Proof of actual intent to commit fraud is not required, rather, fraud occurs when an applicant or registrant makes a false material representation that the applicant or registrant knew or should have known was false.” Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha, 77 U.S.P.Q.2d 1917, 1928 (TTAB 2006) (citing Medinol, 67 U.S.P.Q.2d at 1209). “If fraud can be shown in the procurement of a registration, the entire resulting registration is void.” Medinol, 67 U.S.P.Q.2d at 1208.

The Board has held that signing an oath in a trademark application claiming belief as to trademark ownership when applicant knew or should have known he did not own the mark constitutes fraud on the Trademark Office. Global Maschinen GmbH v. Global Banking Systems, 227 U.S.P.Q. 862, 867-68 (TTAB 1985). Likewise, a declaration by an applicant that it is using the mark in commerce when applicant knew or should have known it was not using the mark in commerce constitutes fraud on the Trademark Office. Medinol, 67 U.S.P.Q.2d at 1208.

1. Applicant’s Declarations to the Trademark Office Were False

Applicant committed fraud on the trademark office when he filed his application in two ways. First, in his application to register the mark TEMPLATEMONSTER, Applicant made the following false declaration to the Trademark Office with regard to his ownership of the mark:

[Applicant] “...declares that he/she is properly authorized to execute this application on behalf of applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered...and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.”

(Application, Exh. 1 to Jacobs Decl.)

Second, Applicant made the following false declarations to the Trademark Office with regard to his use of the mark in commerce:

“The applicant, or the applicant’s related company or licensee, is using the mark in commerce...”

“The applicant is submitting one specimen for each class showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a digital image of a webpage that is currently used in commerce.”

(Application, Exh. 1 to Jacobs Decl.)

Applicant’s representations to the Trademark Office that he is the owner of the mark and is using the mark in commerce were false. As discussed in section I, supra, shortly after making the declaration to the Trademark Office that he was the owner of the mark and was using the mark in commerce on the website www.templatemonster.com, Applicant represented to a federal district court that he does not operate the www.templatemonster.com website, does not control the domain name TEMPLATEMONSTER.COM, and has no affiliation with the entities that do operate the website and control the domain name. (Lognikov Response at p. 9, 10, n. 8, 12, 15, Exh. 7 to Jacobs Decl.; Perri E-Mail, Exh. 9 to Jacobs Decl.) Applicant’s representations to the federal district court are an admission that Applicant is not the rightful owner of the TEMPLATEMONSTER mark and never used the mark in commerce. Based on Applicant’s express representations to the federal district court, Applicant’s declarations to the Trademark Office were false.

2. Applicant’s False Statements to the Trademark Office Were Material

Applicant’s misrepresentations to the Trademark Office were material.

Materiality is apparent on its face where disclosure of the false statement would have resulted in refusal of a registration. See Global Maschinen GmbH, 227 U.S.P.Q. at 868; Standard Knitting Ltd., 77 U.S.P.Q.2d at 1927. The Trademark Office relies on an applicant’s declarations to determine whether to register trademarks. Standard Knitting, 77 U.S.P.Q.2d at 1928, n.14.

Applicant’s misrepresentations to the Trademark Office were material because disclosure to the

Trademark Office that Applicant is not the owner of and does not use the mark in commerce would have resulted in refusal of registration based on Section 1 of the Trademark Act.

3. Applicant Knew or Should Have Known His Declarations Were False

Applicant knew or should have known his declarations to the Trademark Office were false. “Proof of actual intent to commit fraud is not required, rather, fraud occurs when an applicant or registrant makes a false material representation that the applicant or registrant knew or should have known was false.” Standard Knitting, 77 U.S.P.Q.2d at 1928. Statements of use made in connection with a trademark application “are made with such degree of solemnity [that they] are – or should be – investigated thoroughly prior to signature and submission to the USPTO.” Medinol, 67 U.S.P.Q.2d at 1209. Applicant declared to the Trademark Office that he was the owner of the TEMPLATEMONSTER mark and was using the mark in commerce on the www.templatemonster.com website. (Application, Exh. 1 to Jacobs Decl.) Applicant knew these declarations to be false because, as Applicant has admitted, he does not operate the www.templatemonster.com website, does not control the domain name TEMPLATEMONSTER.COM, and has no affiliation with the entities that do operate the website and control the domain name. (Lognikov Response at p. 9, 10, n. 8, 12, 15, Exh. 7 to Jacobs Decl.; Perri E-Mail, Exh. 9 to Jacobs Decl.) The undisputed facts in this case establish that Applicant knew or should have known at the time he submitted his application that he was not the owner of the mark and did not use the mark in commerce.

