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

Proceeding	91200444
Party	Defendant Dropbox, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

OFFICEWARE CORPORATION d/b/a FILESANYWHERE.COM,)	Opposition No: 91200444
Opposer,)	
v.)	APPLICANT’S MOTION TO CONSOLIDATE
DROPBOX, INC.,)	
Applicant.)	Serial No. 77817716

A. INTRODUCTION

Applicant Dropbox, Inc. (“Dropbox”) hereby moves, pursuant to Fed. R. Civ. P. 42(a) and TBMP § 511, to consolidate Opposition No. 91200450, Opposition No. 91200444 and Opposition No. 91201367 because the three proceedings involve common questions of fact and law and the same disputed trademark application. In particular, all three proceedings involve similar challenges to Dropbox’s federal intent-to-use trademark application for the mark DROPBOX. The three opposers — Officeware Corporation (“Officeware”), YouSendIt, Inc. (“YouSendIt”) and Box.net, Inc. (“Box.net”) — each allege superior rights to the mark DROPBOX, claiming priority and likelihood of confusion. Dropbox denies the opposers’ substantive allegations and asserts affirmative defenses of laches, waiver, acquiescence and estoppel in each of the three proceedings.

Dropbox also requests that the Board reset the dates for the discovery and trial periods in these proceedings and that the Board suspend the proceedings pending disposition of this motion.

As set forth below, consolidating the three proceedings would result in significant savings of time and expense for the parties, prevent a wasteful duplication of effort and would create judicial economy for the Board. It would also avoid inconsistent decisions by the Board.

B. PROCEDURAL POSTURE

All three of the proceedings are at a very early stage: the parties have filed their respective pleadings and no discovery has been served. The proceedings are summarized as follows:

1. Officeware v. Dropbox

Officeware filed its Notice of Opposition on June 26, 2011. The Notice of Opposition alleges that Officeware owns superior rights to the mark DROPBOX and that the registration sought by Dropbox is likely to lead to confusion. Dropbox filed its Answer on August 5, 2011, denying the substantive allegations in the Notice of Opposition and asserting the affirmative defenses of laches, waiver, acquiescence and estoppel.

2. YouSendIt v. Dropbox

YouSendIt filed its Notice of Opposition on August 26, 2011. The Notice of Opposition alleges that YouSendIt owns superior rights to the mark DROPBOX and that the registration sought by Dropbox is likely to lead to confusion. Dropbox filed its Answer on September 23, 2011, denying the substantive allegations in the Notice of Opposition and asserting the affirmative defenses of laches, waiver, acquiescence and estoppel.

3. Box.net v. Dropbox

Box.net filed its Notice of Opposition on June 29, 2011. The Notice of Opposition alleges that Box.net owns superior rights to the mark DROPBOX and that the registration sought by Dropbox is likely to lead to confusion. Dropbox filed its Answer on August 5, 2011, denying

the substantive allegations in the Notice of Opposition and asserting the affirmative defenses of laches, waiver, acquiescence and estoppel.

C. DISCUSSION

The Board may consolidate multiple actions where the actions involve common questions of fact and law. Fed. R. Civ. P. 42(a); TBMP § 511. In determining whether to consolidate cases, the Board weighs the savings in time, effort and expense which may be gained from consolidation against any prejudice or inconvenience that consolidation could cause. TBMP § 511. Identity of the parties is not required. Charles Alan Wright & Arthur R. Miller, Federal Practice and Procedure §§ 2383, 2384 (3d ed. 2009). Nor is consent of the parties. *Id.*

These proceedings involve common questions of fact and law because they each involve questions related to (i) priority of rights to the mark DROPBOX, (ii) distinctiveness of the mark DROPBOX, (iii) the likelihood of confusion, if any, arising from Dropbox's application to register the mark DROPBOX and (iv) the defenses of laches, waiver, acquiescence and estoppel. The Board will apply to each of these proceedings the same likelihood of confusion factors set forth by the Federal Circuit in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), namely:

- i. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.
- ii. The similarity or dissimilarity and nature of the goods or services.
- iii. The similarity or dissimilarity of established, likely-to-continue trade channels.
- iv. The conditions under which and the buyers to whom sales are made, that is, 'impulse' vs. careful, sophisticated purchasing.
- v. The fame of the prior mark (sales, advertising, length of use).
- vi. The number and nature of similar marks in use on similar goods.

- vii. The nature and extent of any actual confusion.
- viii. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- ix. The variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark).
- x. The market interface between applicant and the owner of a prior mark.
- xi. The extent to which applicant has a right to exclude others from use of its mark on its goods.
- xii. The extent of potential confusion, *i.e.*, whether de minimis or substantial.
- xiii. Any other established fact probative of the effect of use.

Here, the evidence at trial will likely overlap in each separate proceeding given the similarity of the marks and the identical or substantially similar legal arguments by the Opposers and by Applicant.

If the three proceedings are not consolidated, then the parties will have to take and enter repetitive testimony and evidence in separate cases, file repetitive sets of briefs, and prepare for separate trials on similar issues. Consequently, the Board would have to waste its efforts reviewing the same record, reading similar briefs and preparing for duplicative trials.

Furthermore, if the three proceedings are not consolidated, then there is a risk of inconsistent decisions by the Board on each of the key questions cited above. In particular, the conflicting claims of priority at issue in these proceedings provide context for one another and should be evaluated simultaneously in order to reach a single consistent result.

None of the parties will be prejudiced by consolidation, given the very early stage of each of the three proceedings.

D. CONCLUSION

For the foregoing reasons, Dropbox therefore respectfully requests that the Board grant its motion to consolidate Opposition No. 91200450, 91200444 and 91201367 and reset the dates for the discovery and trial periods in these proceedings. Dropbox also respectfully requests that the Board suspend these proceedings pending disposition of this motion.

Dated: September 23, 2011

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: /John L. Slafsky/
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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 this **MOTION TO CONSOLIDATE** 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.

Remy M. Davis
Thompson & Knight LLP
1722 Routh Street, Suite 1500
Dallas, TX 75201

I declare under penalty of perjury that the foregoing is true and correct. Executed at Palo Alto, California on September 23, 2011.

/Elvira Minjarez/
Elvira Minjarez