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

Proceeding	91204124
Party	Plaintiff Threshold Enterprises, Ltd.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of U.S. Application Serial No. 85/396136
For: PLANT HERBAL TREASURES

THRESHOLD ENTERPRISES LTD.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91204124
)	
ROBERT CAMPBELL (individual),)	
)	
Applicant.)	
)	

**OPPOSER’S REPLY IN SUPPORT OF ITS MOTION FOR AN EXTENSION OF TIME
IN WHICH TO RESPOND TO APPLICANT’S MOTION FOR SUMMARY JUDGMENT**

INTRODUCTION

In Applicant Robert Campbell's ("Applicant") Opposition (the "Opposition") to Opposer Threshold Enterprises, Ltd.'s ("Threshold") Motion for an Extension of Time in Which to Respond to Applicant's Motion for Summary Judgment (the "Motion"), he argues that Threshold has not demonstrated good cause to warrant a thirty-day extension of time in which to respond to his summary judgment motion. His arguments, however, are at varying times unpersuasive and disingenuous, and at times, both. Threshold has demonstrated good cause for its first request for an extension of time in which to file a responsive brief because (1) other litigation demands on Threshold's primary counsel, (2) Applicant only recently responded to some outstanding discovery requests germane to the summary judgment motion, (3) Threshold's primary counsel unexpectedly had to travel due to a family emergency, and (4) Threshold's primary counsel is traveling out of the country for 10 days over the Christmas holiday.

ARGUMENT

Applicant admits that "the board is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused" Opposition ("Opp.") at 3. Moreover, Applicant nowhere states that Threshold or its counsel is "guilty of negligence" or of "bad faith" or that it has "abused" the privilege of extensions. Nor can it; the exact opposite is true. Good cause exists here to grant Threshold's request for a thirty-day extension of time in which to respond to the Motion.

In fact, Applicant has cited no case denying a motion to extend by thirty days the time in which to respond to a motion for summary judgment. Nor has he cited a case denying any motion to extend on facts remotely similar to those presented here. Indeed, Applicant wholly ignored the authority cited by Threshold in its Motion and, in the only two cases cited by

Applicant relating to motions to extend time, the Board denied motions to extend a discovery period on facts easily distinguishable from the present case. In *National Football League v. DNG Management LLC*, 85 U.S.P.Q.2d 1852, 1854 (TTAB 2008) (cited at Opp. 3), the Board denied a motion to extend a discovery period by 90 days because the movant did not serve initial discovery requests until two days after the scheduled closing date of the six-month discovery period¹ and did not attempt to depose its adversary during the discovery period. Similarly, in *Luemme, Inc. v. D.B. Plus Inc.*, 53 U.S.P.Q.2d 1758, 1760 (TTAB 1999) (cited at Opp. 3), the Board denied movant's *second* motion to extend the discovery period where the movant did not serve initial discovery requests until the last possible day of the discovery period, did not attempt to depose its adversary during the (already-extended) discovery period, and failed to provide detailed information explaining how purported travel plans prevented movant from conducting discovery over a six-month period. As opposed to the six-month timeframe of a discovery period, Threshold has 35 days to file its opposition, and Threshold filed its Motion for an extension 13 days before its deadline, not on the final day. Moreover, Threshold here is seeking its *first* extension of a thirty-five day period, and, unlike *National Football League* and *Luemme*, the relevant time period has been encumbered by other litigation demands, outstanding discovery requests, and counsel travel plans.

A. Press of Other Litigation

Applicant does not dispute that the press of other litigation demands may constitute good cause. Nor could it. See *Societa Per Azioni Chianti v. Spoletoducale*, 59 U.S.P.Q.2d 1383, 1384 (TTAB 2001) (“the press of other litigation may indeed constitute good cause for an extension of

¹ Because the scheduled closing day of discovery fell on a Saturday, service of the discovery requests two days later was, by rule, timely.

time, in appropriate circumstances”). Instead, Applicant argues that such reasoning is insufficient here because (1) Threshold sought a requested extension 23 days after Applicant filed its summary judgment motion, (2) Arnold & Porter “is a large well established law firm employing hundreds if not thousands of attorneys” compared to Applicant’s counsel, which is comprised of “approximately 10 U.S. attorneys,” and (3) Threshold has a pattern of delaying this proceeding. These arguments are unpersuasive.