Given Applicant’s express statements to the federal district court, there are no genuine issues of material fact that Applicant made material misrepresentations of fact in his declaration that he was the owner of the TEMPLATEMONSTER mark and was using it in commerce. Accordingly, Applicant committed fraud on the Trademark Office in attempting to

procure his registration. The application is therefore void, and summary judgment should be entered sustaining the opposition.

C. Judicial Estoppel Precludes Applicant from Contradicting His Statements to the Federal District Court

The doctrine of judicial estoppel precludes Applicant from contradicting in this Opposition the statements he made to the federal district court in the Corbis Action to avoid the entry of an order for contempt.

Judicial estoppel is an equitable doctrine that prohibits a party who took one position in an earlier proceeding from pursuing a directly inconsistent position in a subsequent proceeding. State of New Hampshire v. State of Maine, 532 U.S. 742, 751, 121 S. Ct. 1808, 149 L. Ed. 2d 968 (2001). Courts have uniformly recognized that the purpose of the doctrine of judicial estoppel is “to protect the integrity of the judicial process.” State of New Hampshire, 532 U.S. at 751 (internal citations omitted). The doctrine is directed to the preservation of the integrity of judicial proceedings by protecting against litigants who “play fast and loose with the courts,” and is intended to protect the courts rather than the litigants. U.S. Philips Corp. v. Sears Roebuck & Co., 55 F.3d 592, 596-97 (Fed. Cir. 1995) citing In re Cassidy, 892 F.2d 637, 641 (7th Cir. 1990) cert. denied, 498 U.S. 812, 111 S. Ct. 48, 112 L. Ed. 2d 24 (1990).

The principal factors that courts consider in determining whether to apply the doctrine of judicial estoppel are: (1) whether the party’s later position is “clearly inconsistent” with its earlier position; (2) whether the party has succeeded in persuading a court to accept that party’s earlier position, so that judicial acceptance of an inconsistent position in a later proceeding would create the perception that either the first or second court was misled; and (3) whether the party seeking to assert an inconsistent position would derive an unfair advantage or impose an unfair detriment on the opposing party if not estopped. State of New Hampshire, 532

U.S. at 751. Because the doctrine protects the courts rather than the litigants, the third factor, prejudice to the opponent from the change in position, is not a necessary element of judicial estoppel. In re Cassidy, 892 F.2d at 641, n.2. Additional factors should also be considered depending on the specific factual contexts. State of New Hampshire, 532 U.S. at 751.

The doctrine of judicial estoppel should be applied here because Applicant's conduct amply satisfies the foregoing relevant factors.

**1. Applicant's Later Position is
"Clearly Inconsistent" with His Earlier Position**

Applicant's position in the federal district court litigation was that he does not operate the www.templatemonster.com website, does not control the domain name TEMPLATEMONSTER.COM, and has no affiliation with the entities that do operate the website and control the domain name. (Lognikov Response at p. 9, 10 n. 8, 12, 15, Exh. 7 to Jacobs Decl.; Perri E-Mail, Exh. 9 to Jacobs Decl.) Applicant's current position is that he uses the mark TEMPLATEMONSTER.COM in commerce on the website www.templatemonster.com, and is therefore the owner of the TEMPLATEMONSTER mark. (Application, Exh. 1 to Jacobs Decl.) These positions are clearly inconsistent because Applicant cannot at the same time represent that he is the owner of the mark based on use of the mark in commerce on the www.templatemonster.com website, and represent that he does not operate the website, does not control the domain name, and has no affiliation with the entities that do operate the website and control the domain name. Applicant's earlier position is clearly inconsistent with his current position. Thus, the first factor for applying the doctrine of judicial estoppel is fulfilled.

