

ESTTA Tracking number: **ESTTA592342**

Filing date: **03/13/2014**

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

Proceeding	92058621
Party	Plaintiff Thru, Inc.
Correspondence Address	JOHN M CONE HITCHCOCK EVERT LLC PO BOX 131709 DALLAS, TX 75313-1709 UNITED STATES jccone@hitchcockevert.com, docket@hitchcockevert.com
Submission	Motion for Summary Judgment
Filer's Name	John M. Cone
Filer's e-mail	jccone@hitchcockevert.com, docket@hitchcockevert.com, ksimpson@hitchcockevert.com
Signature	/s/ John M. Cone
Date	03/13/2014
Attachments	140312 Motion for Partial Summary Judgment.pdf.2.pdf(16192 bytes ) Motion Exhibit A - Answer.pdf(78651 bytes ) 140313 Harrison Declaration Signed scanned.pdf(32972 bytes ) Harrison Declaration Exhibit A.pdf(418554 bytes ) Harrison Declaration Exhibit B.pdf(37365 bytes )

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

**In the Matter of Registration No. 4,478,345 DROPBOX**

THRU INC., Petitioner,	§	
v.	§	
DROPBOX, INC., Registrant.	§	<b>Cancellation No. 92058621</b>

TO THE HONORABLE TRADEMARK TRIAL AND APPEAL BOARD

**THRU INC.’S MOTION FOR PARTIAL SUMMARY JUDGMENT  
DENYING REGISTRANT’S FIRST, THIRD, FOURTH, FIFTH AND  
SIXTH AFFIRMATIVE DEFENSES AND BRIEF IN SUPPORT**

In this cancellation petition, Thru Inc. (“Thru”) seeks cancellation of Dropbox, Inc.’s (“Registrant”) Registration No. 4,478,345. Petitioner now files this Motion for Partial Summary Judgment pursuant to Federal Rule of Civil Procedure 56 seeking judgment as a matter of law on certain the First, Third, Fourth, Fifth and Sixth Affirmative Defenses pled in Registrant’s Answer to Petition. A copy of the Answer is attached as Exhibit A.

Registration No. 4,478,345 issued on February 4, 2014 and Cancellation No. 92058621 was filed on the same day. It is axiomatic that a Petition for Cancellation cannot be filed before a registration issues. In this case, it is undisputable that the Petition was filed on the very first day possible. Nevertheless, Registrant seeks to assert Affirmative Defenses that are based on delay. The uncontroverted facts show that these defenses cannot be successful and should be denied now as a matter of law.

## I. ARGUMENT

Registrant has pled the affirmative defenses of laches, acquiescence, waiver and estoppel. Registrant simply has no evidence that would support application of any of these defenses to bar Thru's petition. Accordingly, partial summary judgment striking Registrant's affirmative defenses of laches, acquiescence, waiver and estoppel is warranted.

### A. Laches cannot bar the Petition.

Registrant has the burden of proving the Petition is barred by laches. The defense of laches must be related to Registrant's registration of its mark, not its use. *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes Inc.*, 971 F.2d 732, 734 (Fed. Cir. 1992) (citing *National Cable Television Ass'n, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1571 (Fed. Cir. 1991)). There are three elements for the defense of laches: "(1) unreasonable delay in asserting one's rights, (2) lack of excuse for the delay, and (3) undue prejudice to the other party caused by the delay."

*Bridgestone/Firestone Research, Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 1361 (Fed. Cir. 2001); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 668 (5th Cir. 2000).

Registrant has no evidence that would show unexcused delay. Indeed, there was no delay. The period for laches begins to run no earlier than the date of registration. *National Cable Television Ass'n, Inc.*, 937 F.2d at 1582. The record shows the Petition was filed on the very first day possible. The Board should grant partial summary judgment striking Registrant's defense of laches.

## **B. Acquiescence cannot bar the Petition.**

The doctrine of estoppel by acquiescence applies where the owner of a right, by conveying to the defendant through affirmative word or deed, expressly or implicitly states that it will not assert the right. *Hitachi Metals Int'l, Ltd. v. Yamakyu Chain Kabushiki Kaisha*, 209 U.S.P.Q. 1056(7?), 1057 (T.T.A.B. 1981). Acquiescence requires an affirmative act and knowing consent. *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 463 (4th Cir. 1996); *Coach House Restaurant, Inc. v. Coach and Six Restaurants, Inc.*, 934 F.2d 1551, 1558 (11th Cir. 1991).

Registrant can point to no affirmative act by Thru that could provide a basis for the defense of acquiescence. In addition, like laches, the period of acquiescence does not begin to run until the registration issues. Once again, there was no delay. The Board should grant partial summary judgment striking Registrant's defense of acquiescence.

