

ESTTA Tracking number: **ESTTA274044**

Filing date: **03/24/2009**

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

Proceeding	91183753
Party	Plaintiff Heaven Hill Distilleries, Inc.
Correspondence Address	Matthew A. Williams Wyatt, Tarrant & Combs, LLP 500 W. Jefferson Street, Suite 2800 Louisville, KY 40202 UNITED STATES mwilliams@wyattfirm.com, mcapiro@wyattfirm.com
Submission	Motion to Extend
Filer's Name	Matthew A. Williams
Filer's e-mail	mwilliams@wyattfirm.com
Signature	/Matthew A. Williams/
Date	03/24/2009
Attachments	91183753_Motion_for_Extension_of_Time.pdf ( 44 pages )(820325 bytes )

Certificate of Electronic Filing

I hereby certify that this document is being electronically filed as of **March 24th, 2009**, with the United States Patent and Trademark Office, Trademark Trial and Appeal Board.

/Matthew A. Williams/  
Matthew A. Williams  
**March 24th, 2009**

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

HEAVEN HILL DISTILLERIES, INC.,	)		
	)		
Opposer,	)	Opposition No.	91183753
	)		
v.	)		
	)	Serial No.	77/266,196
DIALLO YASSINN PATRICE,	)	Mark:	HYPNOTIZER
	)	Intl Class:	033
Respondent.	)		

**OPPOSER'S MOTION FOR AN EXTENSION OF TIME**

Pursuant to Rule 6(b) of the Federal Rules of Civil Procedure and Section 509.01(a) of the TTAB Manual of Procedure, Opposer Heaven Hill Distilleries, Inc. ("Heaven Hill") hereby moves for an extension of time as set forth below in the current proceeding, Opposition Number 91183753.

<b>Event</b>	<b>Current Deadline</b>	<b>Proposed Deadline</b>
Expert Disclosures Due	31 March 2009	90 days after Board's Grant of Motion
Discovery Closes	30 April 2009	30 days after Expert Disclosure deadline
Plaintiff's Pretrial Disclosures	14 June 2009	75 days after Expert Disclosure deadline
Plaintiff's 30-day Trial Period Ends	29 July 2009	120 days after Expert Disclosure deadline
Defendant's Pretrial Disclosures	13 August 2009	135 days after Expert Disclosure deadline
Defendant's 30-day Trial Period Ends	27 September 2009	180 days after Expert Disclosure deadline
Plaintiff's Rebuttal Disclosures	12 October 2009	195 days after Expert Disclosure deadline
Plaintiff's 15-day Rebuttal Period Ends	11 November 2009	225 days after Expert Disclosure deadline

Heaven Hill made numerous attempts to contact Respondent, Diallo Yassinn Patrice before finally receiving a perfunctory email response on March 20th, 2009, in which Diallo refused to agree to an extension of time. Respondent gave no reason for his refusal to agree to the requested extension and did not respond to a follow-up email from counsel for Heaven Hill. Thus, Heaven Hill was left with no other option than to file this motion.

A Memorandum in Support of this Motion is attached.

Respectfully submitted,

/Matthew A. Williams /

David A. Calhoun

Matthew A. Williams

Michael A. Capiro

WYATT, TARRANT & COMBS, LLP

500 West Jefferson Street, Suite 2800

Louisville, Kentucky 40202-2898

(502) 589-5235

***Counsel for Opposer, Heaven Hill  
Distilleries, Inc.***

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and complete copy of the foregoing Motion has been served upon:

Diallo Yassinn Patrice  
2 Square Tribord  
Courcouronnes 91080  
France

via Federal Express, International Priority, this **24th** day of **March, 2009**.

/Matthew A. Williams/  
*One of Counsel for Opposer, Heaven Hill  
Distilleries, Inc.*

20312216.3

Certificate of Electronic Filing

I hereby certify that this document is being electronically filed as of **March 24th, 2009**, with the United States Patent and Trademark Office, Trademark Trial and Appeal Board.

/Matthew A. Williams/  
Matthew A. Williams

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

HEAVEN HILL DISTILLERIES, INC.,	)		
	)		
Opposer,	)	Opposition No.	91183753
	)		
v.	)		
	)	Serial No.	77/266,196
DIALLO YASSINN PATRICE,	)	Mark:	HYPNOTIZER
	)	Intl Class:	033
Respondent.	)		

**MEMORANDUM IN SUPPORT OF OPPOSER'S  
MOTION FOR AN EXTENSION OF TIME**

Opposer, Heaven Hill Distilleries, Inc. ("Heaven Hill") files this Memorandum in support of its Motion for an Extension of Time to extend the deadlines in Opposition Number 91183753.

Despite Heaven Hill's diligent effort to advance this proceeding, the deadlines reset by the Board in its February 24, 2009 Order denying Heaven Hill's Motion for Summary Judgment do not allow Heaven Hill sufficient time to complete discovery and prepare for trial. Heaven Hill sought agreement from Respondent, Diallo Yassinn Patrice ("Diallo") to an extension of these deadlines. Diallo would not agree to Heaven Hill's request. Therefore, Heaven Hill respectfully requests the Board grant the Motion for an Extension of Time and extend the deadlines in this proceeding as set forth in its Motion for an Extension of Time.

