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

Proceeding	92061714
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Mark: DIYTHEMES  
Reg. No.: 4010482  
Reg. Date: August 9, 2011

Mark: THESIS THEME  
Reg. No.: 4061171  
Reg. Date: November 22, 2011

Mark: THESIS  
Reg. No.: 4039583  
Reg. Date: October 11, 2011

Automatic Inc.,  Petitioner,  v.  Chris Pearson,  Respondent.	Cancellation No.: 92/061,714  <b>REQUEST FOR RECONSIDERATION OF BOARD DECISION</b>
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**REQUEST FOR RECONSIDERATION OF BOARD DECISION**

**I. INTRODUCTION**

Pursuant to 37 CFR 2.129(c), Petitioner Automatic Inc. (“Petitioner” or “Automatic”) hereby requests reconsideration of the Decision of the Board, dated April 20, 2017. In the Decision, the Board dismissed the above-titled cancellation proceeding on the basis that Petitioner failed to prove the necessary standing to bring this action. Petitioner respectfully submits that Petitioner properly pled and proved standing, and requests that the Board reconsider

its decision to dismiss this proceeding and instead issue a ruling in Petitioner's favor based on the merits of this case.

## **II. ARGUMENTS**

### **A. Petitioner Properly Pled Standing With Respect to the Mark THESIS**

Petitioner respectfully submits that it pled and proved standing to seek cancellation of the THESIS Mark. There is no dispute that Respondent sought to transfer the <thesis.com> domain to itself in a URDU action. That the URDU proceeding concluded—in Petitioner's favor—does not eliminate the ongoing potential harm to Petitioner. Petitioner therefore asks the Board to reconsider its decision that Petitioner lacks standing with respect to the mark THESIS.

#### **1. The Board's Ruling With Respect to the Mark THESIS**

The Board held that Petitioner lacks standing because Petitioner failed to plead and prove how Petitioner would be damaged by the continued registration of Respondent's THESIS mark. The Board acknowledged that Petitioner's original pleading alleged harm on the basis of Respondent's URDU action seeking mandatory transfer of Petitioner's <thesis.com> domain name; however, the Board ruled that Petitioner failed to properly prove this allegation of harm vis a vis the URDU action, and also ruled that Respondent's assertions in the Answer did not constitute an admission sufficient to support Petitioner's allegation of harm. Petitioner respectfully disagrees with the Board's conclusion.

#### **2. Petitioner Faces Ongoing Harm from Respondent's Registration of the Mark THESIS**

Respondent's attempt to commandeer Petitioner's <thesis.com.> domain via a URDU action gives Petitioner standing to challenge the Mark THESIS. The URDU action is properly

pled and part of the record in the above-captioned cancellation proceeding. In Paragraph No. 18 of the Petition to Cancel, Petitioner alleged:

18. Mr. Pearson has filed a Uniform Domain Name Dispute Resolution Policy proceeding, challenging ownership by Petitioner of the domain name <thesis.com>, which domain was acquired by Petitioner in 2014.

See Pet. to Cancel, ¶ 18.

In response to this allegation, Respondent asserted:

18. Respondent admits to the allegations contained in Paragraph 18 insofar that he did file the URDU proceeding. However, that case has been resolved and Respondent is unaware of any other on-going litigation between the parties except for this Trademark cancellation.

See Answer, ¶ 18.

Previous Board decisions have held that a petitioner has a real interest in the proceeding and a reasonable belief of harm—and, therefore, standing—if the trademark owner relied on its application or registration in another proceeding between the parties. *See Tonka Corp. v. Tonka Tools, Inc.*, 229 SUP 857, 859 (TAB 1986) (petitioner has standing to cancel registration that has been asserted, even defensively, in a civil action).

Applicant respectfully submits that the allegations in Paragraph 18 do exactly that: they plead harm by virtue of the fact that Respondent asserted his registration for THESIS to support a URDU action to challenge Petitioner’s ownership and use of the <thesis.com> domain name. What is more, Respondent admitted as much in his Answer to the Petition to Cancel, stating that he did, in fact, file the URDU action.

Respondent’s assertion that “the case has been resolved” is both misleading and irrelevant. The matter was not “resolved.” Petitioner and Respondent did not reach some sort of

agreement regarding the domain. Rather, Petitioner successfully defended against the URDU action because – despite asserting trademark rights in THESIS – Respondent failed to prove that Petitioner registered and used the <thesis.com> domain name in bad faith.

However, the fact that Respondent was unsuccessful in depriving Petitioner of a valuable domain that it acquired in good faith does *not* diminish the fact that Respondent still used the THESIS registration to launch an adversarial proceeding against Petitioner. Petitioner has already been damaged by the registration of THESIS; and Petitioner will continue to suffer harm. Importantly, with his THESIS registration in hand, Respondent may continue his efforts to harass Petitioner with further legal proceedings in an effort to deprive Petitioner of its <thesis.com> domain based on the Respondent’s registration. Indeed, the fact that Respondent has already done so is all the more reason to be wary of Respondent’s future actions.