## **C. Thru has not waived its trademark rights.**

Waiver is the intentional relinquishment of a known right. *Ironclad, L.P. v. Poly-America, Inc.*, No. Civ.A. 3:98-CV-2600, 2000 WL 1400762, at \*14 (N.D. Tex. July 28, 2000). Waiver turns on the subjective intent of the plaintiff(?), so that a defendant must demonstrate plaintiff's actual intent to relinquish the right. *Id.*

Registrant can point to no evidence that Thru has ever manifested an unequivocal intention to no longer assert its trademark rights. The Board should grant partial summary judgment striking Registrant's defense of waiver.

**D. Thru is not estopped from asserting its trademark rights.**

Estoppel requires that as a result of reliance on a statement or act of Thru, Registrant has changed its position to its detriment. Registrant has not and cannot plead any such statement or act by Thru, nor can it plead any way in which it has changed its position to its detriment.

Registrant may try to argue that the act or statement of Thru was it not filing a trademark infringement action contesting Registrant's use of the mark DROPBOX. Even if this constituted "act or statement," which it does not, Registrant cannot show that it changed its position to its detriment as a result of Thru's *not* filing infringement litigation.

**E. The Petition Sets Forth Facts Sufficient to Entitle Thru to the Relief Sought.**

As to the First Affirmative Defense, the Petition alleges that Thru has common-law, use-based rights in the trademark DROPBOX that have priority over any rights of Registrant in the mark of Registration No. 4,478,345. (Petition ¶¶ 1, 2).

The Petition further alleges that use by Registrant of the mark DROPBOX for the services of Registration No. 4,478,345 would be likely to cause confusion, or to cause mistake, or to deceive. (Petition ¶ 3).

These contentions sufficiently state a basis under 15 U.S.C. § 1052(d) for cancellation of Registration No. 4,478,345.

The Petition additionally states facts demonstrating that Thru has standing to bring the Petition as a person damaged by Registration No. 4,478,345 remaining on the register.

## II. CONCLUSION

For the foregoing reasons, Thru respectfully requests that the Board grant this Motion for Partial Summary Judgment and enter an order striking Registrant's First, Third, Fourth, Fifth and Sixth affirmative defenses.

Dated: March 13, 2014

Respectfully submitted,

/s/ John M. Cone  
John M. Cone  
Hitchcock Evert LLP  
P.O. Box 131709  
Dallas, Texas 75313-1709  
(214) 880-7002 Telephone  
(214) 953-1121 Facsimile  
jccone@hitchcockevert.com

ATTORNEY FOR PETITIONER  
THRU INC.

**CERTIFICATE OF SERVICE**

I hereby certify that on this 13<sup>th</sup> day of March, 2014, of the foregoing document was served on registrant, Dropbox, Inc. by mailing a true and correct copy thereof via U.S. First Class Mail, postage prepaid to:

John L. Slafsky, Esq.  
WILSON SONSINI GOODRICH & ROSATI  
650 Page Mill Road  
Palo Alto CA 94304-1050  
Attorney for Dropbox, Inc.

/s/ John M. Cone  
John M. Cone

ESTTA Tracking number: **ESTTA591069**

Filing date: **03/06/2014**

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

Proceeding	92058621
Party	Defendant Dropbox, Inc.
Correspondence Address	DROPBOX INC 185 BERRY ST, SUITE 400 SAN FRANCISCO, CA 94107 UNITED STATES
Submission	Answer
Filer's Name	John L. Slafsky
Filer's e-mail	jslafsky@wsgr.com, trademarks@wsgr.com
Signature	/John L. Slafsky/
Date	03/06/2014
Attachments	Answer to Petition for Cancellation.pdf(73242 bytes )









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

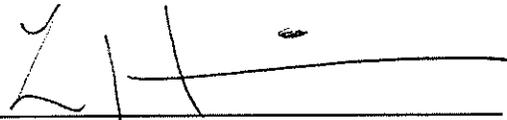
In the Matter of Registration No. 4,478,345 DROPBOX

THRU INC.,	§	
Petitioner,	§	
	§	
v.	§	Cancellation No. 92058621
	§	
DROPBOX, INC.,	§	
Registrant.	§	
	§	

**DECLARATION OF LEE HARRISON**

1. I am the President and CEO of the Petitioner Thru Inc.
2. I am more than 21 years old and am competent to make this Declaration.
3. Thru Inc., by its attorney's letter of December 8, 2011, a copy of which is attached marked Exhibit A, made known to Dropbox, Inc. Thru's claim to rights to the trademark DROPBOX established prior to any date of priority that Dropbox could claim for that trademark.
4. At the time of this letter, Dropbox's application S.N. 77/817,716 had been published and the opposition term had expired.
5. At no time did Thru withdraw its position stated in the letter at Exhibit A, namely that its rights in the mark DROPBOX were superior to those of Dropbox, Inc.
6. This position was re-stated in Thru's attorney's email to Dropbox's attorney on September 13, 2013. A copy of this email is attached as Exhibit B.
7. Thru has never, by act or deed, stated or even suggested to Dropbox, Inc. that it did not maintain its right to contest Dropbox's use and ownership of the mark DROPBOX.