## **STATEMENT OF FACTS**

On August 28, 2007, Diallo filed Application Serial No. 77/266,196 to register the mark HYPNOTIZER for alcoholic beverages in international class 033. On April 8, 2008, the application was published for opposition and Heaven Hill timely filed the current proceeding, Opposition No. 91183753, to protect its HPNOTIQ mark against Diallo's confusingly similar HYPNOTIZER mark.

Since filing this Opposition on April 25, 2008, Heaven Hill has attempted to expedite the resolution of this matter and minimize the expense for each party. Early on, Heaven Hill proposed to Diallo the use of the Board's Accelerated Case Resolution procedure, but Diallo rejected the proposal (Affidavit of Matthew A. Williams ("Williams Affidavit"), attached hereto as Exhibit A, ¶12, Ex. 9). On November 4, 2008, Heaven Hill again attempted to expedite the resolution of this matter by filing a Motion for Summary Judgment, believing there were no factual issues to be resolved in this matter. The Board subsequently issued an order to stay the proceedings on November 13, 2008, pending a decision on the motion. Accordingly, Heaven Hill took no depositions and did not engage any experts to prepare for trial during the pendency of its motion.

On February 24, 2009, the Board issued an Order denying Heaven Hill's motion on the ground that the Board found there to be a factual issue to be resolved concerning the likelihood of confusion between Heaven Hill's HPNOTIQ mark and Diallo's HYPNOTIZER mark. In this Order, the Board also reset the remaining deadlines in this proceeding. In particular, the Expert Disclosure Deadline was reset for March 31, 2009, a mere five (5) weeks following the Board's denial of Heaven Hill's motion, and the close of discovery was reset for April 30, 2009.

As noted above, having genuinely believed that this case would be resolved by summary judgment, Heaven Hill did not proceed with trial preparation after filing its summary judgment motion. After studying the Board's Order and preparing a trial plan, Heaven Hill concluded that the reset deadlines, in particular the deadlines for expert disclosures and the close of discovery, would not provide it with sufficient time to properly prepare its case for trial (Williams Affidavit ¶4). Accordingly, on March 11, 2009, counsel for Heaven Hill sent a letter to Diallo by electronic mail and Federal Express seeking Diallo's agreement to extend the deadlines by ninety (90) days (*Id.* ¶5, Ex. 1.) Counsel for Heaven Hill subsequently received confirmation that the electronic mail was forwarded to Diallo's email address on March 11, 2009 and confirmation from Federal Express that the letter was delivered on March 13, 2009 (*Id.* ¶5, Exs. 2 and 3). Heaven Hill's counsel then attempted, unsuccessfully, to contact Diallo by telephone at the number listed in U.S. Application Serial No. 77/266,196 on March 13, 2009 and March 18, 2009 to discuss the requested extension (*Id.* ¶4).

Having not received a response from Diallo and having been unable to reach Diallo by telephone, Heaven Hill's counsel sent a second letter to Diallo, again by electronic mail and Federal Express, on March 18, 2009 (*Id.* ¶7, Ex. 4). As with the prior letter, Heaven Hill's counsel received confirmation that the electronic mail was forwarded to Diallo's email address on March 18, 2009 (*Id.* ¶7, Ex. 5). Heaven Hill's counsel again attempted, without success, to contact Diallo by telephone on March 19, 2009 (*Id.* ¶8). Heaven Hill's counsel thereafter received confirmation from Federal Express that the second letter was delivered on March 20, 2009 (*Id.* ¶7, Ex. 6).

Finally, on March 20, 2009, Diallo responded to counsel for Heaven Hill via email, rejecting Heaven Hill's request without explanation (*Id.* ¶9, Ex. 7). On March 20, 2009,

Heaven Hill's counsel replied to Diallo via email, noting that parties to opposition proceedings routinely agree to such requests and asking him to reconsider his position (*Id.* ¶10, Ex. 8). As of the date Heaven Hill's Motion for an Extension of Time was filed, no further response had been received from Diallo (*Id.* ¶11).

Thus, Heaven Hill was left with no option but to file this Motion for an Extension of Time.

### **ARGUMENT**

Pursuant to Section 509.01 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), a party to a Board proceeding "may file a motion for an enlargement of the time in which an act is required or allowed to be done." *See also* 37 CFR 2.116(a) and Fed. R. Civ. P. 6(b). When, as here, such a motion is filed as a motion to extend, i.e. before the expiration of the period for which an extension has been requested, the Board should grant the motion upon a showing of good cause by the moving party. TBMP §509.01(a) (citing Fed. R. Civ. P. 6(b)). So long as the moving party has not been guilty of negligence or bad faith and has not otherwise abused the privilege of extension, the Board is generally liberal in granting extensions of time. *See, e.g., American Vitamin Products, Inc. v. Dow Brands, Inc.*, 22 U.S.P.Q.2d 1313 (TTAB 1992) (finding good cause to grant the requested extension of time to respond to interrogatories because the party was "continuing to gather information needed to respond"); *see also Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 U.S.P.Q. 147 (TTAB 1985).

