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

Proceeding	91173189
Party	Defendant Igor Lognikov
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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 TEMPLATEMONSTER

MONSTERCOMMERCE, LLC, and
NETWORK SOLUTIONS, LLC,

Opposers,

v Opposition No. 91173189

IGOR LOGNIKOV,

Applicant.

_____/

APPLICANT'S RESPONSE IN OPPOSITION TO OPPOSERS' MOTION FOR SUMMARY JUDGMENT

COMES NOW, the Applicant, IGOR LOGNIKOV ("Applicant"), by and through his undersigned counsel, who submits this response in opposition to Opposers', MONSTERCOMMERCE, LLC and NETWORK SOLUTIONS, LLC (collectively"Opposers"), motion for summary judgment. Opposers' motion advances a fantastical spin of facts that are disputed, and do not even frame the issue that should be raised, namely, whether Applicant is the owner of the TEMPLATEMONSTER service mark in the United States. Rather, Opposers seek to rely, without any basis or logic, on the notion that the registration of a domain name in another irrevocably defeats Applicant's ownership of the mark in this country. That Applicant is not the registrant of www.templatemonster.com, does not at all address whether he is the owner of the service mark TEMPLATEMONSTER here. Moreover, Opposers fail to cite any authority supporting their speculative contention that owners of U.S. trademarks and service marks must also be registrants of related domain names, otherwise, their claim of mark ownership in this country is

flawed. Finally, the motion seems to present a case of "sour grapes" by Opposer Network Solutions, LLC (and its related subsidiary Monstercommerce, LLC) who attempted to oppose Applicant's related Community Trademark Application for the same mark. In that case, the CTM opposition was withdrawn and Network Solutions, LLC was required to pay, and did pay, the Applicant the costs of that proceeding.

With respect to the present motion, there are at the very least substantial material facts present that raise a genuine issue of the Applicant's service mark ownership claim sufficient to deny the motion. Applicant submits, to the contrary, that there is no genuine issue of material fact but that Applicant is the owner of the service mark TEMPLATEMONSTER in the United States, and as a result, Paragraphs 13-27 of the Second Amended Notice of Opposition should be stricken. Moreover, the Applicant did not commit fraud on the United States Patent and Trademark Office ("PTO") because he rightfully claimed ownership of TEMPLATEMONSTER here in the United States. For these reasons, Opposers' motion should be denied.

FACTUAL BACKGROUND

Applicant is the owner in the United States of the service mark TEMPLATEMONSTER, and of U.S. service mark application, U.S. Serial No. 78612360, for online retail services featuring downloadable software for website development comprising pre-formatted modifiable templates; and website development services, namely, providing website design services for others. (Applicant Dec., ¶ 1). Applicant and others were sued for copyright infringement relating to certain digital images on June 28, 2006 by Corbis Corporation ("Corbis Action")[1] as alluded to

[1]United States District Court for the Southern District of Florida, Case No. 06-CV-21643.

by Opposers in their motion. (Applicant Dec., ¶ 2). However, at no time was there any finding or conclusion by the district court that Applicant committed any infringement, fraud or other wrongdoing. To the contrary, the Corbis Action was dismissed with prejudice against the Applicant and the other defendants who appeared in the case. (Applicant Dec., ¶ 3).[2]

In the complaint in the Corbis Action, the plaintiff Corbis was well aware that Applicant was the owner of the present pending TEMPLATEMONSTER service mark application before the PTO, and acknowledged as much in its allegation at Paragraph 17. (*See* Opposers' Ex. 3, p. 5, ¶17). Applicant admitted that allegation. (Applicant Dec., ¶ 4). Thus, both the district court and Corbis were fully aware of Applicant's ownership of the TEMPLATEMONSTER mark in the United States.

During the Corbis Action, Applicant informed Corbis that the owner of the domain name www.templatemonster.com was an individual **non-party** by the name of Mr. Dmitry Zolotarev. (Opposers' Ex. 9). Applicant accurately stated in the Corbis Action that he had no control over Mr. Zolotarev's business operations, much like licensors do not control the business operations of their unrelated licensees.[3] Notwithstanding the Applicant's lack of control over Mr. Zolotarev's business, Applicant has permitted Mr. Zolotarev the right and license to use Applicant's service mark TEMPLATEMONSTER in the United States. (Applicant Dec., ¶ 5). It is upon this use that Applicant rightfully claims ownership of the mark TEMPLATEMONSTER in the United

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[2]A default judgment was entered against the remaining defendants, all of whom who were not represented by counsel and did not respond to the complaint.

[3]Unlike the present opposers who are related and their business operations clearly overlap as evidenced by the aforementioned CTM opposition proceeding and this one, as well as by the admissions Opposers have made in their pleadings filed in this proceeding.

