

ESTTA Tracking number: **ESTTA605883**

Filing date: **05/22/2014**

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

Proceeding	91210772
Party	Plaintiff Intercast Europe S.r.l.
Correspondence Address	RALPH H CATHCART LADAS PARRY LLP 1040 AVENUE OF THE AMERICAS NEW YORK, NY 10018 3738 UNITED STATES rcathcart@ladas.com,rroa@ladas.com,mmercado@ladas.com
Submission	Motion to Extend
Filer's Name	Ralph H. Cathcart
Filer's e-mail	rcathcart@ladas.com,rroa@ladas.com,mmercado@ladas.com
Signature	/Ralph H. Cathcart/
Date	05/22/2014
Attachments	Opposer's Motion to Extend Time to Determine Need for Expert Witness to Rebut Applicant's Expert Witness and Stay Discovery - THK Photo.pdf(269571 bytes) Declaration of Ralph H. Cathcart, Esq. (2) - THK Photo.pdf(619518 bytes)

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

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	:	
INTERCAST EUROPE S.r.l.,	:	
	:	
Opposer,	:	Opposition No. 91/210,772
	:	Serial No. 85/718,687
v.	:	
	:	
KENKO TOKINA USA, INC.,	:	
	:	
Applicant.	:	
	:	
-----	X	

**OPPOSER’S MOTION TO EXTEND TIME TO
DETERMINE NEED FOR EXPERT TO REBUT
APPLICANT’S EXPERT WITNESS AND STAY DISCOVERY**

I.

Pursuant to Rule 26(a)(2) of the Federal Rules of Civil Procedure and the May 5, 2014 order (the “Suspension Order”) of Christen M. English, Interlocutory Attorney at the Trademark Trial and Appeal Board, proceedings have been suspended so the parties could confer on arrangements for the completion of expert witness related disclosures and Opposer was ordered to disclose whether it intends to secure an expert witness to rebut Applicant’s expert witness on or before May 25, 2014.¹

Opposer is unable to determine whether it shall need an expert for rebuttal purposes on or before May 25, 2014 because Applicant has failed to provide an Expert Report as required by the Federal Rules of Civil Procedure § 26(a)(2) and TBMP Section §§ 401.03 and 408.01(b). Cathcart Declaration at ¶ 7. (“Cathcart Dec’1.”).

¹ The Suspension Order states that “applicant . . . is allowed until 20 days from the mailing date of this Order to disclose any planned rebuttal expert testimony.” Since only Applicant has given notice to date of its plan to use an expert witness, Opposer assumes this was a “typographical error” and the Suspension Order meant to reference Opposer.

In particular, the Expert Report must contain: 1) a complete statement of all opinions the witness will express and the basis and reason for them; 2) the facts or data or other information considered by the witness in forming them; 3) any exhibits that will be used to summarize or support them; 4) the witness's qualifications, including a list of all publications authored in the previous 10 years; 5) a list of all other cases in which, during the previous 4 years, the witness testified as an expert at trial or by deposition; and 6) a statement of the compensation to be paid for the study and testimony in the case.

Accordingly, Opposer must reserve its right to secure an expert witness for rebuttal purposes as it cannot meaningfully make such a determination at this time.

Opposer respectfully requests that the Board set a date certain by which Applicant must provide the expert witness report to Opposer and a date certain whereby Opposer must state whether it intends to secure an expert witness for rebuttal purposes.

II.

Applicant's Discovery Requests Must Be Stayed During The Suspension

On the same day the Suspension Order was issued, Applicant served by mail Applicant's First Set of Interrogatories, Document Requests and Requests for Admissions upon Opposer. Cathcart Dec'1. ¶ 3. These discovery requests were served on the last day of the currently set discovery period for which Opposer has timely moved to extend by 90 days.

The Suspension Order of the Board applies to all non-expert witness related arrangements, disclosures, *etc.* See *e.g.*, TBMP Section 401.03. ("Suspension is as to activities unrelated to the exchange of information about, and reports by, expected witnesses, and the parties should continue with the expert disclosure procedures specified in the Federal Rule pending issuance of any suspension order by the Board that will

specify any actions of the parties required by the Board.”)

Accordingly, Applicant’s discovery requests should be stayed or deemed a nullity until the Board lifts the suspension and the date to reply to such discovery requests should be reset accordingly.