In view of the above, Petitioner respectfully submits that it successfully demonstrated reasonable harm – and therefore standing – by virtue of Respondent’s admission that he filed an adversarial proceeding in which he asserted the THESIS mark and registration against Petitioner. As such, Petitioner respectfully requests that the Board reconsider its ruling as it relates to Petitioner’s standing to bring this cancellation proceeding with respect to Respondent’s registration for THESIS.

**B. Petitioner Properly Pled Standing With Respect to the Marks THESIS THEME and DIYTHEMES**

Petitioner also respectfully submits that it sufficiently pled and proved standing with respect to the marks DIYTHEMES and THESIS THEME. Specifically, Petitioner sought to cancel both marks on the grounds that DIYTHEMES is descriptive and THESIS THEME is deceptively *mis*descriptive. The term “theme”—as the evidence in the record demonstrates—is

generic for a type of software used in connection with webpage design and online publishing (see Petitioner’s First Notice of Reliance, Exhibits F and G), including Petitioner’s services that utilize the term “theme” in this descriptive manner (see Petitioner’s First Notice of Reliance, Exhibits I-L). Petitioner has a direct interest in Respondent’s effort to monopolize this generic term.

### **1. The Board’s Ruling with Respect to the Marks THESIS THEME and DIYTHEMES**

The Board held in its ruling that the evidence submitted in support of Petitioner’s claim of descriptiveness was insufficient to show Petitioner’s standing in this proceeding. Petitioner respectfully disagrees with the Board’s conclusion for the reasons discussed below.

#### **C. Petitioner Has a Direct Interest in Respondent’s Attempt to Monopolize a Generic Web Publishing Term**

Petitioner respectfully submits that it has standing to challenge Respondent’s attempt to monopolize a generic web publishing term. The facts asserted in its trial brief specifically reference the WordPress® platform and the generic term “theme” to identify a type of website publishing software on that platform (and in the broader online publishing industry). Paragraph A in Petitioner’s trial brief (“Automattic and the WordPress® Platform”) identifies Petitioner as the commercial and marketing source of WordPress.com – a hosted version of the WordPress® platform – since 2005. Petitioner’s statement of facts goes on to recite its use of “theme” as a generic type of software offered by Petitioner and others who provide software for use in the web publishing industry (e.g., “...one of hundreds of available WordPress® themes...”) and that such “themes” allow a website owner (like a WordPress.com user) to customize the look and feel of his or her website (“WordPress users can easily choose the look or feel of their websites by incorporating one of hundreds of available WordPress® themes”). As explained in Petitioner’s trial brief,

the term “theme” is commonly defined as “a subject of discourse, discussion . . . or composition.” See Pet. First Not. Rel., Exhibit G. However, in the context of website design software, consumers understand this term to mean, “a unified set of design elements and color schemes that you apply to pages to give them a consistent and attractive appearance.” See Pet. First Not. Rel., Exhibit F. Respondent is one of numerous producers of different themes that consumers use to customize the look and feel of blogs and websites created using WordPress® software. See Pet. First Not. Rel., Exhibits I-L. Thus, “theme” is a generic term to describe the type of website software offered by Respondent. Exhibits I-L in Petitioner’s Notice of Reliance illustrate such generic use of “theme” as it relates to users of the WordPress® platform in particular.

Petitioner respectfully submits that this evidence sufficiently demonstrates the nature of Petitioner’s services, and its need (along with the need of others in the WordPress community and the broader website publishing industry) to utilize the generic term “theme” to promote its software and services for website creation and maintenance.

In addition, Petitioner submits that the Board erred in its determination that this evidence is not admissible as hearsay. While Petitioner acknowledges that hearsay evidence may not be admitted to prove the truth of a matter asserted, Petitioner respectfully submits that the websites contained in these exhibits are not presented to support the truth of any statements made on the websites themselves – but merely to show that the term “theme” does appear as a commonly-used, generic term within the relevant industry. In other words, the documents are being presented for the value they present on their face: that sellers and providers of web “theme” software widely use this term within the industry to identify their products. For example, Exhibit L includes screenshots from the third-party website “Themecircle” which lists “Best WordPress Themes for 2016.” This evidence is not introduced to support the assertion that these





**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing PETITIONER'S  
REQUEST FOR RECONSIDERATION OF BOARD DECISION is served upon Respondent  
electronically on May 22, 2017:

Chris Pearson  
PO Box 5429  
Austin, TX 78763-5429

[deucetwo@gmail.com](mailto:deucetwo@gmail.com)

Dated: May 22, 2017

By:                   /Marina A. Lewis/                    
Marina A. Lewis