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

Proceeding	91206026
Party	Defendant Shurjoint Piping Products, Inc.
Correspondence Address	MARK H TIDMAN BAKER HOSTETLER LLP 1050 CONNECTICUT AVE NW, SUITE 1100 WASHINGTON, DC 20036 5300 UNITED STATES trademarks@bakerlaw.com
Submission	Response to Board Order/Inquiry
Filer's Name	Mark Tidman
Filer's e-mail	trademarks@bakerlaw.com
Signature	/Mark Tidman/
Date	03/04/2013
Attachments	Response to Order.pdf (4 pages)(677465 bytes)

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

Victaulic Company of America, Opposer, v. Shurjoint Piping Products, Inc. Applicant.	Opposition No.: 91206026 Serial No.: 85/502,864

Docket No. 091832.000200

RESPONSE TO ORDER AND MOTION FOR THIRTY DAYS FOR APPLICANT TO RESPOND TO DISCOVERY

In response to the Board's Order of March 1, 2013, undersigned counsel is not available for a call on Tuesday, March 5. Undersigned is available on Wednesday, March 6, 2013 between 2:00 pm and 4:00 pm.

In addition, it is undersigned counsel's understanding that the topic of conversation will be the ex parte inquiry by counsel for Victaulic, Bryan Sugar, as to whether Applicant has been properly served discovery in view of the Board's Order of November 7, 2012.

First, Applicant objects to the repeated ex parte communications of Mr. Sugar with the Board. Mr. Sugar has made a habit of making such communications without notice to counsel for Applicant whenever there is a dispute between the parties, rather than using formal channels via a motion or seeking a conference with *both* counsel present. Applicant objects to those types of ex parte communications and requests that Mr. Sugar be ordered to refrain from engaging in them.

Turning to the discovery Mr. Sugar wants to be treated as properly served, following the most recent discussion, Mr. Sugar represented to the undersigned that the Interlocutory Attorney concurred with Mr. Sugar's view that discovery served during suspension of the proceeding pending consideration of a dispositive motion was effective. The Board's Order of November 7, 2012 unambiguously ordered that ***no activity*** take place with respect to discovery. In particular, the Board's Order stated that "***the parties are directed to defer <u>all activities</u> with respect to discovery during the pendency of the motion for judgment."*** Victaulic served discovery on January 3, 2013 during the pendency of the motion. This attempt at service of discovery ignored the prohibition of the Order, as there is nothing ambiguous about "all activities with respect to discovery." As such, Applicant considered the attempted service to be so clearly ineffective that undersigned counsel did not even recall that such a defective attempt to serve discovery had been made.

Regardless of whether the Board agrees with Mr. Sugar's interpretation that service of discovery is not part of "all activities with respect to discovery" which the Board directed the parties to defer, at the very least, the Order was ambiguous. In view of the language of the Order, Applicant has not turned its attention to the discovery in any manner, believing that it had not been served. Accordingly, regardless of the Board's (and Mr. Sugar's) interpretations of the Order, Applicant requests the benefit of the full thirty (30) days to respond so as not to be severely prejudiced. The above discussion and offer was made to Mr. Sugar previously but was unreasonably declined.

Presumably, the Board will be able to hear this motion and Mr. Sugar's position on it during the call with the Interlocutory Attorney and rule on same.

Respectfully submitted,

Shurjoint Piping Products, Inc.

Date March 4, 2013

By: _____

Mark H. Tidman
Baker & Hostetler LLP
Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036-5300
(202) 861-1500 (Telephone)
(202) 861-1783 (Facsimile)
Attorney for Applicant

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing RESPONSE TO ORDER AND MOTION FOR THIRTY DAYS FOR APPLICANT TO RESPOND TO DISCOVERY was served by first-class mail, postage pre-paid on this 4th day of March, 2013 to Petitioner's counsel at the following address:

Bryan P. Sugar
Ungaretti & Harris
70 West Madison Street
3500 Three First National Plaza
Chicago, IL 60602-4224

By: _____
Mark H. Tidman

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