First, rather than a disregard of Board deadlines (as Applicant argues), that Threshold’s counsel did not immediately seek an extension of time in which to respond to the summary judgment motion shows a faithful effort to try to comply with such deadlines. As detailed in counsel’s declaration, numerous other litigation demands were ongoing when Threshold’s 35 day period commenced, and other matters, including a death penalty appeal, had issues arise during that period that required counsel’s immediate attention. *See* Declaration of Jeremy M. McLaughlin In Support Of Opposer’s Motion For An Extension Of Time In Which To Respond To Applicant’s Motion For Summary Judgment (“McLaughlin Decl.”) ¶2. Threshold’s counsel delayed requesting an extension of time in the hopes that he could meet the original deadline, and made the request—nearly two weeks before the deadline—only when it became clear that he could not. Declaration of Jeremy M. McLaughlin In Support Of Opposer’s Reply In Support Of Its Motion For An Extension Of Time In Which To Respond To Applicant’s Motion For Summary Judgment (“McLaughlin Reply Decl.”) ¶2. Surely, in proceedings before the Board, counsel should not—as Applicant would have it—be penalized for not seeking an extension of time immediately but doing so only when it becomes clear that, due to other circumstances, such as other litigation demands and unexpected emergency travel, counsel will be unable to meet the deadline.

Applicant’s next argument—that, due to the size of the law firm representing Threshold, “other litigation demands” cannot constitute “good cause”—is also unpersuasive. If the relative size of a law firm determined whether other litigation demands could constitute good cause, a party before the Board would be unduly prejudiced if it happened to retain a large law firm to represent itself. That cannot be the standard. Rather, as case law makes clear, the relevant factor is whether counsel provides sufficient detail to explain that other litigation demands are preventing her or him from meeting the established deadline. *See Spoletoduale*, 59 U.S.P.Q.2d at 1384; *Land O’Lakes, Inc. v. A. Duda & Sons, Inc.*, 2004 WL 2047328, at *1 (TTAB Sept. 10, 2004). Moreover, and as explained in the Motion (Motion at 1) and counsel’s original declaration (McLaughlin Decl. ¶2), notwithstanding the number of attorneys employed by counsel’s law firm, counsel serves as Threshold’s *primary* counsel for trademark oppositions before the Board, and he cannot be expected to rely on other attorneys unfamiliar with particular proceedings to prepare in 35 days an opposition to a motion for summary judgment. McLaughlin Reply Decl. ¶3.

Finally, Applicant’s claim that Threshold “has a pattern of delaying this proceeding” is disingenuous, at best. Opp. at 5. In support of his bold statement, Applicant cites to five suspensions that have been filed in this proceeding. Opp. at 5 (citing Opp. Exhibits 6-10). Conspicuously absent from Applicant’s argument, however, is any mention that *each* of those suspensions were *with Applicant’s consent* so the parties could engage in settlement discussions. *See* Opp. Exhibits 6-10. Applicant cannot have it both ways: consent to suspensions to discuss settlement, but then use those suspensions to argue a 30 day extension to respond to a summary judgment motion is unwarranted.

B. Applicant's Responses To Outstanding Discovery Requests

As Applicant admits, Threshold's second set of discovery requests to Applicant relate to two prior trademark applications by Applicant. Opp. at 5. Applicant mistakenly argues, however, that these discovery requests have no bearing on his summary judgment motion and, therefore, cannot serve as a basis for granting the relief Threshold seeks here. This is simply untrue.

Applicant has moved for summary judgment on the ground that Applicant's mark is not confusingly similar to Threshold's marks. As Applicant admits, he has conceded two of the factors relevant in a likelihood of confusion analysis: Threshold's priority and the relatedness of the goods/trade channels. Opp. at 2. Applicant's summary judgment motion goes on to argue that, based on other factors relevant to a likelihood of confusion analysis—"dissimilarities of the marks themselves, sophistication of consumers, weight of disclaimed portions of the at issue marks, lack of actual confusion, and the number of nature of similar marks in use on similar goods or services" (Opp. at 2)—he is entitled to summary judgment.

