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

Proceeding	91207213
Party	Defendant Joseph A. Fay
Correspondence Address	JAMES L VANA PERKINS COIE LLP 1201 3RD AVE, SUITE 4900 SEATTLE, WA 98101 UNITED STATES JVana@perkinscoie.com, pctrademarks@perkinscoie.com
Submission	Other Motions/Papers
Filer's Name	James L. Vana
Filer's e-mail	pctrademarks@perkinscoie.com
Signature	/James L. Vana/
Date	10/01/2014
Attachments	Applicant's Response to Notice of Default.pdf(763944 bytes)

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

Chicago Cubs Baseball Club, LLC, Washington Nationals Baseball Club, LLC Opposers, v. Joseph A. Fay, Applicant.	Opposition No.: 91207213 **APPLICANT'S RESPONSE TO NOTICE OF DEFAULT**

This response addresses the Notice of Default issued by the Board on September 26, 2014 (the "Notice of Default"). As set forth below, Applicant believes it can demonstrate good cause why default judgment should not be entered against him pursuant to Fed. R. Civ. P. 55(b)(2). Applicant therefore respectfully requests that the Notice of Default be set aside and the opposition be reinstated according to the schedule set forth in the May 15, 2014 Motion for Suspension for Settlement With Consent (http://ttabvue.uspto.gov/ttabvue/v?pno=91207213&pty=OPP&eno=19), which was approved by the Board on May 19, 2014 (http://ttabvue.uspto.gov/ttabvue/v?pno=91207213&pty=OPP&eno=20).

Legal Standard

Where a notice of default is issued for failure of the applicant to timely file an answer to the Notice of Opposition, good cause why default judgment should not be entered is usually found when the defendant shows that (1) the delay in filing an answer was not the result of willful conduct or gross neglect on the part of the defendant, (2) the plaintiff will not be substantially prejudiced by the delay, and (3) the defendant has a meritorious defense to the action. *See, e.g.*, *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 U.S.P.Q.2d 1556, 1557 (TTAB 1991). Applicant can meet each noted element.

Analysis

1. The delay was not the result of Applicant's willful conduct or gross neglect. Applicant and Opposers have, for the last two years, been engaged in coexistence negotiations intended to resolve the instant opposition proceeding. The opposition has been suspended repeatedly, at the request of the parties, to facilitate those negotiations. The parties have exchanged drafts of a settlement agreement, and that agreement is currently with Opposers' counsel for review and comment. *See* the e-mail communication dated May 2, 2014 from Opposers' counsel to Applicant's counsel (attached as Exhibit 1 to the Declaration of James L. Vana, attached hereto as Exhibit A (the "Vana Declaration")), noting that Opposer's counsel was reviewing the agreement and would advise Applicant's counsel once comments from Opposers were received. To date, Applicant's counsel has not received those comments. As a result, since at least May 2, 2014, the posture of this matter is that Applicant is waiting for input from Opposers regarding settlement negotiations.

The answer deadline was August 20, 2014. On that date, Applicant's counsel was away from the office, traveling on a planned sabbatical. Applicant's counsel's firm has a formal docketing system that identified the answer deadline. However, the docket report (relevant portion attached as Exhibit 2 to the Vana Declaration) showed two entries for this matter - one titled "Answer Due" and the other titled "Suspension Expires." The assigned paralegal and other administrative staff reviewing the docket focused on the "Suspension Expires" docket entry and determined, incorrectly, that the matter had no associated deadline to be met. As a result, no further action was taken to bring the deadline to the attention of another attorney. This set of circumstances demonstrates that the failure to timely file an answer resulted from neither willful conduct nor gross neglect. Instead, that failure occurred due to a combination of unique circumstances, and despite the efforts of Applicant's counsel and his firm to put in place procedures to avoid such a failure. *See id.* (failure of applicant's counsel to file previously prepared answer prior to vacation was clearly inadvertent and thus not the result of willful conduct or gross neglect); *Paolo's Associates Ltd. Partnership v. Bodo*, 21 U.S.P.Q.2d 1899, 1904 (TTAB

1990) (standard met based on the credible statement of registrant's counsel that "his docketing system failed him in this case").

2. Opposers will not be substantially prejudiced by the delay. Applicant submits that the six-week delay in filing an answer in this opposition does not prejudice Opposers. As noted above and as demonstrated by a review of the docket for this proceeding, action in the opposition has repeatedly been suspended to allow the parties to negotiate a coexistence agreement, and the current status is that Opposers have committed to providing comments regarding that agreement. The parties' confirmed expectation is that they will focus on coexistence negotiations rather than the opposition proceeding. As a result, Opposers are not prejudiced by the delay in the filing of Applicant's answer to the Notice of Opposition.

3. Applicant has a meritorious defense. To meet this requirement, Applicant must only show that it has a plausible response to the allegations in the Notice of Opposition. The filing of an answer which is not frivolous demonstrates a meritorious defense. *See Fred Hayman Beverly Hills, supra*, 21 U.S.P.Q.2d at 1557. Attached as Exhibit B hereto is a copy of the answer to the Notice of Opposition (the "Answer"), being filed concurrently herewith. As the Answer is clearly not frivolous, Applicant has demonstrated that he has a meritorious defense.

