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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

DROPBOX, INC.,
Plaintiff,
v.
THRU INC.,
Defendant.

Case No. [15-cv-01741-EMC](#)

**ORDER GRANTING PLAINTIFF’S
MOTION FOR SUMMARY JUDGMENT**

Docket No. 97

I. INTRODUCTION

Plaintiff Dropbox, Inc. (“Dropbox”) brought this action for declaratory relief seeking to establish its right to use the term “dropbox” as a trademark. Docket No. 1. Defendant Thru Inc. (“Thru”) brought counterclaims for trademark infringement under the Lanham Act, 15 U.S.C. § 1125(a)(1)(A), and California common law, and for unfair competition under Cal. Bus. & Prof. Code § 17200 et seq. and cancellation of Dropbox’s trademark registration under 15 U.S.C. § 1119. Docket No. 33. Now pending before the Court is Dropbox’s motion for summary judgment on Thru’s counterclaims. Docket No. 97 (“Motion”). The Court **GRANTS** the motion.

II. FACTUAL AND PROCEDURAL BACKGROUND

Dropbox is a large software company that produces an application allowing people to store, access, and modify electronic files online. Today, Dropbox has over 500 million users. Docket No. 98 (Vashee Decl.) ¶ 5. As of 2014, the company was valued at \$10 billion. The company was founded in 2006. Co-founder and CEO Drew Houston states that he planned to use the name “Dropbox” from the start, having previously used folders called “dropboxes” to share files with other computer users. Docket No. 99 (Houston Decl.) ¶¶ 3-4. Dropbox launched its product in 2008, and it quickly attracted numerous users and significant press coverage. *Id.* ¶¶ 16-

1 23. In late 2009, Dropbox applied to the United States Patent and Trademark Office (“PTO”) to
2 register the DROPBOX trademark. *Id.* ¶ 24. Its application was published in March 2011.
3 Docket No. 100 (Slafsky Decl.) ¶ 3.

4 After this publication, other companies claimed rights in the “dropbox.” In June 2011, a
5 company called Officeware sued Dropbox claiming common law trademark rights in the term,
6 having used it beginning in 2004 to describe functionality similar to that offered by Dropbox. Ex.
7 5.¹ The parties reached a settlement according to which Officeware assigned its rights to
8 Dropbox. Ex. 7. Also in 2011, Dropbox received demands from two other companies, YouSendIt
9 and DropBoks, each of which claimed similar rights. Slafsky Decl. ¶ 13. Dropbox contended that
10 the term was merely descriptive as used by these companies – indeed, the PTO had already denied
11 a trademark application from DropBoks on this ground – and the companies ultimately did not
12 press their claims. The PTO issued Dropbox a trademark registration for DROPBOX in February
13 2014. *Id.* ¶ 4.

14 Defendant Thru is a company based in Texas that has, since 2002, offered a file
15 management software program called File Transaction Hub (FTH). Docket No. 109 (Harrison
16 Decl.) ¶ 2. In 2004, Thru added a feature that allowed its customers to receive digital files from
17 third parties; it called this feature “DropBox.” *Id.* ¶ 12. In May 2004, Thru asked all of its
18 employees to include the term in their email signature blocks. *See* Harrison Decl. Ex. 29. It also
19 appears that Thru at times – though not always – appended a TM symbol when it used the
20 “DropBox” designator on documents intended for customers and the general public, indicating its
21 intent to use the term as a trademark. *Compare id.* Ex. 2 (using the symbol in an FTH user guide)
22 *with* Ex. 3 (using the term DropBox without the symbol on the company web page).

23 Thru took no action to enforce any trademark rights in the term “dropbox” until December
24 8, 2011, when Thru’s counsel contacted Dropbox for the first time, asserting that Thru had “used
25 its mark DROPBOX continuously since 2004.” Ex. 28. Counsel stated that Thru was “aware of
26 the current trademark dispute regarding the mark” between Dropbox, Officeware, “and several

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28 ¹ Except where otherwise noted, “Ex.” refers to exhibits attached to the Slafsky declaration,
Docket No. 100.