For all of the above reasons, Opposer’s motion should be granted in all respects, and Applicant should be ordered to serve Opposer with its Expert’s Report and all discovery requests served by Applicant on May 5, 2014 should be stayed.

Respectfully submitted,

LADAS & PARRY LLP
Attorneys for Opposer

Dated: May 22, 2014

By: 
Ralph H. Cathcart
1040 Avenue of the Americas
New York, NY 10018
Tel: (212) 708-1920
(Our Ref: C13650025)

CERTIFICATE OF TRANSMISSION

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **OPPOSER'S MOTION TO EXTEND TIME TO DETERMINE NEED FOR EXPERT TO REBUT APPLICANT'S EXPERT WITNESS AND STAY DISCOVERY** is being electronically transmitted to the United States Patent and Trademark Office on the date indicated:

Dated: May 22, 2014


Reinaldo M. Roa

CERTIFICATE OF SERVICE

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **OPPOSER'S MOTION TO EXTEND TIME TO DETERMINE NEED FOR EXPERT TO REBUT APPLICANT'S EXPERT WITNESS AND STAY DISCOVERY** was served by first-class mail, postage prepaid, to the following persons:

Katherine M. Hoffman, Esq.
McKenna Long & Aldridge LLP
4435 Eastgate Mall, Suite 400
San Diego, CA 92121-1980

Tel: (619) 533-7392
E-mail: KHoffman@MckennaLong.com

Dated: May 22, 2014


Reinaldo M. Roa

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

-----X	:	
INTERCAST EUROPE S.r.l.,	:	
Opposer,	:	Opposition No. 91/210,772
v.	:	Serial No. 85/718,687
KENKO TOKINA USA, INC.,	:	
Applicant.	:	
-----X	:	

DECLARATION OF RALPH H. CATHCART, ESQ.

I, Ralph H. Cathcart, declare that the following is true and correct pursuant to 28 U.S.C. § 1746:

1. I am a partner at the law firm of Ladas & Parry LLP, attorneys for Opposer Intericast Europe S.r.l. and respectfully submit this declaration in support of Opposer’s Motion to Extend Time to Determine Need for Expert to Rebut Applicant’s Expert Witness and Stay Discovery.
2. On or about May 5, 2014, the Board issued an order (“Suspension Order”) suspending proceedings and ordering the parties to confer regarding arrangements relating to expert testimony related to Applicant’s notice of its intent to use an expert witness in these proceedings.
3. On the very same day, Applicant served Opposer, by First Class Mail, with Applicant’s First Set of Interrogatories, Applicant’s First Request for Production of Documents and Things and Applicant’s First Request for Admissions which were received by our office on May 12, 2014.

4. The Suspension Order specifically provided that applicant was allowed 20 days from the date thereof to determine whether it intended to use an expert witness for rebuttal purposes.

5. Upon information and belief, Opposer surmises that the Suspension Order meant to state that “Opposer” had until May 25, 2014 to make arrangements for a rebuttal expert witness, since only Applicant has filed or served notice of an intent to use an expert witness in this proceeding.

6. Having received no further word from Applicant’s counsel after the issuance of the Suspension Order, Opposer sent a letter to Applicant’s counsel on May 19, 2014 seeking to set up a conference call to comply with the Suspension Order and address Applicant’s objectionable discovery requests. *See Exhibit A.*

7. Opposer has yet to receive Applicant’s Expert Witness Report.

8. Upon sending a follow-up letter on May 20, 2014, the parties agreed to confer on May 22, 2014 concerning expert witnesses and arrangements therefor. *See Exhibit B (pages 2-3).*

9. On May 22, 2014, Applicant’s counsel stated that it had to “reschedule” our conference to another day. *See Exhibit B (page 1).*

10. In reply, Opposer requested Applicant’s consent to stay its discovery served on May 5, 2014 and to enlarge Opposer’s time to determine if it needed to secure an expert rebuttal witness, noting the likelihood that the parties could now reach a settlement. *See Exhibit B (page 1).*

11. At the time of submission of this motion, Applicant has consented to the motion concerning the extension of time for Opposer to determine if an expert rebuttal witness is

needed, but has not agreed to the portion of this motion directed to staying Applicant's May 5, 2014 discovery requests.

Executed on May 22, 2014 in New York, New York.