But the factors Applicant identifies are not the only factors relevant to a likelihood of confusion analysis, and Threshold is entitled to oppose Applicant's summary judgment motion by showing that disputed issues of material fact exist on any issue(s) relevant to a likelihood of confusion analysis, thereby preventing the entry of summary judgment. For example, Applicant's "intention to confuse the public" is a factor to consider in a likelihood of confusion analysis. McCarthy on Trademarks §23:108 (4th ed. 2013). Moreover, also relevant to the intent element is that an applicant adopted a mark with full knowledge of plaintiff's mark and/or that an applicant tried to adopt a mark as close as possible to that of plaintiff. *See id.* §§23:115, 116. Here, Applicant abandoned or ceased using two marks after Threshold engaged with

Applicant, and his decision--with full knowledge of Threshold's marks-- to then chose a third mark that, in Threshold's view, is likely to cause confusion is relevant to his intent to deceive the public. However, because Applicant provided only partial responses relevant to the issue of intent on December 18, 2013 (two days *after* Threshold initially requested an extension), Threshold needs additional time to fully investigate this factor to prepare an adequate opposition.

C. Counsel's Unavailability Due To Travel

Applicant argues that counsel's travel—once due to an unexpected family medical emergency and once due to pre-planned vacation plans—is an insufficient reason to find good cause for the extension because counsel either had knowledge of the travel plans when Applicant filed his summary judgment motion or learned of the travel necessity shortly thereafter. This argument is unpersuasive.

First, as to counsel's pre-planned Christmas travel plans, as described above, counsel should not be penalized for attempting to meet Board-established deadlines and requesting an extension only when it becomes clear that she or he cannot do so. Of course, counsel was aware he would be out of the country from December 24, 2013 to January 4, 2014. That in and of itself may not have prevented counsel from preparing an adequate response to the summary judgment motion, however, and so counsel saw no reason to request an immediate extension of time once the summary judgment motion was filed. Rather, as other developments occurred, including an unforeseen family medical emergency and growing litigation demands, counsel only then determined an extension was necessary and thus made the request.

Second, Threshold counsel's learned of a family medical emergency on December 7, 2013—10 days after Applicant emailed his summary judgment motion, not "shortly after" receipt. Opp. at 6. Threshold's counsel was in Pittsburgh with his family from December 11,

2013 until December 15, 2013. McLaughlin Reply Decl. ¶4.² Upon counsel’s return, it became clear that, due to the unforeseen travel, the planned Christmas travel, and the growth and backlog of other litigation demands, he could not prepare an adequate summary judgment opposition within the original timeframe. Accordingly, he requested an extension *the next day*, and Applicant refused the request two days later.³

D. Applicant’s Claim Of Prejudice Is Belied By His Behavior

In a last-ditch effort to oppose Threshold’s request, Applicant contends that the requested extension serves only to prejudice and harass him. Opp. 7-8. This argument is puzzling for several reasons.

First, as discussed above, the prior suspensions in this proceeding were consensual. *See* Opp. Exhibits 6-10. If, as Applicant contends, those prior suspensions “have prejudiced [him] to the extent that Applicant is not able to fully invest in his mark, products, and implement a marketing strategy” (Opp. 7), it is entirely unclear why Applicant would consent to the suspensions. But he did consent, and he consented to suspensions totaling 240 days, so it is hard to ascertain how Threshold’s request for only 30 more days suddenly amounts to prejudice.

Second, to the extent Applicant argues this extension request seeks only to harass him by bolstering his legal fees, his argument is undermined by his refusal to consent to Threshold’s initial two-week extension request and thus avoid this motion practice. Threshold filed the

² Threshold’s counsel stated *in a sworn declaration* about his need to travel due to an unforeseen medical emergency involving his father. McLaughlin Decl. ¶3. Accordingly, Applicant’s implication that counsel’s family emergency is “supposed” is unwarranted and unprofessional. Opp. at 6.

