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

Proceeding	92058621
Party	Defendant Dropbox, Inc.
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Date	07/01/2014
Attachments	Amended Answer to Petition for Cancellation.pdf(1882151 bytes)

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

THRU INC.,)	Cancellation No: 92058621
)	
Petitioner,)	
)	AMENDED ANSWER TO
v.)	PETITION FOR CANCELLATION
)	
DROPBOX, INC.,)	
)	Registration No. 4,478,345
Registrant.)	
)	
)	
)	

Dropbox, Inc. (“Registrant”), through its undersigned attorneys, hereby submits this Answer to the Petition for Cancellation filed by Thru Inc. (“Petitioner”) in the above-mentioned proceeding. Unless expressly admitted herein, each allegation contained in the Petition for Cancellation is denied.

1. Registrant admits the allegations in Paragraph 1 of the Petition for Cancellation.
2. Registrant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 2 of the Petition for Cancellation and on that basis denies those allegations.
3. Registrant denies the allegations in Paragraph 3 of the Petition for Cancellation.
4. Registrant denies the allegations in Paragraph 4 of the Petition for Cancellation.
5. The allegations in Paragraph 5 of the Petition for Cancellation comprise a prayer for relief, to which no response is required.

AFFIRMATIVE DEFENSES

First Affirmative Defense

6. The Petition for Cancellation fails to set forth facts sufficient to entitle Petitioner to the relief sought.

Second Affirmative Defense

7. Registrant's rights to the DROPBOX mark are superior to those, if any, of Petitioner. Among other things, Registrant has acquired third-party rights that are superior to those claimed by Petitioner.

Third Affirmative Defense

8. Petitioner has had actual knowledge of Registrant's use of the DROPBOX mark for years. On information and belief, Petitioner was aware of Registrant's use of the DROPBOX mark prior to the close of the opposition period. Petitioner did not seek to oppose registration of the DROPBOX mark, and did not otherwise assert its rights prior to filing the Petition for Cancellation. During such time, Registrant continued to use, promote and invest in the DROPBOX mark, including through the acquisition of third-party rights, and develop goodwill around this mark. Petitioner has unduly or unreasonably delayed in asserting its rights, resulting in prejudice to Registrant. Accordingly, the Petition for Cancellation is barred by the doctrine of laches.

Fourth Affirmative Defense

9. On November 17, 2011, Petitioner filed an application for the DROPBOX mark at the United States Patent and Trademark Office. In December 2011, Petitioner contacted Registrant, stating its belief that Petitioner holds superior rights to the DROPBOX mark and indicating an interest in reaching resolution regarding the mark. Although Registrant indicated a

willingness to resolve the issue, Petitioner ceased substantive communications with Registrant for approximately 18 months while Registrant and other claimants engaged in proceedings to determine ownership of the DROPBOX mark. Petitioner's silence during this time, and its decision to take no action to assert its purported rights, constitutes intentional conduct inconsistent with claiming rights to the DROPBOX mark. Accordingly, the Petition for Cancellation is barred by the doctrine of waiver.

Fifth Affirmative Defense

10. In December 2011, Petitioner contacted Registrant, stating its belief that it holds superior rights to the DROPBOX mark and indicating that it was aware of Registrant and its use of the DROPBOX mark, as well as the various disputes surrounding the mark. Petitioner did not oppose Registrant's application for the DROPBOX mark or take any other action to assert its purported rights, and, although it indicated an interest in reaching resolution regarding the mark, stopped communicating substantively with Registrant for approximately 18 months, while Registrant and other claimants engaged in proceedings to determine ownership of the DROPBOX mark. The assertion of superior rights in the DROPBOX mark, coupled with a subsequent decision not to pursue such rights, all with full knowledge of Registrant's pending application and use of the mark, amounted to implied consent to Registrant's activities, including its prosecution of Registration No. 4,478,345. Accordingly, the Petition for Cancellation is barred by the doctrine of acquiescence.

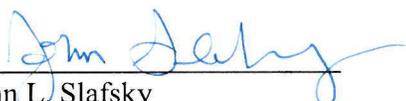
Sixth Affirmative Defense

11. In December 2011, Petitioner contacted Registrant, stating its belief that it holds superior rights to the DROPBOX mark and indicating that it was aware of Registrant and its use of the DROPBOX mark, as well as the various disputes surrounding the mark. Although

Registrant engaged with Petitioner and indicated willingness to reach a resolution regarding the mark, Petitioner fell silent and disengaged from discussions, without explanation. Registrant did not receive any substantive communication from Petitioner for approximately 18 months. During that time, Petitioner took no action to assert its purported rights in the DROPBOX mark. Registrant reasonably relied on Petitioner's apparent decision to not assert its rights, and consequently continued to use, promote and invest in the DROPBOX mark, including through the acquisition of third-party rights, and develop goodwill around this mark, to its prejudice. Accordingly, the Petition for Cancellation is barred by the doctrine of equitable estoppel.

Dated: July 1, 2014

WILSON SONSINI GOODRICH & ROSATI
A Professional Corporation

By: 
John L. Slafsky
Stephanie S. Brannen

Attorneys for Applicant
DROPBOX, INC.

Please address all communications concerning this proceeding to:

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CERTIFICATE OF SERVICE BY MAIL

I, Elvira Minjarez, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I served **AMENDED ANSWER TO PETITION FOR CANCELLATION** on each person listed below, by placing the document described above in an envelope addressed as indicated below, which I sealed. I placed the envelope for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

John M. Cone
Hitchcock Evert LLC
P.O. Box 131709
Dallas, TX 75313-1709

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on July 1, 2014.


Elvira Minjarez