1 other claimants,” but asserted that Thru’s rights that would take priority to any of those parties.
2 *Id.* Thru asserts that after that point it offered to meet with Dropbox on multiple occasions “to
3 resolve the ownership question.” Docket No. 107 (“Opp.”) at 19. On February 4, 2014, when the
4 PTO issued Dropbox’s trademark registration, Thru filed a Petition for Cancellation, but it did not
5 otherwise take any action until Dropbox initiated the present suit on April 17, 2015. Thru then
6 filed counterclaims for trademark infringement under the Lanham Act and California common
7 law, and for unfair competition under Cal. Bus. & Prof. Code § 17200 et seq. and cancellation of
8 Dropbox’s trademark registration under 15 U.S.C. § 1119. Docket No. 33. Following discovery,
9 Dropbox filed the instant motion for summary judgment on Thru’s counterclaims.

10 **III. DISCUSSION**

11 A. Legal Standard

12 “Summary judgment is appropriate only if, taking the evidence and all reasonable
13 inferences drawn therefrom in the light most favorable to the non-moving party, there are no
14 genuine issues of material fact and the moving party is entitled to judgment as a matter of law.”
15 *Torres v. City of Madera*, 648 F.3d 1119, 1123 (9th Cir. 2011) (citing *Corales v. Bennett*, 567 F.3d
16 554, 562 (9th Cir. 2009)). “[T]here is no issue for trial unless there is sufficient evidence favoring
17 the nonmoving party for a jury to return a verdict for that party. If the evidence is merely
18 colorable, or is not significantly probative, summary judgment may be granted.” *McIndoe v.*
19 *Huntington Ingalls Inc.*, 817 F.3d 1170, 1173 (9th Cir. 2016) (quoting *R.W. Beck & Assocs. v. City*
20 *& Borough of Sitka*, 27 F.3d 1475, 1480 n.4 (9th Cir. 1994)).

21 “A moving party without the ultimate burden of persuasion at trial” – such as Dropbox in
22 this case – nonetheless “has both the initial burden of production and the ultimate burden of
23 persuasion on a motion for summary judgment.” *Nissan Fire & Marine Ins. Co. v. Fritz*
24 *Companies, Inc.*, 210 F.3d 1099, 1102 (9th Cir. 2000). The moving party may discharge its initial
25 burden by “show[ing] that the nonmoving party does not have enough evidence of an essential
26 element to carry its ultimate burden of persuasion at trial.” *Friedman v. Live Nation Merch., Inc.*,
27 833 F.3d 1180, 1188 (9th Cir. 2016) (quoting *Nissan Fire*, 210 F.3d at 1102). Where “a moving
28 party carries its burden of production, the nonmoving party must produce evidence to support its

1 claim or defense.” *Id.* (quoting *Nissan Fire*, 210 F.3d at 1102). The ultimate question at summary
 2 judgment is whether “the record taken as a whole could . . . lead a rational trier of fact to find for
 3 the non-moving party”; if not, then “there is no ‘genuine issue for trial.’” *Matsushita Elec. Indus.*
 4 *Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986) (quoting *First Nat. Bank of Ariz. v. Cities*
 5 *Serv. Co.*, 391 U.S. 253, 287 (1968)); *see also Dominguez-Curry v. Nevada Transp. Dep’t*, 424
 6 F.3d 1027, 1039 (9th Cir. 2005).

7 Dropbox argues that it is entitled to summary judgment for three reasons: (1) Thru has no
 8 trademark rights in “dropbox” because it failed to use it as a trademark and because “dropbox” is
 9 descriptive and Thru has not established secondary meaning; (2) even if Thru could demonstrate a
 10 protectable interest in “dropbox,” Dropbox would have seniority by virtue of its acquisition of
 11 Officeware’s rights; and (3) Thru’s claims are barred by laches.