States. Further, the use by Mr. Zolotarev of Applicant's mark renders Opposers' claim of fraud on the PTO moot. Finally, Applicant's ownership of the TEMPLATEMONSTER mark in the United States is entirely consistent with the same claim of ownership of that mark to which he admitted in the pleadings in the Corbis Action.

ARGUMENT

Opposers bear the burden of establishing that there is no genuine issue of material fact that Applicant is not the owner of the United States service mark TEMPLATEMONSTER. *See* Fed.R.Civ.P. 56 (c); TBMP §528.01. The attached affidavit of Applicant unquestionably denies Opposers of the ability to meet their burden of proof. Moreover, the affidavit clearly establishes that Applicant is the owner of the TEMPLATEMONSTER mark in the United States, and that he has not committed fraud in so claiming ownership with the PTO by filing his pending service mark application.

Opposers correctly point out that

> 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.

(Opposers' Motion, p. 7). As supported by the attached affidavit, Applicant is the owner of his TEMPLATEMONSTER mark in the United States through its use by Mr. Zolotarev. This is thoroughly consistent with the statements Applicant made in the Corbis Action. First, Applicant fully disclosed in the Corbis Action that Mr. Zolotarev was the owner of www.templatemonster.com. Second, Applicant made no statement in the Corbis Action relating to ownership of the

TEMPLATEMONSTER service mark in the United States - it was simply not an issue in the Corbis Action copyright infringement case. Third, because the Applicant controls the use of his mark vis-a-vis Mr. Zoltarev, (Applicant Dec., ¶ 5), Applicant has every right to claim ownership of the TEMPLATEMONSTER mark in the United States.

CONCLUSION

The Opposers continue to exhaust every means to possible deny ownership of TEMPLATEMONSTER to Applicant both here and abroad, and to the registration of Applicant's rightfully filed and pending service mark application before the PTO. Contrary to Opposers' mistaken notion of ownership, Applicant never denied ownership of the TEMPLATEMONSTER mark in the Corbis Action. Applicant is the owner of that mark in the United States as set forth above and in the attached affidavit. Accordingly, Opposers' motion should be denied, and Paragraphs 13-27 of the Second Amended Notice of Opposition should be stricken.

Respectfully submitted,

s/Richard S. Ross, Esq.
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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing has been served by United States Postal Service first class regular mail, and addressed to counsel for the Opposer:

Brian J. Winterfeldt
Tricia McDermott Thompkins
Ballard Spahr Andrews & Ingersoll, LLP
601 13th Street, NW,
Suite 1000 South
Washington, DC 20005

this 26th day of December, 2008.

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

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In the matter of application Serial No. 78/612,360 TEMPLATEMONSTER

MONSTERCOMMERCE, LLC, and
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IGOR LOGNIKOV,

Applicant.

_____/

DECLARATION OF APPLICANT IGOR LOGNIKOV IN SUPPORT OF APPLICANT'S RESPONSE IN OPPOSITION TO OPPOSERS' MOTION FOR SUMMARY JUDGMENT

I, the Applicant, IGOR LOGNIKOV, declare as follows:

1. I am the owner in the United States of the service mark TEMPLATEMONSTER, and of U.S. service mark application for the mark TEMPLATEMONSTER, U.S. Serial No. 78612360, for online retail services featuring downloadable software for website development comprising pre-formatted modifiable templates; and website development services, namely, providing website design services for others.

2. I and others were sued for copyright infringement relating to certain images on June 28, 2006 by Corbis Corporation before the United States District Court for the Southern District of Florida ("Corbis Action").

3. At no time did the district court in the Corbis Action find or conclude that I committed any infringement, fraud or other wrongdoing whatsoever. To the contrary, the Corbis Action was dismissed against me and others with prejudice.

4. In the complaint in the Corbis Action, the plaintiff alleged that I filed the subject service mark application for TEMPLATEMONSTER with the USPTO. (Opposers' Ex. 3, p. 5, ¶17). I admitted that allegation in the pleadings in the Corbis Action, and admit it here.

5. During the Corbis Action, I informed Corbis that the owner of the domain name www.templatemonster.com was an individual **non-party** by the name of Mr. Dmitry Zolotarev. (Opposers' Ex. 9). Though I have no control over Mr. Zolotarev's business operations, I have granted Mr. Zolotarev the right and license to use my service mark TEMPLATEMONSTER in the United States, and I control the use of that mark by Mr. Zolotarev.

6. Pursuant to 28 U.S.C. §1746, I declare under penalty of perjury that the foregoing is true and correct to the best of my information and belief.

Date: 23 dec 08

IGOR LOGNIKOV
Applicant