I MAKE THIS DECLARATION BELIEVING THE FOREGOING TO BE TRUE  
AND CORRECT UNDER PENALTY OF PERJURY AND SUBJECT TO THE  
PROVISIONS OF 28 U.S.C. § 1746.



LEE HARRISON

**CERTIFICATE OF SERVICE**

I hereby certify that on this 13<sup>th</sup> day of March, 2014, of the foregoing document was served on registrant, Dropbox, Inc. by mailing a true and correct copy thereof via U.S. First Class Mail, postage prepaid to:

John L. Slafsky, Esq.  
WILSON SONSINI GOODRICH & ROSATI  
650 Page Mill Road  
Palo Alto CA 94304-1050  
Attorney for Dropbox, Inc.

/s/ John M. Cone  
John M. Cone

# Hitchcock · Evert

John M. Cone, Esq.  
(214) 880-7002  
jcone@hitchcockevert.com

December 8, 2011

John L. Slafsky, Esq.  
Wilson Sonsini Goodrich & Rosati  
650 Page Mill Road  
Palo Alto, CA 94304-1050

**Via Email and First Class Mail**

**Re: Trademark DROPBOX and Dropbox, Inc.**

Dear John:

I represent Thru LLC ("Thru"), formerly known as Rumble Group, in trademark matters. Thru is a Managed File Transfer as a Service company which has been in business since 2002.

In 2004, it introduced a new feature of its service under the mark DROPBOX. I am enclosing copies of web pages from April, May and June 2004 illustrating Thru's use of DROPBOX at that time. My client has used its mark DROPBOX continuously since 2004 in connection with file transfer and storage services. Thru's business is focused on providing MFTaaS services to business clients and it is the owner of proven technology for this purpose which it has used for more than seven years.

Thru is aware of the current trademark dispute regarding the mark DROPBOX involving your client Dropbox, Inc. and several other claimants, including Officeware Corporation d/b/a FilesAnywhere.com.

After reviewing the filings in the oppositions against your client's trademark application 77/817,716 DROPBOX, we consider that Thru has trademark rights in the mark DROPBOX and that its rights to DROPBOX take priority over the rights relied on by Yousendit, Inc., Box.net, Inc., and Officeware Corporation. In addition, they take priority over any rights that could be claimed by Dropbox, Inc.

Please contact me to discuss this situation and possible strategies for resolving this to the benefit of both of our clients.

Best Regards,



John M. Cone

Enclosure



# Features

## 1 Administration Tools

Access real-time data on storage utilization, users, logins, keyword search, category/folder/file count and file usage. Create categories, add descriptions and assign access. Create user groups (including read only, download, upload & download and administrative), create/edit users and automatically send updated information. Send Messages to FTH users, user groups or the entire user base.

## 2 User Tools

Create file collections; distribute secure access via integrated email. Full address book including distribution lists and private or shared contacts. Email notification and tracking of unlimited distributions. A user home directory which includes My Files, My DropBox™ & My Collect™ folders accessible only by the logged in user. Extensive search capabilities, the ability to change profile details, access to live Chat Support and Rumble Help Center 24/7.

## 3 Categories

Users can search for folders & files by navigating the category structure, as categories are selected detail information on the creator as well as a description. Folders contained in the category appear in the lower section of the file console.

## 4 Folders

Select folders to reveal contents; add folders and have the ability to cut, copy and paste folders into other categories. Use the select all feature to delete folders or download entire contents.

## 5 Files

Choose from Power Upload (drag & drop) or Browser Upload; to copy files into selected folder. Use select all to delete download add to collection or distribute. Select single file to download, click on spyglass icon to view thumbnail and highlight file to see detailed information.

## 6 Detail View

The detail view shows information on the selected folder or file-including the name and date/time of the creator, last modified, last download with the ability to email directly by clicking on the user name. Also view descriptive information and folder or file expiry features.

## 7 Clipboard

Cut & paste folders and files to the clipboard. From there you can quickly move their location within the FTH dBank.