Here, Heaven Hill previously moved for summary judgment on the belief that there were no disputed issues of material fact. Upon the suspension of the proceeding for the Board to consider its motion, Heaven Hill reasonably and justifiably suspended its efforts to prepare the case for trial since such efforts would have been unnecessary if its motion had been

granted. Upon receiving the Board's Order denying its motion, Heaven Hill timely reviewed the Order, determined what proof it would need to present at trial and how to gather that proof, and evaluated its ability to prepare its case for trial under the deadlines as reset by the Board in the Order. Within two (2) weeks of the Order being issued, Heaven Hill realized that it would not be able to prepare its case for trial within the reset deadlines.

Upon determining that the reset dates did not provide sufficient time for Heaven Hill to prepare for trial, counsel for Heaven Hill promptly sought Diallo's consent to a short extension of the deadlines in this proceeding. Following Heaven Hill's repeated attempts to contact Diallo and discuss this request, Diallo responded with a perfunctory email refusing, without explanation, Heaven Hill's requested extension. Counsel for Heaven Hill replied to Diallo's response by noting that parties routinely agree to such extensions in proceedings in front of the Board and requesting that he reconsider his position. Since Diallo has not responded to Heaven Hill's latest communication, Heaven Hill was left with no choice but to proceed with this Motion for an Extension of Time.

Heaven Hill has demonstrated good cause justifying its first request for an extension to the deadlines in this proceeding. The five (5) week period between the Board Order resetting the deadlines and the Expert Disclosure deadline simply does not provide Heaven Hill with sufficient time to determine whether it wishes to engage one or more experts to support its case, identify and engage said one or more experts, and provide the required expert disclosure before the deadline. Moreover, since the case itself was formally suspended by the Board, Heaven Hill could not have engaged in additional discovery during the pendency of the motion.

Diallo will not be unduly prejudiced by the requested extension. Diallo rejected Heaven Hill's request to utilize the Board's Accelerated Case Resolution procedure, and he has

repeatedly delayed in responding to requests from Heaven Hill's counsel for agreement on this and other procedural matters. Heaven Hill has been diligent in its prosecution of this matter and has not sought to delay the proceeding or otherwise acted in bad faith or in a dilatory manner.

Having shown good cause for the extension of time and demonstrated that it has not been negligent or acted in bad faith and having shown that Diallo will not be unduly prejudice by an extension, Heaven Hill respectfully requests that the Board reset the deadlines such that the Expert Disclosure Deadline will be set for ninety (90) days following the date on which the Board grants Heaven Hill's motion and the dates for the remaining deadlines following thereafter as set forth in the motion. This differs from the request that was made to Diallo because Heaven Hill does not want to incur the expense of investigating, and potentially engaging, experts until the Board has granted Heaven Hill's request for an extension of time and thereby providing Heaven Hill with sufficient time to meet the deadline for expert disclosures.

### **SUMMARY**

Heaven Hill has filed this first Motion for an Extension of Time only after repeated attempts to obtain Diallo's consent to an extension proved unsuccessful. Since Diallo refused to consent to Heaven Hill's requested extension, Heaven Hill has been left with no choice but to seek the Board's approval of the Motion so that Heaven Hill may adequately prepare for trial. Heaven Hill has shown good cause; thus, the Board should grant Heaven Hill's Motion for an Extension of Time.

Respectfully submitted,

/Matthew A. Williams/

David A. Calhoun

Matthew A. Williams

Michael A. Capiro

WYATT, TARRANT & COMBS, LLP

500 West Jefferson Street, Suite 2800

Louisville, Kentucky 40202-2898

(502) 589-5235

*Counsel for Opposer, Heaven Hill  
Distilleries, Inc.*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and complete copy of the foregoing Memorandum in Support of Opposer's Motion for an Extension of Time of has been served upon:

Diallo Yassinn Patrice  
2 Square Tribord  
Courcouronnes 91080  
France

via Federal Express, International Priority, this **24th** day of **March, 2009**.

/Matthew A. Williams/

*One of Counsel for Opposer, Heaven Hill  
Distilleries, Inc.*

20312211.5

**EXHIBIT A**  
**AFFIDAVIT OF MATTHEW A. WILLIAMS**

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

HEAVEN HILL DISTILLERIES, INC.,	)		
	)		
Opposer,	)	Opposition No.	91183753
	)		
v.	)		
	)	Serial No.	77/266,196
DIALLO YASSINN PATRICE,	)	Mark:	HYPNOTIZER
	)	Intl Class:	033
Respondent.	)		

**AFFIDAVIT OF MATTHEW A. WILLIAMS**

Comes now the Affiant, Matthew A. Williams, after first having been duly sworn, and hereby states as follows:

1. I am over 18 years of age, and I have personal knowledge of the matters described in this Affidavit.
2. I am submitting this Affidavit in support of the Memorandum in Support of Opposer's Motion for an Extension of Time that is being filed in the above-captioned proceeding.
3. I am an attorney with Wyatt, Tarrant & Combs, LLP in Louisville, Kentucky, and I represent Heaven Hill Distilleries, Inc. ("Heaven Hill") in this proceeding.
4. On February 24, 2009, the Trademark Trial and Appeal Board ("Board") issued an order denying Heaven Hill's Motion for Summary Judgment. Following a review of the decision by Heaven Hill, it was determined that the deadlines set by the Board would not provide Heaven Hill with sufficient time to prepare its case for trial.
5. On March 11, 2009, approximately two (2) weeks after the Board issued the order resetting the deadlines, I sent a letter to Respondent, Diallo Yassinn Patrice ("Diallo") via electronic mail to Diallo's email address, yassinn.diallo@laposte.ne, and Federal Express's FedEx International Priority service requesting agreement to extend the deadlines in the Board's

Order of February 24, 2009 by ninety (90) days. A copy of this letter is attached hereto as Exhibit 1. On March 11, 2009, I received electronic confirmation that the electronic mail was relayed to Diallo's email address. A copy of this confirmation is attached hereto as Exhibit 2. On March 13, 2009, Federal Express confirmed that the letter was delivered on March 13, 2009. A copy of this confirmation is attached hereto as Exhibit 3.

6. I then attempted to contact Diallo by telephone at the number listed in U.S. Application Serial No. 77/266,196 on March 13, 2009 and March 18, 2009 but was unable to reach him.

7. On March 18, 2009, I sent a second letter to Diallo reiterating the original request for agreement to an extension of time via electronic mail to Diallo's email address, yassinn.diallo@laposte.ne, and Federal Express's FedEx International Priority service requesting agreement to an extension of time. A copy of this letter is attached hereto as Exhibit 4. On March 18, 2009, I received electronic confirmation that the electronic mail was relayed to Diallo's email address. A copy of this confirmation is attached hereto as Exhibit 5. On March 20, 2009, Federal Express confirmed that the letter was delivered on March 20, 2009. A copy of this confirmation is attached hereto as Exhibit 6.

8. On March 19, 2009, I again attempted to contact Diallo via telephone and was unable to reach him.

9. On March 20, 2009, I received an email reply from Diallo rejecting my request for an extension of time and stating, "The current deadlines set by the TTAB will be respected." A copy of Diallo's email is attached hereto as Exhibit 7.



# **EXHIBIT 1**



500 West Jefferson Street, Suite 2800  
Louisville, Kentucky 40202-2898  
502.589.5235  
502.589.0309

Matthew A. Williams  
502.562.7378  
mwilliams@wyattfirm.com

March 11, 2009

**via ELECTRONIC MAIL; confirmation via FEDERAL EXPRESS**

Diallo Yassinn Patrice  
2 Square Tribord  
COURCOURONNES 91080  
FRANCE

**Re: U.S. Opposition No. 91183753**

Dear Mr. Diallo:

In light of the Trademark Trial and Appeal Board's recent decision, the Board has reset the deadlines in the proceedings as stated below. As you can see, the expert disclosure deadline is quite imminent. Accordingly, to give each side sufficient time to prepare its case for trial, we would like to file a stipulation with the Board to extend the deadlines for ninety (90) days. This would extend the deadlines to the dates shown below.

Event	Current Deadline	Proposed Deadline
Expert Disclosures Due	31 March 2009	29 June 2009
Discovery Closes	30 April 2009	29 July 2009
Plaintiff's Pretrial Disclosures	14 June 2009	12 September 2009
Plaintiff's 30-day Trial Period Ends	29 July 2009	27 October 2009
Defendant's Pretrial Disclosures	13 August 2009	11 November 2009
Defendant's 30-day Trial Period Ends	27 September 2009	26 December 2009
Plaintiff's Rebuttal Disclosures	12 October 2009	10 January 2010
Plaintiff's 15-day Rebuttal Period Ends	11 November 2009	9 February 2010

Please let me know if this proposal is acceptable to you.



Diallo Yassinn Patrice  
March 11, 2009  
Page 2

If you would like to discuss this request in further detail, please feel free to call me at your convenience. If you would prefer that I call you, please email me back with your phone number and a time that would be convenient for me to call.

Very truly yours,

WYATT, TARRANT & COMBS, LLP

A handwritten signature in black ink, appearing to read "Matthew A. Williams". The signature is written in a cursive, flowing style.

Matthew A. Williams

MAW/dkl

20311735.1

## **EXHIBIT 2**

---

**From:** postmaster account  
**Sent:** Wednesday, March 11, 2009 11:31 AM  
**To:** Williams, Matthew  
**Subject:** Delivery Notification - Message successfully relayed.