12 B. Laches

13 The Court first addresses Dropbox’s argument that Thru’s claims are barred by laches.
 14 “Laches is an equitable time limitation on a party’s right to bring suit,” . . . resting on the maxim
 15 that “one who seeks the help of a court of equity must not sleep on his rights.” *Jarrow Formulas,*
 16 *Inc. v. Nutrition Now, Inc.*, 304 F.3d 829, 835 (9th Cir. 2002) (quoting *Boone v. Mech. Specialties*
 17 *Co.*, 609 F.2d 956, 958 (9th Cir.1979)). “As the party asserting laches, [Dropbox] must show that
 18 (1) [Thru]’s delay in filing suit was unreasonable, and (2) [Dropbox] would suffer prejudice
 19 caused by the delay if the suit were to continue.” *Id.* at 838. “While laches and the statute of
 20 limitations are distinct defenses, a laches determination is made with reference to the limitations
 21 period for the analogous action at law. If the plaintiff filed suit within the analogous limitations
 22 period, the strong presumption is that laches is inapplicable. . . . However, if suit is filed outside of
 23 the analogous limitations period, courts often have presumed that laches is applicable.” *Id.* at 836.
 24 “When a federal statute lacks a specific statute of limitations, we generally presume that Congress
 25 intended to ‘borrow’ the limitations period from the most closely analogous action under state
 26 law.” *Id.* “[I]n determining the presumption for laches, the limitations period runs from the time
 27 the plaintiff knew or should have known about his [Lanham Act] cause of action.” *Id.* at 838.

28 The first question, then, is whether Thru has brought its claims within the applicable

1 limitations period. Thru asserts that the applicable limitations period is four years under
2 California’s “catch-all” limitations period, as set out in Cal. Prof. Bus. & Prof. Code § 17208.
3 Dropbox suggests that the more appropriate limitations period might be the two-year limitations
4 period for tort claims under Cal. Code Civ. P. § 339, but argues that Thru’s claim is untimely
5 whether the four year period or the two year period applies. The Court agrees.

6 In an interrogatory response verified by Thru CEO Lee Harrison, Thru stated that “Thru’s
7 directors and management first became aware of Dropbox, Inc., and its use of DROPBOX in mid-
8 2011” and that “Thru’s directors and management is not aware of any employee that was aware of
9 Dropbox, Inc. and its use of DROPBOX at any earlier date.” Ex. 40. Record evidence shows that
10 this is not the case. On June 9, 2009, Thru’s Chief Technology Officer sent an email to the
11 Harrison, as well as other officers, informing them about Dropbox, which offered another service
12 “to sync the files across computers.” Ex. 42. On June 15, 2009, the CTO wrote again, asking
13 “[a]re we ok with web-only write only dropbox or we will need [sic] something like
14 getdropbox.com²? They are very prominent in Mac community.” Ex. 43. In a sworn deposition,
15 Harrison nonetheless insisted again that he had never heard of Dropbox before the summer of
16 2011, at which point Dropbox had 40 million users. Ex. 34 at 138:20. When confronted with the
17 CTO’s 2009 emails, however, Harrison conceded that his interrogatory response had been “false.”
18 *Id.* at 162:3-4. In light of this evidence, Harrison’s continued assertion that “[Dropbox] did not get
19 [his] attention until 2011” is simply not credible. “When opposing parties tell two different
20 stories, one of which is blatantly contradicted by the record, so that no reasonable jury could
21 believe it, a court should not adopt that version of the facts for purposes of ruling on a motion for
22 summary judgment.” *Scott v. Harris*, 550 U.S. 372 (2007). This is especially so where the only
23 evidence supporting them on this point is concededly false.

24 As the above evidence demonstrates, Thru’s statement in its briefing on the present motion
25 that “there is no evidence (or at least a factual dispute as to the evidence), that Thru knew or
26 should have known of its claim against [Dropbox] prior to July 2011” is plainly false. Opp. at 18.

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² At the time of this email, getdropbox.com was Dropbox’s web address.