Conclusion

Applicant respectfully submits that he has demonstrated good cause for his failure to timely file an answer to the Notice of Opposition. As a result, Applicant requests that the Board

set aside the Notice of Default and reinstate the case pursuant to the schedule set forth in the May 15, 2014 Motion for Suspension for Settlement With Consent (Docket Entry No. 19).

DATED: October 1, 2014

CERTIFICATE OF SERVICE	PERKINS COIE LLP
I hereby certify that this, **APPLICANT'S RESPONSE TO NOTICE OF DEFAULT**, is being deposited with the United States Postal Service with sufficient postage as first class mail on October 1, 2014 in an envelope addressed to Opposer's counsel: SETH SHAIFER COWAN LIEBOWITZ & LATMAN PC 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036. Signature: Linda L Martin Printed Name: Linda L. Martin	By _____ James L. Vana Perkins Coie LLP 1201 Third Avenue, Suite 4900 Seattle, Washington 98101-3099 (206) 359-3036 Attorney for Applicant

Exhibit A

to

Applicant's Response to Notice of Default

Declaration of James L. Vana, Counsel for Applicant

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

Chicago Cubs Baseball Club, LLC, Washington Nationals Baseball Club, LLC Opposers, v. Joseph A. Fay, Applicant.	Opposition No.: 91207213 **DECLARATION OF JAMES L. VANA IN SUPPORT OF APPLICANT'S RESPONSE TO NOTICE OF DEFAULT**

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares as follows:

1. I am counsel for the Applicant in this trademark opposition, and I have personal knowledge of the matters stated herein and am competent to testify thereto.

2. Attached hereto as Exhibit 1 is a true and complete copy of an e-mail communication dated May 2, 2014 from Don Obert, Opposers' counsel, to Applicant titled "THE BIG "W"; Opp. No. 91207213 - FOR SETTLEMENT PURPOSES ONLY - PURSUANT TO FRE 408.

3. Between August 16, 2014 and August 31, 2014, I was out of the office on a firm-approved sabbatical.

4. Attached hereto as Exhibit 2 is a true and complete copy of the relevant page from my docket report for the week of August 18, 2014.

All statements made of my own knowledge are true and statements made on information and belief are believed to be true.

DATED: October 1, 2014

	PERKINS COIE LLP By _____ James L. Vana Perkins Coie LLP 1201 Third Avenue, Suite 4900 Seattle, Washington 98101-3099 (206) 359-3036 Attorney for Applicant

Exhibit 1

to

Declaration of James L. Vana in Support of Applicant's Response to Notice of Default

Copy of May 2, 2014 E-Mail From Opposers' Counsel

Vana, James L. (Perkins Coie)

From: Obert, Don M. <DMO@cll.com>
Sent: Friday, May 02, 2014 9:31 AM
To: Vana, James L. (Perkins Coie)
Cc: Kevlin, Mary; Natale, Kristine M.
Subject: THE BIG "W"; Opp. No. 91207213 - FOR SETTLEMENT PURPOSES ONLY - PURSUANT TO FRE 408

Jim:

I am writing as a follow up to your telephone discussion with Mary this past Monday, April 28th, and am confirming that we will be filing a motion on consent with the Board today to suspend this proceeding for 90 days, so as to allow sufficient time for our client to review the recently revised agreement. We will advise you as soon as we receive our client's comments. Have a good weekend.

Don M. Obert, Esq.
Cowan, Liebowitz & Latman, P.C.
1133 Avenue of the Americas
New York, New York 10036-6799
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For more information please visit http://www.mimecast.com[mimecast.com]

Exhibit 2

to

Declaration of James L. Vana in Support of Applicant's Response to Notice of Default