**Attachments:** ATT793890.txt; ATT793891.txt



ATT793890.txt ATT793891.txt (1  
(465 B) KB)

The following recipients have been successfully relayed.  
<yassinn.diallo@laposte.net>

=====  
This message is a confidential communication and may be protected by attorney-client  
privilege.  
If you believe that it has been sent to you in error, do not read it.  
Please reply to the sender that you received the message in error, then delete it. Thank  
you.  
=====

ATT793890.txt

Reporting-MTA: dns;lousmtp2.wyattfirm.org

Final-Recipient: rfc822;<yassinn.diallo@laposte.net>

Action: RELAYED

Status: 2.1.5 (250 ok)

Remote-MTA: dns;193.251.214.113

ATT793891.txt

Received: from [10.5.25.22] by lousmtp2.wyattfirm.org with ESMTTP (Tumbleweed Email Firewall SMTP Relay (Email Firewall v6.3.1)); wed, 11 Mar 2009 11:30:20 -0400  
X-Server-Uuid: 3E76CC72-C8A3-4B61-9DF2-70FDF867CB54  
Content-class: urn:content-classes:message  
Return-Receipt-To: "Williams, Matthew" <mwilliams@wyattfirm.com>  
MIME-Version: 1.0  
Disposition-Notification-To: "Williams, Matthew" <mwilliams@wyattfirm.com>  
X-MimeOLE: Produced By Microsoft Exchange V6.5  
Subject: U.S. Opposition Proceeding 91183753  
Date: wed, 11 Mar 2009 11:30:21 -0400  
Message-ID: <99D39A1363197447B0EB525EE2B44C15015EC9DE@Lou-Exch1.wyattfirm.org>  
X-MS-Has-Attach: yes  
X-MS-TNEF-Correlator:  
Thread-Topic: U.S. Opposition Proceeding 91183753  
Thread-Index: AcmixknelIqsFOk3SEipuVMhClcU3Q==  
From: "Williams, Matthew" <mwilliams@wyattfirm.com>  
To: "yassinn.diallo" <yassinn.diallo@laposte.net>  
X-WSS-ID: 65A906862942210090-01-01  
Content-Type: multipart/mixed;  
boundary="----=\_NextPart\_001\_01C9A25E.49A74238"  
Content-Transfer-Encoding: 7bit

## **EXHIBIT 3**

---

**From:** TrackingUpdates@fedex.com  
**Sent:** Friday, March 13, 2009 8:57 AM  
**To:** Laney, Deb  
**Subject:** FedEx Shipment 796418495617 Delivered

---

This tracking update has been requested by:

Company Name: Wyatt  
Name: Matthew A. Williams  
E-mail: dlaney@wyattfirm.com

---

Our records indicate that the following shipment has been delivered:

Reference: 019354.029312  
Ship (P/U) date: Mar 11, 2009  
Delivery date: Mar 13, 2009 12:00 PM  
Sign for by: D.IALLO  
Delivered to: Receptionist/Front Desk  
Service type: FedEx International Priority  
Packaging type: FedEx Envelope  
Number of pieces: 1  
Weight: 1.00 lb.  
Special handling/Services: Deliver Weekday

Tracking number: 796418495617

Shipper Information	Recipient Information
MATTHEW A. WILLIAMS	DIALLO YASSINN PATRICE
WYATT	2 SQUARE TRIBORD
500 WEST JEFFERSON STREET; SUITE 2600	COURCOURONNES
LOUISVILLE	FR
KY	91080
US	
40202	

Please do not respond to this message. This email was sent from an unattended mailbox. This report was generated at approximately 7:57 AM CDT on 03/13/2009.

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To track the latest status of your shipment, click on the tracking number above, or visit us at [fedex.com](http://fedex.com).

This tracking update has been sent to you by FedEx on the behalf of the Requestor noted above. FedEx does not validate the authenticity of the requestor and does not validate, guarantee or warrant the authenticity of the request, the requestor's message, or the accuracy of this tracking update. For tracking results and fedex.com's terms of use, go to [fedex.com](http://fedex.com).

Thank you for your business.

3/16/2009

## **EXHIBIT 4**

March 18, 2009

**via ELECTRONIC MAIL; confirmation via FEDERAL EXPRESS**

Diallo Yassinn Patrice  
2 Square Tribord  
COURCOURONNES 91080  
FRANCE

COPIE

**Re: U.S. Opposition No. 91183753**

Dear Mr. Diallo:

This letter is in follow up to the letter that I sent you via electronic mail and Federal Express on 11 March 2009 (a copy of which is enclosed) requesting your agreement to extend the deadlines in the above-referenced proceeding as shown in the table below.

Event	Current Deadline	Proposed Deadline
Expert Disclosures Due	31 March 2009	29 June 2009
Discovery Closes	30 April 2009	29 July 2009
Plaintiff's Pretrial Disclosures	14 June 2009	12 September 2009
Plaintiff's 30-day Trial Period Ends	29 July 2009	27 October 2009
Defendant's Pretrial Disclosures	13 August 2009	11 November 2009
Defendant's 30-day Trial Period Ends	27 September 2009	26 December 2009
Plaintiff's Rebuttal Disclosures	12 October 2009	10 January 2010
Plaintiff's 15-day Rebuttal Period Ends	11 November 2009	9 February 2010

I have not yet received a response from you, even though I received a receipt indicating that my email was properly relayed to your email address, yassinn.diallo@laposte.net, on 11 March 2009 and Federal Express has confirmed delivery of the letter to you on 13 March 2009. In addition, I have attempted to call you several times at 164972059 on 13 March 2009 and 18

Diallo Yassinn Patrice  
March 18, 2009  
Page 2

March 2009 without success.

As noted in my prior letter, the purpose of this extension is to give each party sufficient time to prepare its case for trial in the wake of the TTAB's recent ruling on the motion for summary judgment.