## 8 Transaction Log

By selecting the Transaction Log feature you can view all the transactions taken place on the folder or file selected. They include creation, modification, downloads, distributions and collections.

## 9 DropBox™

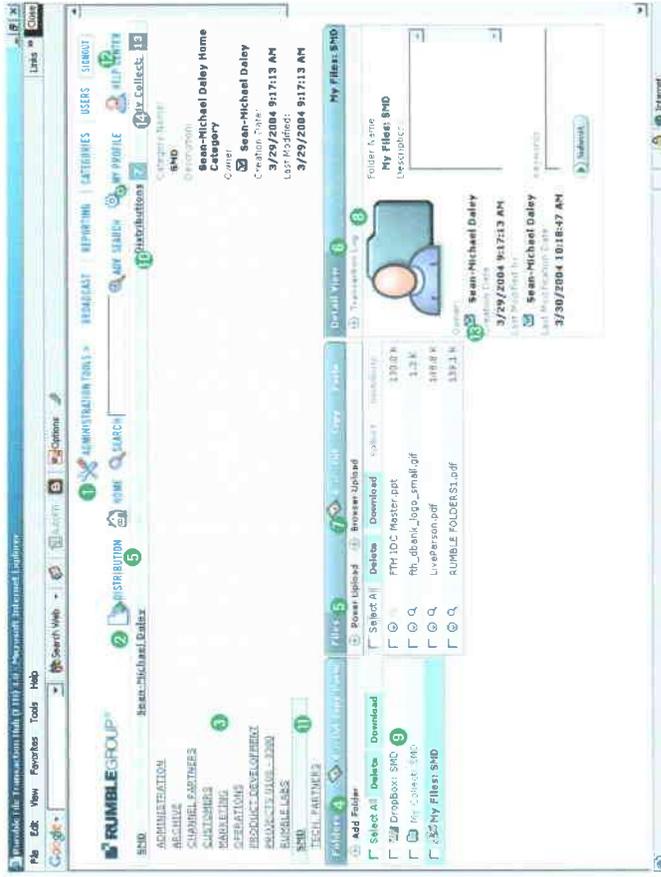
DropBox™ allows non-FTH users to upload files to a users private DropBox™ folder. All files are virus scanned, the person uploading the file is notified via email of successful delivery and the DropBox™ owner is emailed to notify of delivery. Perfect for replacing anonymous FTP, as it is much easier to use and manage.

## 10 Distribution

Rather than send large files as email attachments, that can be bounced, FTH allows you to collect files and distribute secure links. By utilizing the integrated contacts feature you can create lists, favorites and share with other users. Keep constant track of who has download which files you have distributed and be sent email notifications when downloads occur.

## 11 User Home Directory

Every new user is automatically set-up with a user home directory, which includes My Files, My DropBox™, and My Collect™. These



Folders can allow only be accessed by the logged in user.

## 12 Help Center

From anywhere within the FTH dBank you can access our 24/7 Help Center. Use Chat Support, our integrated email ticket system, link to live training sessions, choose from a selection of product tutorials or quiz our extension knowledge base.

## 13 Email Notification

FTH dBank includes an extensive email subsystem, which allows users to communicate with other users and have the FTH dBank notify them automatically based on events.



### FTH makes digital file distribution, sharing and management easy & secure

- Never have email bounce because the attachment was too large
- Get confirmation when the recipient has taken delivery of your files
- No software to load or need to reconfigure your computer
- Always have 128-bit SSL encrypted access to your files
- Never deal with FTP or IT issues again
- Ensure all files being sent or received are checked for viruses

Learn More | Reseller Program | Product Tutorials | Pricing/Purchase | Free 15-Day Trial

#### FTH Overview v4.0

- Customizable login screen & url
- Intuitive and easy to use administration and user tools
- Create your own user groups to control access and functionality
- Power Upload - drag and drop file up-load
- Automated user home creation - Includes My Files, My DropBox and My Collect
- Transaction Log to track file usage, changes and ownership
- Distribution, create file collections, distribute access via secure links
- 24/7 Help Center for unlimited support & training
- Receive email download notifications

[See Larger Screen](#)

- May 3, 2004 Rumble Group establishes presence in Canada with Global Storm IT
- April 26, 2004 Value-Added Reseller Evigi Technologies signs on to resell FTH
- April 14, 2004 ServerMatrix bundles File Transaction Hub
- April 6, 2004 Epiphany signs on as FTH re-seller
- March 24, 2004 Rumble announces significant features & interface upgrades in FTH v4.0
- March 10, 2004 Rumble's Help Center goes 24/7 to support worldwide user base