1 Thru's officers, including its CEO, corresponded over email about Dropbox as early as June 2009,
2 and Harrison conceded in his deposition that his earlier statement, that the company had not
3 learned of Dropbox until 2011, was "false." Ex. 34. Moreover, Harrison stated in Thru's Rule
4 30(b)(6) deposition that in 2009, Thru believed that Dropbox's use of its name was
5 "overwhelmingly an obvious violation of what we believe is our trademark." Ex. 39 at 139-141.
6 The evidence is simply uncontestable that Thru actually knew of Dropbox's use of what Thru
7 believed was its trademark beginning in 2009.

8 Thru asserts that it nonetheless was not required to act at that point because it "believed
9 [Dropbox]'s use to be non-competitive or minimal in light of the customers Thru was targeting."
10 Opp. at 22 (citing Harrison Decl.. Specifically, Thru claims it believed Dropbox was a purely
11 consumer-oriented technology, while it targeted businesses. See Harrison Decl. ¶ 28; Docket No.
12 108 Ex. 24 (Deposition of Thru's Former VP of Marketing and Product Strategy Thomas
13 Skybakmoen). That, too, is not plausible. First of all, an email in the record shows that as early as
14 January 2010, Thru was aware that it had lost at least one customer to Dropbox, which, the
15 customer stated, "serve[d] [his] needs, both professionally and personally." Ex. 44. But in any
16 case, "the law is well settled that, where the question of laches is in issue the plaintiff is chargeable
17 with such knowledge *as he might have obtained upon inquiry*, provided the facts already known
18 by him were such as to put upon a man of ordinary intelligence the duty of inquiry." 6 McCarthy
19 on Trademarks § 31:38 (4th ed.) (quoting *Johnston v. Standard Mining Co.*, 148 U.S. 360 (1893))
20 (emphasis added). It is not disputed that by June 2009, Dropbox had over one million customers,
21 and had been widely covered in the mainstream media, including coverage detailing business use
22 of the product. See Ex. 91 (January 2009 NY Times article discussing business applications of
23 Dropbox); Houston Decl. ¶ 20-22 (citing 2009 articles about Dropbox appearing in Forbes, PC
24 Magazine, CNN, The Washington Post, and others and describing the growth in Dropbox's user
25 base during 2009). Even if you were to credit this implausible testimony that it was not aware of
26 Dropbox's commercial business in 2009, it clearly had inquiry notice sufficient to trigger laches.
27 A company such as Thru in the business of providing online file storage and transfer software
28 should have been aware of what was, by then, the preeminent company offering similar products

1 in the field, and that this company posed a competitive threat. No reasonable fact finder could
2 conclude otherwise. The Court therefore concludes that the limitations period began running in
3 June 2009; because Thru had still taken no action in June 2013, when the four-year period expired,
4 laches presumptively applies.

5 Thru nonetheless argues that its delay was reasonable, first because it took some action
6 during the intervening period, including sending its December 2011 demand letter to Dropbox.
7 Opp. at 18-19. But “the delay, which the defense (of laches) contemplates, is not delay in bringing
8 claims to the attention of the defendant. It is . . . delay on the part of the plaintiff in instituting
9 litigation on his claims.” *Danjaq LLC v. Sony Corp.*, 263 F.3d 942, 953 (9th Cir. 2001) (quoting
10 *Nealey v. Transportacion Maritima Mexicana, S.A.*, 662 F.2d 1275, 1280 n. 6 (9th Cir.1980)).