If we do not hear from you by the end of the week, we will proceed with a motion to the TTAB requesting that the dates be extended as shown in the above table.

Very truly yours,

WYATT, TARRANT & COMBS, LLP



Matthew A. Williams

Enclosure  
MAW/dkl

March 11, 2009

**via ELECTRONIC MAIL; confirmation via FEDERAL EXPRESS**

Diallo Yassinn Patrice  
2 Square Tribord  
COURCOURONNES 91080  
FRANCE

Re: **U.S. Opposition No. 91183753**

Dear Mr. Diallo:

In light of the Trademark Trial and Appeal Board's recent decision, the Board has reset the deadlines in the proceedings as stated below. As you can see, the expert disclosure deadline is quite imminent. Accordingly, to give each side sufficient time to prepare its case for trial, we would like to file a stipulation with the Board to extend the deadlines for ninety (90) days. This would extend the deadlines to the dates shown below.

Event	Current Deadline	Proposed Deadline
Expert Disclosures Due	31 March 2009	29 June 2009
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Defendant's 30-day Trial Period Ends	27 September 2009	26 December 2009
Plaintiff's Rebuttal Disclosures	12 October 2009	10 January 2010
Plaintiff's 15-day Rebuttal Period Ends	11 November 2009	9 February 2010

Please let me know if this proposal is acceptable to you.

Diallo Yassinn Patrice  
March 11, 2009  
Page 2

If you would like to discuss this request in further detail, please feel free to call me at your convenience. If you would prefer that I call you, please email me back with your phone number and a time that would be convenient for me to call.

Very truly yours,

WYATT, TARRANT & COMBS, LLP



Matthew A. Williams

MAW/dkl

## **EXHIBIT 5**

---

**From:** postmaster account  
**Sent:** Wednesday, March 18, 2009 9:56 AM  
**To:** Williams, Matthew  
**Subject:** Delivery Notification - Message successfully relayed.

**Attachments:** ATT1313804.txt; ATT1313805.txt



ATT1313804.txt ATT1313805.txt (1  
(469 B) KB)

The following recipients have been successfully relayed.  
<yassinn.diallo@laposte.net>

=====  
This message is a confidential communication and may be protected by attorney-client privilege.  
If you believe that it has been sent to you in error, do not read it.  
Please reply to the sender that you received the message in error, then delete it. Thank you.  
=====

ATT1313804.txt

Reporting-MTA: dns;lousmtp2.wyattfirm.org

Final-Recipient: rfc822;<yassinn.diallo@laposte.net>

Action: RELAYED

Status: 2.1.5 (250 Ok)

Remote-MTA: dns;193.251.214.113

ATT1313805.txt

Received: from [10.5.25.22] by lousmtp2.wyattfirm.org with ESMTTP (Tumbleweed Email Firewall SMTP Relay (Email Firewall v6.3.1)); wed, 18 Mar 2009 09:55:45 -0400  
X-Server-Uid: 3E76CC72-C8A3-4B61-9DF2-70FDF867CB54  
X-MimeOLE: Produced By Microsoft Exchange V6.5  
Content-class: urn:content-classes:message  
Return-Receipt-To: "Williams, Matthew" <mwilliams@wyattfirm.com>  
MIME-Version: 1.0  
Disposition-Notification-To: "Williams, Matthew" <mwilliams@wyattfirm.com>  
Subject: U.S. Opposition Proceeding 91183753  
Date: wed, 18 Mar 2009 09:55:45 -0400  
Message-ID: <99D39A1363197447B0EB525EE2B44C1501630710@Lou-Exch1.wyattfirm.org>  
X-MS-Has-Attach: yes  
X-MS-TNEF-Correlator:  
Thread-Topic: U.S. Opposition Proceeding 91183753  
Thread-Index: AcmiXknelIqsFOk3SEipuVMhClcu3Q==  
From: "Williams, Matthew" <mwilliams@wyattfirm.com>  
To: "yassinn.diallo" <yassinn.diallo@laposte.net>  
X-WSS-ID: 65DE22EB2942528872-01-01  
Content-Type: multipart/mixed;  
boundary="-----=\_NextPart\_001\_01C9A7D1.3C0BA9F2"  
Content-Transfer-Encoding: 7bit

# **EXHIBIT 6**

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**From:** TrackingUpdates@fedex.com  
**Sent:** Friday, March 20, 2009 5:12 AM  
**To:** Laney, Deb  
**Subject:** FedEx Shipment 797426001683 Delivered

---

This tracking update has been requested by:

Company Name: Wyatt  
Name: Matthew A. Williams  
E-mail: dlaney@wyattfirm.com

---

Our records indicate that the following shipment has been delivered:

Reference: 019354.029312  
Ship (P/U) date: Mar 18, 2009  
Delivery date: Mar 20, 2009 9:47 AM  
Sign for by: C.C  
Delivered to: Receptionist/Front Desk  
Service type: FedEx International Priority  
Packaging type: FedEx Envelope  
Number of pieces: 1  
Weight: 1.00 kg.  
Special handling/Services: Deliver Weekday

Tracking number: 797426001683

Shipper Information	Recipient Information
MATTHEW A. WILLIAMS	DIALLO YASSINN PATRICE
WYATT	2 SQUARE TRIBORD
500 WEST JEFFERSON STREET; SUITE 2600	COURCOURONNES
LOUISVILLE	FR
KY	91080
US	
40202	

Please do not respond to this message. This email was sent from an unattended mailbox. This report was generated at approximately 4:11 AM CDT on 03/20/2009.