2. Applicant Succeeded in Persuading the Federal District Court to Accept his Earlier Position

Applicant succeeded in persuading the federal district court to accept his position that he had no control over the www.templatemonster.com website or the TEMPLATEMONSTER.COM domain name, and no affiliation with the entities that did control the website and domain name. In his argument opposing Corbis' motion to find Applicant and the other defendants in violation of the court's preliminary injunction Order, Applicant argued that he did not violate the Order requiring him to cease marketing and publishing pirated copies of Corbis' images on the www.templatemonster.com website, and not transfer the TEMPLATEMONSTER.COM domain name because he had no relationship with the defendants that actually controlled the website and/or the domain name. (Lognikov Response at p. 9, 10 n. 8, 12, 15, Exh. 7 to Jacobs Decl.; Perri E-Mail, Exh. 9 to Jacobs Decl.) The federal district court denied Corbis' motion.² (Order Denying Corbis Motion, Exh. 10 to Jacobs Decl.) In doing so, the court accepted Applicant's representations noting that "regardless of the nature of Defendants' relationships, there is no clear and convincing evidence that all of the Defendants are capable of controlling the actions of all other Defendants." (Order Denying Corbis Motion at p. 10, n. 5, Exh. 10 to Jacobs Decl.) The Board's acceptance of Applicant's fundamentally inconsistent position in this proceeding would create the perception that either the Board or the district court was misled, a central policy reason for the invocation of the judicial estoppel doctrine. See State of New Hampshire, 532 U.S. at 755 ("were we to accept New Hampshire's

² It appears that the Corbis Action ultimately settled. Applicant need not finally prevail to be estopped from changing a successful position on a preliminary matter. In re Cassidy, 892 F.2d at 641.

latest view, the risk of inconsistent court determinations would become a reality . . . [and we cannot do so] without undermining the integrity of the judicial process”).

3. Other Factors Weigh in Favor of Estopping Applicant from Reversing His Position

The Board should consider additional factors particular to the facts of this case that strongly favor the application of the doctrine of judicial estoppel. The Supreme Court did “not establish inflexible prerequisites or an exhaustive formula for determining the applicability of judicial estoppel . . . additional considerations may inform the doctrine’s application in specific factual contexts.” State of New Hampshire, 532 U.S. at 751.

First, the Board should consider that Applicant’s earlier position was made in an attempt to avoid a finding of contempt for violation of a court Order. The ability to vindicate the authority of courts to enforce its own orders is paramount. Young v. U.S. ex rel. Vuitton et Fils S.A., 481 U.S. 787, 796, 107 S. Ct. 2124, 95 L. Ed. 2d 740 (1987) (“The ability to punish disobedience to judicial orders is regarded as essential to ensuring that the Judiciary has a means to vindicate its own authority without complete dependence on other Branches.”). Applicant’s inconsistent prior representations to the federal district court are particularly egregious in this case because Applicant may have convinced the district court not to enforce its own Order. If Applicant reverses his position now, the district court may be viewed as having been misled into failing to enforce its own order, an essential component of vindicating its judicial authority. In its discretion whether to apply the doctrine of judicial estoppel, the Board should consider that Applicant made his earlier inconsistent statements in an effort to convince a federal court that Applicant was in compliance with a court order.

Second, the Board should consider that counsel for Applicant in this proceeding likewise represented him in the Corbis Action. Applicant’s attorney here filed the pleading in

the Corbis Action in which Applicant represented to the federal district court that Applicant does not operate the www.templatemonster.com website, does not control the domain name www.templatemonster.com, and has no affiliation with the entities that do operate the website and control the domain name. (Lognikov Response, Exh. 7 to Jacobs Decl.) The same attorney represents Applicant in this proceeding. Given that Applicant's attorney is fully aware of Applicant's position in the Corbis Action and the statements made to the court in furtherance of that position, Applicant should not be permitted to take an opposite position because it now furthers his interest to claim control over the www.templatemonster.com website or to have a relationship with the entities that operate the www.templatemonster.com website and control the www.templatemonster.com domain name.

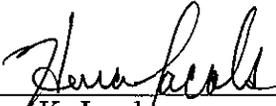
Applicant should be judicially estopped from taking the position that he controls the use of the www.templatemonster.com mark on the www.templatemonster.com website, or that he controls the domain name www.templatemonster.com, or that he has an affiliation with the entities that do operate the website and control the domain name because it is clearly inconsistent with the position he took earlier in federal district court in which he succeeded in avoiding a contempt violation for violating court's order.

IV. CONCLUSION

For all the foregoing reasons, MonsterCommerce and Network Solutions respectfully request that the Board grant their motion for summary judgment, and sustain the opposition. Additionally, Opposer requests that the Board suspend the proceedings pending the disposition of Opposer's Motion for Summary Judgment.

Respectfully submitted,

Date: November 24, 2008

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ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

I, Troy E. Larson, hereby certify that on today's date, I caused a copy of the foregoing Opposer's Motion for Summary Judgment to be served by United States First Class mail, postage prepaid, on counsel for Applicant as set forth below:

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