Excerpt From Vana Docket Report For Week of August 18, 2014

Urgent Consolidated Docket For James Vana

Report Criteria

Thru: 01-Sep-2014

DUE	ACTION *Notes*	EXTENSIONS TAKEN	REMAIN	REFERENCE#	TITLE	CLIENT		REG/SERIAL#	RESPONSIBLE PARTIES
August 2014									
20 Wed	OTHER PARTY'S DEADLINE TO FILE OPPOSITIO	0	NONE	043668-4000.0027.CN001	DAN NA (DANNER in Chinese Characters)	Danner, Inc.	(CN)	9934082	JLV/REA/N/A/ AJE
20 Wed	Other Party's Deadline *Response to OA filed by Applicant?*	0	NONE	059439-4010.0000.WX001	HOOKD NATION (MuseAmi, Inc) (2d Citation) Potential Opposition	AirG Inc.		MuseAmi, Inc.	JLV/DLC/N/A/ AJE
20 Wed	Registration Received?	0	3 Ext/ 1 Mnths	072821-6000.0001.US001	Northside Daybreak Camo Print	Triple T Trading, Inc.		Triple T Trading, Inc.	JLV/JJ/N/A/ RBB
20 Wed	Answer Due	0	NONE	087298-7001.0000.PX001	THE BIG "W" (Chicago Cubs Baseball Club LLC and Washington Nationals Baseball Club, LLC) Opposition 91207213	Metropolitan Broadcasters LLP	()	Fay, Joseph A.	JLV/WCR/N/A/ BZ
20 Wed	Suspension Expires	0	NONE	087298-7001.0000.PX001	THE BIG "W" (Chicago Cubs Baseball Club LLC and Washington Nationals Baseball Club, LLC) Opposition 91207213	Metropolitan Broadcasters LLP		Fay, Joseph A.	JLV/WCR/N/A/ BZ
20 Wed	CONVENTION ENDS	0	NONE	089212-4000.0017.US001	INGENUITY HEALTH	AMERITOX, LTD.	(US)	86199620	JLV/DLC/N/A/ BZ
20 Wed	FOLLOW UP *Search reported to client?*	0	NONE	111553-4000.0001.SX001	LIVUU	Cosnova GmbH	(US)		JLV/DLC/N/A/ AJE
20 Wed	Follow up	0	NONE	112126-7003.0000.CX001	(Multicades.com, Jobber Instruments) Copyright Infringement	BANDAI NAMCO Games Inc		Multicades.com	JLV/JJ/N/A/ BZ
20 Wed	Follow up *Recommend filing US word mark, how infringed if only logo is registered?*	0	NONE	112597-7000.0000.CX01	Solutions for Int'l Bus., Inc. & Kevin Reilly (Partnership Agreement) Adv.	Matsuoka Kagu Seizo Co. Ltd.			JLV/N/A/N/A/ RFW
21 Thu	RENEWAL COMPLETE? *2/21/14 Agent confirmed renewal filed.*	0	1 Ext/ 6 Mnths	003071-4900.0085.T21398	BOEING	Boeing Intellectual Property Busines	(TW)	1088483	JLV/WBM/SFR/ AJE
21 Thu	RENEWAL	0	1 Ext/ 6 Mnths	043666-4000.0025.US002	RAINFAIR & HORSE Design	LaCrosse Footwear, Inc.	(US)	1291246	JLV/REA/N/A/ AJE

<u>Exhibit B</u>

to

Applicant's Response to Notice of Default

Answer to Notice of Opposition

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

Chicago Cubs Baseball Club, LLC, Washington Nationals Baseball Club, LLC Opposers, v. Joseph A. Fay, Applicant.	Opposition No.: 91207213 **APPLICANT'S ANSWER TO NOTICE OF OPPOSITION**

Applicant Joseph A. Fay ("Applicant"), owner of Application No. 85452733 for the mark THE BIG W ("Applicant's Mark"), by and through its undersigned counsel, hereby submits this answer to the Notice of Opposition as follows:

1. Applicant lacks knowledge or information sufficient to form a belief as to the allegations found in Paragraph 1, and therefore denies them.

2. Applicant lacks knowledge or information sufficient to form a belief as to the allegations found in Paragraph 2, and therefore denies them.

3. Applicant lacks knowledge or information sufficient to form a belief as to the allegations found in Paragraph 3, and therefore denies them.

4. Applicant lacks knowledge or information sufficient to form a belief as to the allegations found in Paragraph 4, and therefore denies them.

5. Applicant lacks knowledge or information sufficient to form a belief as to the allegations found in Paragraph 5, and therefore denies them.

6. Applicant lacks knowledge or information sufficient to form a belief as to the allegations found in Paragraph 6, and therefore denies them.

7. Applicant lacks knowledge or information sufficient to form a belief as to the allegations found in Paragraph 7, and therefore denies them.

8. Applicant lacks knowledge or information sufficient to form a belief as to the allegations found in Paragraph 8, and therefore denies them.

9. Applicant lacks knowledge or information sufficient to form a belief as to the allegations found in Paragraph 9, and therefore denies them.

10. Applicant lacks knowledge or information sufficient to form a belief as to the allegations found in Paragraph 10, and therefore denies them.

11. Applicant admits the allegations found in Paragraph 11.

12. Applicant admits the allegations found in Paragraph 12.

13. Applicant denies the allegations found in Paragraph 13.

14. The allegations found in Paragraph 14 assert a legal conclusion, and thus Applicant contends that no answer is required.

15. Applicant denies the allegations found in Paragraph 15.

WHEREFORE, Applicant respectfully requests that the Opposition be dismissed.

DATED: October 1, 2014

CERTIFICATE OF SERVICE I hereby certify that this, **ANSWER TO NOTICE OF OPPOSITION**, is being deposited with the United States Postal Service with sufficient postage as first class mail on October 1, 2014 in an envelope addressed to Opposer's counsel: SETH SHAIFER COWAN LIEBOWITZ & LATMAN PC 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036. Signature: Linda L Martin Printed Name: Linda L. Martin	**PERKINS COIE LLP** By _____ James L. Vana Perkins Coie LLP 1201 Third Avenue, Suite 4900 Seattle, Washington 98101-3099 (206) 359-3036 Attorney for Applicant