Learn more about new ways to track with FedEx.

All weights are estimated.

To track the latest status of your shipment, click on the tracking number above, or visit us at [fedex.com](http://fedex.com).

This tracking update has been sent to you by FedEx on the behalf of the Requestor noted above. FedEx does not validate the authenticity of the requestor and does not validate, guarantee or warrant the authenticity of the request, the requestor's message, or the accuracy of this tracking update. For tracking results and fedex.com's terms of use, go to [fedex.com](http://fedex.com).

Thank you for your business.

3/20/2009

## **EXHIBIT 7**

---

**From:** yassinn.diallo [yassinn.diallo@laposte.net]  
**Sent:** Friday, March 20, 2009 7:02 AM  
**To:** Williams, Matthew  
**Subject:** Re:U.S. Opposition Proceeding 91183753

Dear Matthew A Williams,

Thank for requesting the extension,

But we would like to stick the current deadlines set by the TTAB decisions following the denial of the summary judgment.

The current deadlines set by the TTAB will be respected.

Very truly yours,

Yassinn Patrice DIALLO.

> Message du 18/03/09 14:55  
> De : "Williams, Matthew"  
> A : "yassinn.diallo"  
> Copie à :  
> Objet : U.S. Opposition Proceeding 91183753  
>  
>

Dear Mr. Diallo,

Please see the attached correspondence regarding a proposed extension to the deadlines in this matter, and please let me know if the proposal is acceptable to you.

If you would like to discuss this request in further detail, please feel free to call me at your convenience. If you would prefer that I call you, please email me back with your phone number and a time that would be convenient for me to call.

Very truly yours,

Matt

Matthew A. Williams  
WYATT, TARRANT & COMBS, LLP  
500 W. Jefferson Street, Suite 2800  
Louisville, Kentucky 40202  
502.562.7378 (direct telephone)  
502.589.0309 (facsimile)  
[mwilliams@wyattfirm.com](mailto:mwilliams@wyattfirm.com) (e-mail)

*Click below to learn more about Wyatt:*  
[www.wyattfirm.com](http://www.wyattfirm.com)

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----- This message is a confidential commu.

>

> [ 20090318 Letter to Diallo.pdf (147.3 Ko) ]

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3/24/2009

## **EXHIBIT 8**

---

**From:** Williams, Matthew  
**Sent:** Friday, March 20, 2009 7:17 AM  
**To:** yassinn.diallo  
**Subject:** RE: U.S. Opposition Proceeding 91183753

Dear Mr. Diallo,

We are disappointed that you have refused our request for an extension of the deadlines in the above-referenced proceeding. As noted, the extension request has been sought in order to provide the parties with sufficient time to prepare their respective cases for trial. Such extensions are routinely agreed to in the course of practice before the USPTO in proceedings such as this. I hope that you will reconsider your decision. If not, we will be forced to file a motion with the Board requesting that it order the requested extension of time.

Please feel free to call me if you would like to discuss this matter further.

Very truly yours,  
Matt

Matthew A. Williams  
WYATT, TARRANT & COMBS, LLP  
500 W. Jefferson Street, Suite 2800  
Louisville, Kentucky 40202  
502.562.7378 (direct telephone)  
502.589.0309 (facsimile)  
[mwilliams@wyattfirm.com](mailto:mwilliams@wyattfirm.com) (e-mail)

*Click below to learn more about Wyatt:*  
[www.wyattfirm.com](http://www.wyattfirm.com)

---

**From:** yassinn.diallo [mailto:yassinn.diallo@laposte.net]  
**Sent:** Friday, March 20, 2009 7:02 AM  
**To:** Williams, Matthew  
**Subject:** Re:U.S. Opposition Proceeding 91183753

Dear Matthew A Williams,

Thank for requesting the extension,

But we would like to stick the current deadlines set by the TTAB decisions following the denial of the summary judgment.

The current deadlines set by the TTAB will be respected.

Very truly yours,

Yassinn Patrice DIALLO.

| > Message du 18/03/09 14:55  
| > De : "Williams, Matthew"

3/24/2009

> A : "yassinn.diallo"  
> Copie à :  
> Objet : U.S. Opposition Proceeding 91183753  
>  
>

Dear Mr. Diallo,

Please see the attached correspondence regarding a proposed extension to the deadlines in this matter, and please let me know if the proposal is acceptable to you.

If you would like to discuss this request in further detail, please feel free to call me at your convenience. If you would prefer that I call you, please email me back with your phone number and a time that would be convenient for me to call.