³ Applicant several times references that Threshold’s counsel did not apprise Applicant of the press of other litigation matters or of an unforeseen family emergency. Opp. at 4, 6, 7. This is merely a distraction, because Applicant nowhere states that such factors would have altered his decision not to agree to Threshold’s requested extension. Indeed, Applicant cannot make such a claim; if such factors would have altered his decision, he would not have filed the immediate Opposition.

Motion only because Applicant refused to consent to an extension unless Threshold forfeited its right to argue that Applicant has waived his right to object to the merits to certain discovery responses. Motion at 5 n.2.⁴

Finally, there are no grounds for Applicant to argue that Threshold has harassed Applicant since 2011. Opp. at 7-8. While true that Threshold has engaged with Applicant since at least 2011 with respect to various infringing marks in use by Applicant, Applicant's decision to cease use of those marks as a result of those discussions at least arguably demonstrates that Threshold had some basis on which to request Applicant's discontinuation of the marks, not that Threshold has harassed him.

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⁴ Moreover, Applicant's harassment argument is rather audacious given that Applicant provided Threshold with a motion for summary judgment the day before Thanksgiving and with his Opposition to the immediate Motion two days before Christmas, especially given that Applicant's counsel was aware Threshold's counsel was leaving the country the next day. Indeed, as a result of such tactics, Threshold's counsel prepared this reply while traveling for the Christmas holiday. McLaughlin Reply Decl. ¶5.

CONCLUSION

Because good cause exists, the Board should grant Threshold's request for a 30-day extension of time—until February 3, 2014—in which to respond to Applicant's Motion.

December 26, 2013

Respectfully submitted,
THRESHOLD ENTERPRISES, LTD.

By: /s/ _____

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

In the Matter of U.S. Application Serial No. 85/396136
For: PLANT HERBAL TREASURES

THRESHOLD ENTERPRISES LTD.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91204124
)	
ROBERT CAMPBELL (individual),)	
)	
Applicant.)	
)	

**DECLARATION OF JEREMY M. MCLAUGHLIN IN SUPPORT OF OPPOSER'S
REPLY IN SUPPORT OF ITS MOTION FOR AN EXTENSION OF TIME IN WHICH
TO RESPOND TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT**

I, Jeremy M. McLaughlin, declare as follows:

1. I am admitted to practice law in the State of California, and am an attorney with the law firm of Arnold & Porter LLP, counsel to Opposer Threshold Enterprises, Ltd. (“Threshold”) in the above-captioned proceedings. I offer this declaration in support of Threshold’s Reply In Support Of Its Motion For An Extension Of Time In Which To Respond To Applicant’s Motion For Summary Judgment. This declaration is based upon my own personal knowledge, and I could and would testify competently to the truth of the matters stated herein if called upon to do so.

2. Applicant Robert Campbell’s (“Applicant”) counsel emailed me a copy of Applicant’s summary judgment motion on November 27, 2013. I did not seek an extension of time in which to respond at that time, because I believed I had adequate time in which to respond, notwithstanding pre-planned Christmas travel plans and other litigation demands. However, after I had to travel unexpectedly for a family medical emergency and issues arose in other litigation matters that required immediate attention, including issue briefing in a death penalty appeal, I realized that I could not prepare an adequate response in the original timeframe.

3. I serve as the primary counsel for Threshold’s trademark oppositions, and no other attorney in my firm does regular work on those matters. At the time Applicant filed his motion, I was representing Threshold in over 30 Board proceedings and/or settlement negotiations.

4. I traveled to Pittsburgh, Pennsylvania on December 11, 2013 for a family medical emergency, and I did not return to San Francisco until December 15, 2013.

5. Given that Applicant served its opposition three days after Threshold filed its motion for an extension of time, which was two days before Christmas and one day before my pre-planned Christmas travel, I prepared this reply while traveling over the Christmas holiday so

as to ensure that the motion for an extension of time was fully briefed should the Board consider it prior to my scheduled return on January 4, 2014.

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge. This declaration was executed on this 26th day of December 2013, at Puebla, Mexico.

/s/ _____

Jeremy M. McLaughlin