

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

EJW

Mailed: February 11, 2014

Opposition No. 91195328

Hard Candy Cases, LLC

v.

Hard Candy, LLC

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On February 11, 2014,¹ the Board, by the assigned Interlocutory Attorney (Elizabeth Winter), conducted a brief telephone conference with the parties (represented by Stuart West for opposer and Gabriel Grossman for applicant) regarding opposer's emailed request² to suspend the proceedings so that the testimonial deposition of applicant's witness, Jerome Falic, could be postponed and rescheduled. See Trademark Rule 2.120(i)(1); and TBMP § 502.06(a) (3d ed. rev.2 2013). This order summarizes the conference and the Board's order in connection with opposer's motion.

¹ On the same date in the previously consolidated proceeding, the Board entered judgment against applicant in Opp. No. 91195327 only, sustained that opposition, and refused registration based on applicant's withdrawal of application Serial No. 77700559.

² See attached.

In accordance with the Board's order mailed December 9, 2013, applicant's trial period closes on February 22, 2014 (see also Board order mailed February 5, 2014). Opposer requested that the Board suspend this proceeding to give opposer additional time to prepare for the testimonial deposition which is scheduled for the next day, February 12, 2014, and as grounds therefor argues that applicant had just abandoned one of the two opposed applications and that opposer would be prejudiced with respect to the deposition insofar as its strategy would change. Applicant opposed opposer's request, stating that opposer had sufficient notice of applicant's intent to abandon application Serial No. 77700559, that there would be great difficulty in rearranging the deposition given the busy schedule of the deponent, and that the proceedings were pending already for almost four years.

During the conference, the Board noted that applicant had notified opposer in early January, 2014, of its intent to withdraw the application; that in opposer's opposition to applicant's motion to withdraw without prejudice, opposer requested that the Board find that application Serial No. 77700559 is withdrawn with prejudice (response at 2); and that on February 5, 2014, one week before the deposition, the Board allowed applicant to withdraw its application without the designation "without prejudice." Thus,

applicant's second withdrawal of the referenced application without opposer's consent (filed on February 10, 2014) could have been submitted at any time since February 5th. In view of the foregoing, because opposer never consented to the withdrawal of the application, the Board determined that opposer has been on notice that judgment may be entered against applicant with respect to the involved application since last week, if not since January, 2014. Additionally, other than opposer's general statement concerning its strategy as regards the deposition, opposer did not elaborate further as to how it would be prejudiced with respect to the deposition now that application Serial No. 77700559 was no longer involved in the proceeding.

In view of the foregoing, and noting the delay to the proceeding that would likely be caused if the deposition were to be rescheduled and finding insufficient prejudice to opposer, the Board denied opposer's motion to suspend and to reschedule the testimony deposition of Mr. Falic.

Trial dates remain as set in the Board's order dated December 9, 2013.

☼☼☼

Opposition No. 91195328

The screenshot shows an email client window with a toolbar at the top containing various actions like Ignore, Reply, Forward, Meeting, Office Maintenance, To Manager, Rules, OneNote, Mark Unread, Categorize, Follow Up, Translate, Related, and Zoom. Below the toolbar, the email header indicates it was sent on Monday, 2/10/2014 at 3:43 PM. The sender is Stuart J. West, and the recipient is Ms. Winter. The subject is 'Request for Emergency Suspension Pending Motion Disposition: Opposition No. 91195327'. The body of the email contains the following text:

Ms. Winter:

After you order last Wednesday (February 5, 2014), Mr. Groisman again requested (approximately, 30 minutes ago) that we consent to a motion to withdraw and we refused to provide consent. A few moments ago, Mr. Groisman filed a motion (without consent) to withdraw one of the two trademark applications at issue.

This motion is brought less than 48 hours prior to a scheduled deposition (scheduled for 10 am PST on February 12, 2014). The filing of this motion immediately prior to the deposition material prejudices our client in its preparation for the deposition and has been brought at such a late hour to have such prejudicial impact. Following the Board's ruling last week, Mr. Groisman has adequate time to prepare and file any motion, but intentionally delayed the initiation of this present motion until less than 48 hours prior to his scheduled deposition, in order to have the most significant impact on Opposer's deposition preparation.

Opposer is entitled to time to adequately prepare a response to the present motion which will include, inter alia, a request for judgment against Applicant and therefore requests that the Board immediately suspend the present case pending the disposition of the matter. Regardless of the Board's ruling, Opposer will require time to prepare an adequate response to the motion and properly prepare for the deposition of Mr. Falic.

Best regards,

Stuart J. West, P.E.
West & Associates, A PC
2815 Mitchell Drive, Suite 209
Walnut Creek, CA 94598
Tel: 925.262.2220
Fax: 925.262.2205

STUART J. WEST, P.E. S.WEST@WESTPATENTLAW.COM
MANAGING ATTORNEY WWW.WESTPATENTLAW.COM