- Architects
- Field Sales
- Software Developers
- Network Managers
- Executives
- Engineers
- Designers
- Project Managers

5/11/04

## PRODUCTS

- Thru Web Edition
- Thru Outlook Edition
- Thru Enterprise Edition
- Thru Enterprise Server

## SOLUTIONS

- Centralized Online File Delivery
- Web FTP Replacement
- Enterprise
- Vertical

## CUSTOMER SUCCESSIES

### SERVICES

- Support Request
- Information Request
- Consulting
- Training
- Request/Asset Catalog
- Download

### Thru.

- About Thru.
- News
- Careers

### CONTACT

## Thru Web FTP Replacement

### FTP?

"File Transfer Protocol" or FTP has been around for a very long time. It works and lots of engineering professionals use it everyday. But when the average computer user has never heard of it, or let alone used it, that creates problems.

Face it, FTP is just hard to use sometimes even when you know how. This is why we invented the Thru Web Edition. Just point and click via your browser. No more tech support calls from your clients trying to upload files and asking how. Thru Web Edition is easy to use is much more secure than FTP and every file is virus scanned on upload.

Project Management? You bet...  
Project management and collaboration is easy with Thru Web Edition. With our simple-to-use group and permission management, you can set up the project with all the players in minutes with complete confidence that the users will only access what you want them to. You

Send Thru files or folders of any size  
Since files are not encoded via a mail client nor do they hit the mail server, any size is acceptable to send. On the receiving end, since Thru allows the receiver to pull only what they want when they want, even the largest email attachment won't plug up the system.

Send Thru complete folders with hierarchy intact

Now when you are doing a project that requires you to distribute a complete folder hierarchy, you can Thru, allows you to point and attach a mixture of any number of complete folders and files

Notification Systems

Want to know who is uploading or downloading your files or folders? Just set up the notifications system in Thru, and stay informed about any action taken on those files and folders

Microsoft Outlook integration

Want to work the same way you send email but with all the functionality of Thru Web Edition? Just download and install the New Thru Outlook Edition. Address the same files via this new and powerful tool

Virus checking on all files

You can rest files that are passed Thru. Every file is virus checked with the latest updated virus scanner.

Enterprise level unlimited size storage system

Need more space? The Thru, file system expands to the size you need. In fact, keep all your files on Thru, and never worry about having to backup. We do it for you.

External user access via the Thru **Dropbox**

Need files sent to you but the sender hasn't signed up yet? Have them upload directly to your Thru **Dropbox**. This way they are virus checked and safe. Stay in control! You don't need to accept files that could take your company down

Enterprise Group management tools

Permission and identity management for a large company is complex and requires synchronizing with current products used by the enterprise. Thru AD (Active Directory) gets your users up and running without the hassles of additional software. Secure, SSO and secure A

Please contact us to find out more [HERE](#)

**From:** John Morant Cone  
**To:** ["jslafsky@wsgr.com"](mailto:jslafsky@wsgr.com)  
**Bcc:** ["Lee Harrison"](#)  
**Subject:** Trademark DROPBOX  
**Date:** Friday, September 13, 2013 11:38:00 AM

---

Dear John:

As you will recall, I represent Thru, Inc. in trademark matters. My client has noted that you have successfully overcome the oppositions to your client Dropbox, Inc.'s trademark application No. 77/817,716 DROPBOX and are awaiting the Notice of Allowance. In addition, your client has taken an assignment of application No. 85/012,206 DROPBOX from Officeware Corp. d/b/a FilesAnywhere.com.

We have reviewed the publicly available portions of the Settlement and Assignment Agreement of April 22, 2013 between Dropbox, Inc. and Officeware Corp. d/b/a FilesAnywhere.com, including the so-called "Substantiation of Officeware's Rights" and Tim Rice's Declaration. We remain of the view that Thru, Inc.'s rights in DROPBOX have priority over any rights to that mark that Officeware may have purported to assign to your client. We are able to demonstrate use and marketing of DROPBOX in a variety of different geographic markets in early 2004.

Is your client interested in meeting with Thru, Inc. to discuss a resolution of these issues?

I look forward to hearing from you.

Best Regards,

John

**John M. Cone, PC**  
**Hitchcock Evert LLP**  
750 North St. Paul Street  
Suite 1110  
Dallas, Texas 75201  
+1-214-880-7002 (direct dial)  
+1-214-953-1121 (facsimile)  
[jccone@hitchcockevert.com](mailto:jccone@hitchcockevert.com)

This e-mail is sent by a law firm and may contain information that is privileged or confidential. If you are not the intended recipient, please delete the e-mail and any attachments and notify us immediately.