

ESTTA Tracking number: **ESTTA388955**

Filing date: **01/18/2011**

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

Proceeding	91194772
Party	Plaintiff Cannery Casino Resorts, LLC
Correspondence Address	JAMES D. BOYLE, ESQ. SANTORO DRIGGS WALCH KEARNEY HOLLEY & THOMPSON 400 SOUTH FOURTH STREET, THIRD FLOOR LAS VEGAS, NV 89101 UNITED STATES tip@nevadafirm.com
Submission	Opposition/Response to Motion
Filer's Name	Kim Cooper
Filer's e-mail	tip@nevadafirm.com
Signature	/Kim Cooper/
Date	01/18/2011
Attachments	Opposer's Response to Applicant's Request to Expedite.pdf (8 pages)(337518 bytes)

I hereby certify that this correspondence is being deposited with the United States Patent and Trademark Office, Trademark Trial and Appeal Board via electronic filing through its website accessible through the following domain name: <http://esta.uspto.gov> on January 18, 2011.

Kimberly J. Cooper, Esq.

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

Cannery Casino Resorts, LLC,

Opposer,

vs.

Omri S. Shellef,

Applicant.

Marks:

EAST SIDE SOCIAL CLUB,
Serial No. 77767677

Opposition No.: 91194772

**OPPOSER'S RESPONSE TO APPLICANT'S REQUEST
TO EXPEDITE TRADEMARK REGISTRATION**

Pursuant to 37 C.F.R. § 2.127 and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 502.02, Opposer Cannery Casino Resorts, LLC ("CCR"), by and through its undersigned counsel of record, hereby responds to Applicant's Request to Expedite Trademark Registration ("Request to Expedite") and respectfully requests the Trademark Trial and Appeal Board (the "Board") deny or, in the alternative, decline to consider Applicant's Request to Expedite. Opposer's Response to Applicant's Request to Expedite Trademark Registration ("Response to Request") is based upon the records and pleadings on file herein and the memorandum of points and authorities set for below.

I. MEMORANDUM OF POINTS AND AUTHORITIES

A. Introduction

Applicant Omri S. Shellef ("Applicant") is a pro se applicant who misconstrues and misapplies the rules governing this proceeding, despite efforts by CCR and the Board to inform

Applicant of the rules and their applications. For example, in the Request to Expedite Applicant complains of delay by CCR when in fact Applicant has continually missed procedural deadlines - deadlines that CCR has (as a professional courtesy) either informed Applicant of prior to their expiration or subsequent to their expiration contacted Applicant and allowed Applicant to respond even though such response was untimely. Furthermore, the Board has informed Applicant via its Order Setting Trial Dates dated May 5, 2010 (the "Scheduling Order") of the rules and deadlines applicable to this proceeding. Nonetheless, Applicant has remained stalwart in his refusal to abide by the rules.

Applicant's purposeful ignorance of the rules has led Applicant to prepare and file a document that is unclear as to purpose, is improper in form and substance and has no applicability to this proceeding. It is unclear exactly what relief Applicant is seeking from the Board because his Request to Expedite, at a minimum, does not contain a full statement of the grounds for seeking an order from the Board pursuant to 37 C.F.R. § 2.127 and Fed. R. Civ. P. 7(b). As a result, CCR and the Board are only left to speculate as to the grounds for Applicant's Request to Expedite. Without a clear statement of the grounds for Applicant's request, CCR is greatly prejudiced because it has no true and effective means to respond. More to the point, however, is that without a clear statement of the grounds, the Board has no basis upon which to grant relief. Therefore, the Board should deny Applicant's Request to Expedite.

B. Procedural Overview

Applicant filed an application for registration of the mark EAST SIDE SOCIAL CLUB in International Classes 41 and 43 (the "Infringing Mark"). CCR is the owner of various federally registered trademarks and service marks incorporating the text "EASTSIDE", including registrations in International Classes 41 and 43. Believing it would be damaged by registration

of the Infringing Mark, CCR filed an opposition. Shortly after Applicant served his Answer on CCR, CCR began good faith settlement negotiations with Applicant that ultimately resulted in CCR sending Applicant a draft agreement.