11 Thru also argues that it was not required to act because, during 2011, after Dropbox’s
12 registration was published, a number of other parties, including Officeware, YouSendIt, and
13 Box.net, opposed Dropbox’s trademark application to the PTO and claimed rights in the term
14 “dropbox.” Thru argues that it “could not tell which of these parties had superior rights in the
15 DROPBOX mark and decided to let them fight it out and then pursue the party that the PTO
16 affirmed.” Opp. at 20. Thru provides no excuse why it did not join the other companies in
17 asserting its own trademark rights before the PTO in a timely way. Indeed, a delay of this sort is
18 precisely what laches is designed to guard against; Thru cannot simply “sleep on [its] rights,”
19 allowing multiple other parties to expend significant resources litigating over rights that Thru
20 believes it owns, only to belatedly pursue the victorious party. *See Jarrow Formulas*, 304 F.3d at
21 835. Such an approach would unfairly prejudice all of the companies who *did* timely join the fray
22 by asserting their claims. Thru cites a case that it claims allowed a similar approach, but in fact
23 the case is inapplicable. *See Novell, Inc. v. Unicom Sales, Inc.*, No. C-03-2785 MMC, 2004 WL
24 1839117, at *1 (N.D. Cal. Aug. 17, 2004) In *Novell*, this court excused a party’s delay in bringing
25 suit when that party was, itself, already engaged in litigation over its right to use a trademark, and
26 thus its right to bring suit was unsettled. Furthermore, the defendant in that case had promised to
27 stop the allegedly infringing use, and the plaintiff promptly brought suit when the defendant broke
28 the promise.

1 Nor can Thru's petition for cancellation of Dropbox's trademark, filed with the PTO on
2 February 4, 2014, salvage its claim. First, that petition was itself filed outside the limitations
3 period. As noted above, it did not timely oppose Dropbox's application to the PTO in 2011.
4 Second, while the 2014 proceeding challenged Dropbox's registration, Thru has conceded that it
5 did *not* challenge Dropbox's right to continue using the mark. *See* Docket No. 19 (Thru's Motion
6 to Dismiss) ("Thru has not and does not contest Plaintiff's use of the DROPBOX mark.").
7 Nothing about the cancellation petition put Dropbox on notice that its name was at risk; instead,
8 Thru continued to delay litigation while allowing Dropbox to expend additional resources
9 developing the value of its brand.

10 Finally, and perhaps most significantly, the record belies Thru's explanation for the reason
11 behind its delay. Dropbox points to numerous documents that indicate that, in fact, Thru's delay
12 was a deliberate attempt to maximize the value of its claims by leveraging an anticipated initial
13 public offering from Dropbox. Thru had been explicitly contemplating a lawsuit concerning its
14 trademark rights at least since February 2012, when Harrison wrote in an email to an investor:
15 "New development turns out we own the term Dropbox . . . Our IP attorney is talking to
16 Dropbox's attorney about buying the name from us . . . They raised 250M in October 2011 at 1B
17 value. . . . An action could be had soon." Ex. 47. Harrison repeatedly in emails described Thru's
18 claim as a "lottery ticket." Ex. 54 (discussing whether "a portion of the staff [had] no skin in DB
19 lottery ticket game"); Ex. 62 ("Dropbox will be a lottery ticket."). In October 2013 Harrison
20 wrote that "My call is [Dropbox] want[s] us to file a lawsuit and treat us like [Officeware] so they
21 can quietly dispose of this matter anytime they want to . . . The best leverage we have is to sit tight
22 and wait to the IPO announcement and be prepared to file suit that day and make as much noise as
23 we can about it." Ex. 51; *see also* Ex. 57 ("If we wanted to be the first to file we should have done
24 that last year. Time is on our side not theirs. Slow walking this to [Dropbox's pre-IPO] S1 filing
25 is all that is important."). In his deposition, Harrison confirmed that he had felt that a pending IPO
26 "was a leverage point," that "it would be tough for them to file without clear title" to their
27 trademark, and that accordingly Dropbox "would come to us eventually and settle with us." Ex.
28 34 at 187.

1 accordingly holds that Thru's claims are barred by laches, and **GRANTS** Dropbox's motion for
2 summary judgment on that ground. Because this determination is sufficient to decide the motion,
3 the Court does not reach Dropbox's alternative arguments for summary judgment.

4 This order disposes of Docket No. 97.

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6 **IT IS SO ORDERED.**

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8 Dated: November 15, 2016

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EDWARD M. CHEN
United States District Judge

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