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

Proceeding	91193067
Party	Plaintiff Heidelberg University
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Submission	Motion to Suspend for Settlement Discussions
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Date	11/12/2015
Attachments	51094_Motion_Suspend_91193067_HU.pdf(28786 bytes )

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

In the Matter of Trademark Application Serial No. 77/636,839  
Mark: HEIDELBERG UNIVERSITY  
Filed: December 19, 2008  
Publication Date: June 23, 2009

HEIDELBERG UNIVERSITY,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91193067
	)	
HEIDELBERG UNIVERSITY,	)	
	)	
Applicant.	)	
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MOTION TO SUSPEND WITH CONSENT

Opposer, Heidelberg University, hereby moves, with the consent of Applicant, to suspend the discovery and trial periods for 180 days, as follows:

Time to Answer:	CLOSED
Deadline for Discovery Conference:	CLOSED
Discovery Opens:	CLOSED
Initial Disclosures Due:	CLOSED
Expert Disclosure Due:	05/25/2016
Discovery Closes:	06/24/2016
Plaintiff's Pretrial Disclosures:	08/08/2016
Plaintiff's 30-day Trial Period Ends:	09/22/2016
Defendant's Pretrial Disclosures:	10/07/2016
Defendant's 30-day Trial Period Ends:	11/21/2016
Plaintiff's Rebuttal Disclosures:	12/06/2016

Plaintiff's 15-day Rebuttal Period Ends:

01/05/2017

This request is necessitated by good cause, and is not made for purposes of delay. The parties mutually insist that a further suspension of proceedings is necessary, useful, and appropriate.

The parties have been actively negotiating a particular settlement framework since February 2013. During this time, the parties have routinely exchanged proposals and engaged in extensive discussions regarding the details of this settlement framework. The settlement framework involves not only U.S. rights, but also international rights. The negotiation process has taken longer than desired because of the considerable number and complexity of issues involved. In addition, one of the parties is a foreign entity.

As previously reported, the parties have reached an agreement in principle on a settlement framework that would resolve this opposition proceeding. It was previously stated that the potential settlement needed to be reduced to writing and put in final form for formal approval by the respective parties. Further, the parties stated that a number of minor details still required further discussions between the parties.

Subsequently, the parties exchanged multiple drafts of the various agreements necessary to effectuate the settlement framework that has been discussed since February 2013. This process resulted in many issues being tentatively resolved in principle, including the general mechanics of a settlement framework whereby the parties could use certain specific service marks in the United States and around the world.

During the present suspension, the parties conducted an in-person meeting, and held several further conversations, in an attempt to resolve the few remaining issues. As a result, the parties believe that an agreeable settlement has been reached in principle. However, at least one party requires the formal approval of its governing Board of

Trustees prior to any settlement being accepted. Currently, the parties are working to reduce the potential settlement framework to writing in final form so that the settlement can be formally approved. Because of the large number and complexity of issues involved in the settlement framework, the parties simply cannot complete this task prior to the end of the present suspension, despite their best efforts to do so.

In compliance with the Board's order dated May 28, 2015, the parties report that the issues previously reported to be outstanding have been resolved in principle. Previously, the parties reported that the issues remaining to be resolved included the finer details of the settlement framework. Currently, the parties have reached a mutually agreeable framework.

The parties also report that no additional discovery has been conducted during the present suspension. Previously, interrogatories, requests for admissions, and requests for production of documents were served and responded to by both parties. Should the parties be unable to ultimately reach a settlement, additional discovery would be necessary.

As before, the parties desire to be able to report a firm timetable for resolution. However, given the nature of the parties and the complexity of the issues involved, it is not possible to set a firm timetable for resolution. The parties mutually convey that best efforts are being made to reach a settlement. Both parties sincerely hope that this opposition proceeding will be finally resolved by the end of the requested suspension period.

Given the present posture of settlement negotiations, the parties mutually desire to avoid the time and expense of engaging experts and conducting further discovery.

Engaging experts and conducting further discovery would also detract from the efforts that will be needed to finalize and effectuate the settlement.

Should the Board wish for further details regarding the issues involved in the settlement framework or the efforts of the parties in reaching a final settlement, the parties' attorneys are available for a conference call to discuss the current settlement negotiations at the convenience of the Board.

Heidelberg University has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

Heidelberg University has provided an email address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board: [emch@mstfirm.com](mailto:emch@mstfirm.com) (Gregg W. Emch, attorney for Opposer) and [Lara.Holzman@alston.com](mailto:Lara.Holzman@alston.com) (Lara A. Holzman, attorney for Applicant).

Dated: Toledo, Ohio  
November 12, 2015

Respectfully submitted,  
MacMILLAN, SOBANSKI & TODD, LLC

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*Attorneys for Opposer*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address of record by Facsimile or email (by agreement only), on November 12, 2015.

/Gregg W. Emch/  
Gregg W. Emch