On or about December 21, 2010, CCR proposed the parties consent to extend the discovery period in light of the upcoming holiday season and the fact that the discovery period would end shortly thereafter. Six days later, Applicant sent CCR an email rejecting CCR's request for consent to extend the discovery period and filed his Request to Expedite. Up until Applicant filed his Request to Expedite, CCR believed that Applicant was still considering the draft agreement and was continuing to negotiate in good faith.

Upon notice of Applicant's refusal to consent to an extension of the discovery period, CCR prepared and filed its Motion for Extension of Case Management Deadlines on December 30, 2010. Further, upon receipt of Applicant's Request to Expedite, CCR propounded written discovery on Applicant on December 28, 2010. CCR also scheduled and conducted the deposition of Applicant in New York City, New York on January 10, 2011. On January 7, 2011, Applicant also propounded written discovery on CCR (which was in essence the same written discovery propounded by CCR on Applicant with the names of the parties reversed). Applicant has not conducted any other discovery in this matter.

C. Argument

CCR is mindful that Applicant is a pro se party in this opposition proceeding and presumably he is inexperienced in the rules governing this proceeding. Consequently, CCR has repeatedly gone out of its way to work with Applicant in identifying Applicant's obligations under the rules. For example, CCR has contacted Applicant numerous times regarding pending or missed deadlines. Moreover, when it became clear to CCR that Applicant did not understand his obligations under Fed. R. Civ. P. 26(a)(1)(A), CCR sent an email to Applicant enumerating

the four types of information Applicant is required to disclose under the rule. Furthermore, the Board has informed Applicant via its Scheduling Order of the rules applicable to this proceeding and provided Applicant access to the rules via a hyperlink within the Scheduling Order. Thus, Applicant is not only aware of the rules governing this proceeding but Applicant has access to such rules. Yet, despite his awareness of and access to the rules, Applicant continues to be recalcitrant in following the rules, and it appears he is simply making it up as he goes along. Applicant's pro se status does not excuse him from failing to comply with the rules of this proceeding. *See McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, FN2 (TTAB 2006), *aff'd*, (Fed. Cir., No. 07-1101, July 11, 2007) ("Strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel"). Applicant's Request to Expedite is a prime example of his shoot-from-the-hip approach to this proceeding.

1. Applicant Has Failed to State Any Grounds Upon Which He Bases the Request to Expedite.

Applicant has failed to state any grounds upon which he bases his Request to Expedite. A request for an order must be made by motion and the motion must state the grounds for seeking an order. Fed. R. Civ. P. 7(b) and 37 C.F.R. § 2.127.

37 C.F.R. § 2.127 states in pertinent part that "[a motion] shall contain a full statement of the grounds, and shall embody or be accompanied by a brief." 37 C.F.R. § 2.127. The Request to Expedite is not simply deficient in its statement of the grounds for seeking an order from the Board, it is completely void of any statement of the grounds for seeking an order. As a result, both CCR and the Board are left to speculate as to the grounds for Applicant's Request to Expedite. Without a clear statement of the grounds for Applicant's request, CCR is greatly

prejudiced because it has no true and effective means to respond. More to the point, however, is that without a clear statement of the grounds, the Board has no basis upon which to grant relief.