Very truly yours,

Matt

Matthew A. Williams  
WYATT, TARRANT & COMBS, LLP  
500 W. Jefferson Street, Suite 2800  
Louisville, Kentucky 40202  
502.562.7378 (direct telephone)  
502.589.0309 (facsimile)  
[mwilliams@wyattfirm.com](mailto:mwilliams@wyattfirm.com) (e-mail)

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>

===== This message is a conf

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> [ 20090318 Letter to Diallo.pdf (147.3 Ko) ]

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## **EXHIBIT 9**

June 9, 2008

via OVERNIGHT COURIER

Diallo Yassinn Patrice  
2 Square Tribord  
COURCOURONNES 91080  
FRANCE

RE: Discovery Conference for U.S. Opposition No. 91183753

Dear Mr. Patrice:

Pursuant to the TTAB's scheduling order in this proceeding, the parties are required to have a Discovery Conference on or before July 4, 2008 to discuss the following matters:

1. the nature of and basis for their respective claims and defenses;
2. the possibility of settling the case or at least narrowing the scope of claims or defenses; and
3. arrangements relating to mandatory disclosures, discovery, and introduction of evidence at trial, if an agreement to settle the case cannot be reached.

To facilitate this discussion, we have attached a proposed discovery plan for your review and comment. Please note that we have made two additional proposals under section 4 of the plan. First, we believe that service of papers by either email or fax communication would be the most efficient method of service. Under Section 2.119(b) of the TTAB rules, the parties may mutually agree to accept service by such electronic communications. If this is not acceptable to you, we respectfully request that you serve all papers on us via an overnight courier rather than using first class French mail as you did with your Answer. We believe that mailing such papers through the French postal system is not proper method of service because Section 113.04 of the TTAB Manual of Procedure states that the TTAB considers the mailing date of a paper under Section §2.119(b)(4) "to be the

Diallo Yassinn Patrice  
June 9, 2008  
Page 2

date when the paper is deposited with the United States Postal Service." (emphasis added)

Second, we believe that this matter is appropriate for the TTAB's Accelerated Case Resolution ("ACR") process. The ACR process allows the parties to seek a final determination on this matter quickly, without the time and expense of a full trial. Because of the limited amount of discovery necessary in this matter, an expeditious resolution would be advantageous to both parties.

Finally, please email the dates on which you would be available to schedule a telephonic Discovery Conference to me at [mwilliams@wyattfirm.com](mailto:mwilliams@wyattfirm.com). Due to the time difference, we suggest that the conference be scheduled between 8:00 A.M. and noon EDT (which would be between 2:00 and 6:00 in the afternoon Paris time). If possible, we would also like to schedule the conference to occur no later than Wednesday June 18, 2008.

I look forward to hearing from you.

Very truly yours,

WYATT, TARRANT & COMBS, LLP



Matthew A. Williams

MAW/jma  
Enclosure

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

HEAVEN HILL DISTILLERIES, INC	)		
	)		
Opposer	)	Opposition No.	91183753
	)		
v.	)		
	)	Application No.:	77/266,196
	)	Filing Date:	August 28, 2007
DIALLO YASSINN PATRICE	)	Mark:	HYPNOTIZER
	)	Intl Class:	033
	)		
Respondent.	)		

**REPORT OF THE PARTIES' PLANNING MEETING**

1. Pursuant to Federal Rule of Civil Procedure ("Rule") 26(f), a meeting was held on June \_\_, 2008, by telephone and was attended by:

David A. Calhoun, Matthew A. Williams, and Michael A. Capiro for  
Opposer Heaven Hill Distilleries, Inc.

Diallo Yassinn Patrice as *pro se* Respondent.

2. **Pre-Discovery Disclosures.** The parties will exchange by August 3, 2008, the information required by Rule 26(a)(1).
3. **Discovery Plan.** The parties jointly propose to the court the following discovery plan:

- (a) Opposer anticipates taking discovery on the following:

Use of the HYPNOTIZER mark by Respondent, including but not limited to marketing efforts for products under the HYPNOTIZER mark, offers for sale of product under the HYPNOTIZER mark, and sales of products by Opposer under the HYPNOTIZER mark;

Products on which Respondent is using, or plans to use, the HYPNOTIZER mark;

Similarity of the parties' respective marks;

Actual confusion that may have occurred between Opposer's HPNOTIQ mark and Respondent's HYPNOTIZER mark;

Respondent's knowledge of Opposer's HPNOTIQ mark and of Opposer's use of the HPNOTIQ mark when Respondent filed Application Serial No. 77/266,196 being opposed herein;

Defendant's experts and any opinions rendered on behalf of defendants; and

Damages.

- (b) Defendants anticipate taking discovery on the following:

*To be provided by Defendant*

- (c) All written discovery and lay depositions to be completed by December 31, 2008.
- (d) The parties agree that the limitations on depositions and interrogatories set forth in the Federal Rules of Civil Procedure shall govern discovery in this case.
- (e) Reports from retained experts under Rule 26 are due on December 1, 2008.
- (f) Supplementation under Rule 26(e) to be provided as needed.

**4. Other Items**

- (a) The parties agree, pursuant to TTAB Rule 2.119(b), that service via email is acceptable for all communications related to this proceeding.

Plaintiff: mwilliams@wyattfirm.com

Defendant: yassinn.diallo@laposte.net

- (b) The parties request the resolution of this matter utilizing the Accelerated Case Resolution (ACR) process, and the interlocutory attorney will be notified of said request.