Ralph H. Cathcart

CERTIFICATE OF TRANSMISSION

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **DECLARATION OF RALPH H. CATHCART, ESQ.** is being electronically transmitted to the United States Patent and Trademark Office on the date indicated:

Dated: May 22, 2014



Reinaldo M. Roa

CERTIFICATE OF SERVICE

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **DECLARATION OF RALPH H. CATHCART, ESQ.** was served on the persons listed below by First-Class Mail, postage prepaid, on the date indicated below:

Katherine M. Hoffman, Esq.
James C. Danaher, Esq.
McKenna Long & Aldridge LLP
4435 Eastgate Mall, Suite 400
San Diego, CA 92121-1980

Tel: (619) 533-7392
E-mail: KHoffman@MckennaLong.com
E-mail: jdanaher@mckennalong.com

Dated: May 22, 2014



Reinaldo M. Roa

EXHIBIT A

LADAS & PARRY LLP
INTELLECTUAL PROPERTY LAW

Ralph H. Cathcart



rcathcart@ladas.com

212.708.1920

1040 Avenue of the Americas • New York, New York 10018-3738
P 212.708.1800 • F 212.246.8959 • F 212.246.8925 • nymail@ladas.com • www.ladas.com

May 19, 2014

For Settlement Purposes
Only – Without Prejudice

VIA E-MAIL

Katherine M. Hoffman, Esq.
James C. Danaher, Esq.
McKenna Long & Aldridge LLP
4435 Eastgate Mall, Suite 400
San Diego, CA 92121-1980

E-mail: KHoffman@MckennaLong.com
E-mail: jdanaher@mckennalong.com

Re: Intercast Europe S.r.l. v. Kenko Tokina USA, Inc. (formerly T H K Photo Products, Inc.) - Opposition No. 91/210,772 (Our Ref: C13650025)

Dear Ms. Hoffman and Mr. Danaher:

As you know, the Board recently issued an Order on May 5, 2014 suspending proceedings. *See* attached.

In the Order, the Board directs, *inter alia*, that the parties' counsel confer on the issue of expert witnesses, the introduction of such witnesses, stipulations, method of submission, *etc.*, and other expert witness obligations prior to resuming proceedings.

The Board also stated that "Applicant" is allowed "until 20 days from the mailing date of this Order", namely May 25, 2014, to disclose any planned rebuttal expert witness. We assume that the Board meant to say that Opposer had until such time to reply.

In any event, we propose a conference call tomorrow, May 20, 2014, either late morning (11:00 a.m. EDT) or any time in the afternoon other than 5:00 – 6:00 p.m. EDT (when I have another conference scheduled) so that we can timely comply with the Order. I am likewise available on May 21, and May 22nd.

In addition, we acknowledge receipt of your client's discovery requests served on the same day that the Board suspended proceedings. We assume, but please confirm, that your client will withdraw such discovery requests "without prejudice" until proceedings are resumed.

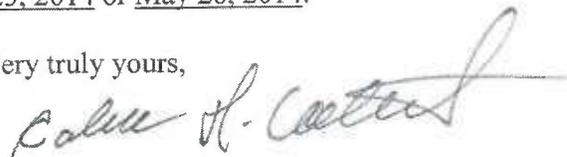
Katherine M. Hoffman, Esq.
James C. Danaher, Esq.
May 19, 2014

Page 2

Lastly, and perhaps most importantly, we would like to discuss the new possibility of an amicable resolution. As you know, our client was just recently acquired by another company and we have now had an opportunity to obtain instructions from our "new" client.

Kindly let us know when you will be available to speak, as time is of the essence and I will not be in the office on Friday, May 23, 2014 or May 26, 2014.

Very truly yours,



Ralph H. Cathcart

RHC/rmr
Enclosure

EXHIBIT B

Cathcart, Ralph

From: Cathcart, Ralph
Sent: Thursday, May 22, 2014 1:59 PM
To: 'Danaher, Jamie'; Roa, Reinaldo
Cc: Hoffman, Katherine
Subject: RE: Intercast Europe S.r.l. v. Kenko Tokina USA, Inc. (formerly T H K Photo Products, Inc.) - Opposition No. 91/210,772 (Our Ref: C13650025)

Dear Mr. Danaher:

We confirm receipt of your email a few minutes ago. As I indicated previously, I will not be in the office tomorrow or Monday May 26th.