For example, it is unclear if Applicant is treating his request as a motion for failure to state a claim under which relief can be granted under Fed. R. Civ. P. 12(b)(6), or a motion for judgment on the pleadings under Fed. R. Civ. P. 12(c), or a motion for failure to prosecute under Fed. R. Civ. P. 41(b), or a motion for summary judgment under Fed. R. Civ. P. 56 and 37 C.F.R. § 2.127(e), or some other procedural grounds upon which Applicant may be entitled to dispositive relief. Applicant has entirely failed to set forth any legal arguments, evidentiary grounds or procedural grounds for relief or set forth any other valid theory for dispositive relief to satisfy his burdens under any of the rules cited above. Nor has Applicant made any effort to specify which of those rules, if any, he is relying upon. Such failures are fatal and the Board should deny Applicant's Request to Expedite.

2. Applicant's Request to Expedite is Inapposite.

The Request to Expedite is inapposite. To the extent Applicant is asking the Board to expedite the registration of his mark application, such a request is not applicable to this proceeding. Generally, registration is a function of the ex-parte application process handled by the examining unit of the United States Patent and Trademark Office. The instant matter is an inter parties opposition proceeding before the Board which is akin to a civil action in Federal district court, and which in effect removes jurisdiction from the examining attorney over applicant's mark application and suspends the application process. *See* TBMP § 102.03 and 15 U.S.C. §1063(a). To the extent Applicant is asking the Board to register the mark in his application, such a request is not applicable to this proceeding because the entire purpose of the proceeding is to determine whether Applicant's mark is in fact registerable. To simply expedite

the registration of Applicant's mark without adjudicating the issues presented in CCR's opposition would contravene the purpose and nature of this proceeding. Consequently, a request to expedite registration is inapposite and the Board should not consider Applicant's Request to Expedite.

3. To the Extent the Board is Inclined to Treat the Request to Expedite as a Proper Motion, CCR Requests the Board Identify the Type of Motion Being Made and Grant CCR Additional Time to Respond.

To the extent the Board is inclined to treat Applicant's Request to Expedite as a properly formed and filed motion, CCR respectfully requests that the Board or Applicant identify what type of motion it believes Applicant is making and provide CCR with adequate time to respond. Without such notice and time to respond, CCR will be greatly prejudiced because it will be forced to spend a considerable amount of time and money formulating a response that addresses every conceivable ground for Applicant's request for fear that the one ground CCR fails to address is the one that Applicant is pressing and the Board may base its relief upon. Moreover, if CCR is forced to address every conceivable ground for which Applicant may seek relief, CCR will in effect be placed in the absurd position of doing Applicant's job for him. Thus, should the Board be inclined to consider Applicant's Request to Expedite as a proper motion, equity dictates that CCR be given notice and an adequate time to respond to the designated basis for the Request to Expedite.

///

///

///

///

///

D. Conclusion

For the foregoing reasons, CCR respectfully requests that the Board deny or, in the alternative, decline to consider Applicant's Request to Expedite.

SANTORO, DRIGGS, WALCH, KEARNEY,
HOLLEY & THOMPSON

Dated: January 18, 2011



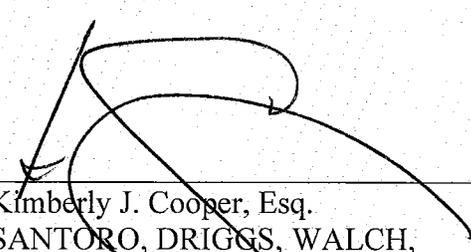
Kimberly J. Cooper, Esq.
400 South Fourth Street, 3d Floor
Las Vegas, NV 89101
(702)791-0308

Attorney for Opposer,
Cannery Casino Resorts, LLC

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing Opposer's Response to Applicant's Request to Expedite Trademark Registration was served via First Class Mail, postage prepaid, on this 18th day of January, 2011, upon:

Mr. Omri S. Shellef
135 Station Rd
Great Neck, NY 11023-1721
Email: tkomri@soulpushernyc.com



Kimberly J. Cooper, Esq.
SANTORO, DRIGGS, WALCH,
KEARNEY, HOLLEY & THOMPSON
400 South Fourth Street, Third Floor
Las Vegas, Nevada 89101
Telephone: (702) 791-0308