

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

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

Baxley

Mailed: June 23, 2009

Opposition No. 91173189

MonsterCommerce, LLC and  
Network Solutions, LLC

v.

Igor Lognikov

**Andrew P. Baxley, Interlocutory Attorney:**

On April 19, 2005, Igor Lognikov ("applicant") filed application Serial No. 78612360 seeks 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.<sup>1</sup> In that application, applicant included specimens showing use of the involved mark on the `templatemonster.com` website.

MonsterCommerce, LLC and Network Solutions, LLC ("opposers") have opposed registration of applicant's mark on grounds set forth in their amended notice of opposition

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<sup>1</sup> The application is based on an assertion of use in commerce under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), and sets forth April 12, 2002 as the date of first use anywhere and April 15, 2002 as the date of first use in commerce.

as follows: 1) there is likelihood of confusion between applicant's mark and opposers' previously used and registered mark MONSTERCOMMERCE<sup>2</sup> and "family of MONSTER marks" under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d); 2) because applicant is not the owner of the involved mark, his involved application is void *ab initio*; and 3) applicant committed fraud upon the USPTO by allegedly making false statements in the involved application regarding ownership and use in commerce of the involved TEMPLATEMONSTER mark. Applicant has denied the salient allegations of the amended notice of opposition in his answer.

This case now comes up for consideration of opposers' motion (filed November 24, 2008) for summary judgment on their pleaded grounds of nonownership and fraud. That motion has been fully briefed.

Opposers filed their motion for summary judgment electronically with the Board and, due to the voluminous nature of its exhibits in support thereof, concurrently sent those exhibits to the Board by mail, albeit to the Board's

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<sup>2</sup> Registration No. 2947268, issued May 10, 2005, 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" in International Class 42.

former address.<sup>3</sup> The exhibits did not become associated with the proceeding file, presumably because opposers sent them to an outdated address. However, opposers served those exhibits on applicant concurrently with its brief in support of the motion for summary judgment, and applicant, in his brief in response to the motion for summary judgment, responded on the merits thereof. On January, 28, 2009, following full briefing of the motion for summary judgment, opposer filed a copy of those exhibits with the Board at the correct mailing address. Accordingly, we have considered those exhibits in this decision.

Turning to opposers' motion for summary judgment, the record indicates that, on June 28, 2006, Corbis Corporation ("Corbis") commenced a civil action styled *Corbis Corp. v. Lognikov*, Case No. 06-21643, by filing a complaint and motion for injunctive relief in the United States District Court for the Southern District of Florida against applicant, [www.templatemonster.com](http://www.templatemonster.com) and others based in part on allegations of copyright infringement regarding more than 600 stock photography images. On July 6, 2006, the district

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<sup>3</sup> The Board moved to its current address in November 2004, more than four years prior to the filing of the motion for summary judgment. Opposer had notice of the Board's new address through both the Trademark Rules of Practice and on the USPTO's website. See Trademark Rule 2.190(a) and <http://www.uspto.gov/web/offices/dcom/ttab/tbmp/>. In addition, opposers had sent previous submissions in this case to the Board by mail at the current address.

court granted Corbis's motion for a temporary restraining order and preliminary injunction, freezing the assets of applicant, [www.templatemonster.com](http://www.templatemonster.com) and others, and ordering defendants to remove photographic images owned by Corbis from the [www.templatemonster.com](http://www.templatemonster.com) website. On July 25, 2006, Corbis filed a motion for an order to show cause why the defendants were not in contempt of the July 6, 2006 order, wherein it alleged multiple violations of that order. In a brief in response to the motion for an order to show cause, applicant contends that he "is a writer and does not have a business relationship with [[templatemonster.com](http://templatemonster.com)], other than to link his Web Design Library to the [[templatemonster.com](http://templatemonster.com)] website." Brief in response at 9. The district court, on August 11, 2006, issued a decision in which it denied without prejudice Corbis's motion for an order to show cause.<sup>4</sup> However, in response to the motion for summary judgment, applicant asserts in a declaration dated December 23, 2006 that

... [d]uring the Corbis Action, I informed Corbis that the owner of the domain name [www.templatemonster.com](http://www.templatemonster.com) was an individual **non-party** by the name of Mr. Dmitry Zolotarev. 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.

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<sup>4</sup> In that decision, the district court noted that, "there is no clear and convincing evidence that all of the Defendants are capable of controlling the actions of all other Defendants." August 11, 2006 order at 9, fn. 5.

Lognikov declaration at paragraph 5 (emphasis supplied).

Opposers essentially contend that, in view of applicant's representations in the earlier civil action, applicant cannot be the owner of the involved TEMPLATEMONSTER mark and that applicant committed fraud upon the United States Patent and Trademark Office (USPTO) by falsely averring to ownership of the involved mark and use of that mark in commerce. Opposers further contend that as a result of applicant's earlier representations to the district court in response to Corbis's motion for an order to show cause, applicant is precluded by the doctrine of judicial estoppel from claiming ownership and use in commerce of the involved mark. Accordingly, opposers ask the Board to enter summary judgment against applicant on their pleaded nonownership and fraud claims.

Applicant, in his response, contends that there are genuine issues of material fact regarding applicant's alleged ownership of the involved TEMPLATEMONSTER mark.

As has often been stated, summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); and *Sweats Fashions Inc. v.*

*Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. The Board may not resolve issues of material fact; it may only ascertain whether such issues are present. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Our primary reviewing court has stated that the doctrine of judicial estoppel prohibits a party from taking inconsistent positions in the same or related litigation and is intended to protect the integrity of the judicial process. See *Transclean Corp. v. Jiffy Lube International Inc.*, 474 F.3d 1298, 81 USPQ2d 1400 (Fed. Cir. 2007). Judicial estoppel is an equitable doctrine that may be invoked by a court at its discretion. See *New Hampshire v. Maine*, 532 U.S. 742, 750 (2001). The Supreme Court recently acknowledged the viability of the doctrine and identified several non-exclusive factors that guide a court's decision whether to apply judicial estoppel: (1) the party's later position must be "clearly inconsistent" with its earlier position; (2) the party must have succeeded in persuading a

court to adopt the earlier position, thereby posing a "risk of inconsistent court determinations"; and (3) "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." *Id.* at 750-51.

After reviewing the parties' arguments and evidence, we find that disposition of this proceeding by summary judgment is inappropriate. We note initially that applicant's intent in filing the involved application is at issue in opposers' claims herein and that the factual question of intent is generally ill-suited for disposition on summary judgment. See *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991).

With this in mind, we find that there are genuine issues of material fact as to applicant's claim of ownership of the involved mark, as to the nature and extent of any license by applicant of that mark, and as to whether applicant's claim of ownership and use in commerce of the mark is clearly inconsistent with his representations in the earlier civil action. Moreover, we note that, because the earlier civil action involved allegations of copyright infringement, whereas this proceeding involves trademark registrability, there is a genuine issue of material fact as to whether the earlier civil action is related litigation for purposes of the doctrine of judicial estoppel.

In view thereof, opposers' motion for summary judgment is denied. Proceedings herein are resumed. Discovery and testimony periods are reset as follows.

DISCOVERY PERIOD TO CLOSE:	<b>July 10, 2009</b>
Plaintiff's 30-day testimony period to close:	<b>October 8, 2009</b>
Defendant's 30-day testimony period to close:	<b>December 7, 2009</b>
Plaintiff's 15-day rebuttal testimony period to close:	<b>January 21, 2010</b>

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.