Will you consent to a motion to stay the discovery you served on May 5th, the same day proceedings were suspended and an enlargement of the time for Opposer to determine whether to engage an expert rebuttal witness, given that we have not received your expert's report and the deadline to respond is May 25th.

We believe that with the recent acquisition of our client that the parties can readily reach an amicable resolution, but as you can appreciate, we must protect our client's interest in the meantime.

We look forward to your urgent response today,

Very truly yours,

Ralph H. Cathcart, Esq.
LADAS & PARRY LLP
1040 Avenue of the Americas
New York, New York 10018
Tel: 212-708-1920
Fax: 212-246-8959
Email: rcathcart@ladas.com
Web: www.ladas.com

From: Danaher, Jamie [mailto:JDanaher@mckennalong.com]
Sent: Thursday, May 22, 2014 1:40 PM
To: Roa, Reinaldo
Cc: Hoffman, Katherine; Cathcart, Ralph
Subject: RE: Intercast Europe S.r.l. v. Kenko Tokina USA, Inc. (formerly T H K Photo Products, Inc.) - Opposition No. 91/210,772 (Our Ref: C13650025)

Dear Mr. Roa,

I am sorry for the late notice, but we will need to reschedule today's call. Unfortunately, Ms. Hoffman is not available today and as lead counsel, she is needed on the call. Please let us know when your next available date, and we will try to make that work.

Thanks,
Jamie

Jamie Danaher | Associate
McKenna Long & Aldridge LLP

5/22/2014

4435 Eastgate Mall, Suite 400 | San Diego, CA 92121-1980
Tel: 619.699.2440 | Fax: 619.645.5349 | jdanaher@mckennalong.com

From: Roa, Reinaldo [<mailto:RRoa@ladas.com>]
Sent: Tuesday, May 20, 2014 3:40 PM
To: Danaher, Jamie
Cc: Hoffman, Katherine; Cathcart, Ralph
Subject: RE: Intercast Europe S.r.l. v. Kenko Tokina USA, Inc. (formerly T H K Photo Products, Inc.) - Opposition No. 91/210,772 (Our Ref: C13650025)

Dear Mr. Danaher:

Thank you for your email below.

We confirm that Mr. Cathcart is available to conference with you and Ms. Hoffman on Thursday, May 22, 2014 at 2:00 p.m. PDT (5:00 p.m. EDT).

Mr. Cathcart will call you at such time.

Very truly yours,
Reinaldo M. Roa
Litigation Support Manager
LADAS & PARRY LLP
1040 Avenue of the Americas
New York, NY 10018
Tel: 212-708-1926
Fax: 212-246-8959
E-mail: rroa@ladas.com
Web: www.ladas.com

From: Danaher, Jamie [<mailto:JDanaher@mckennalong.com>]
Sent: Tuesday, May 20, 2014 6:19 PM
To: Roa, Reinaldo; Hoffman, Katherine
Cc: Cathcart, Ralph
Subject: RE: Intercast Europe S.r.l. v. Kenko Tokina USA, Inc. (formerly T H K Photo Products, Inc.) - Opposition No. 91/210,772 (Our Ref: C13650025)

Reinaldo,

We would be available to speak with Mr. Cathcart on Thursday afternoon Pacific time.

Thanks,
Jamie

Jamie Danaher | Associate
McKenna Long & Aldridge LLP
4435 Eastgate Mall, Suite 400 | San Diego, CA 92121-1980
Tel: 619.699.2440 | Fax: 619.645.5349 | jdanaher@mckennalong.com

From: Roa, Reinaldo [<mailto:RRoa@ladas.com>]
Sent: Tuesday, May 20, 2014 2:13 PM

5/22/2014

To: Hoffman, Katherine; Danaher, Jamie
Cc: Cathcart, Ralph
Subject: FW: Intercast Europe S.r.l. v. Kenko Tokina USA, Inc. (formerly T H K Photo Products, Inc.) - Opposition No. 91/210,772 (Our Ref: C13650025)

Dear Ms. Hoffman and Mr. Danaher:

We are following up again to our letter of May 19, 2014. See attached.

Please confirm your availability. We have also sent you a copy of our May 19, 2014 letter by FEDEX.

Very truly yours,
Reinaldo M. Roa
Litigation Support Manager
LADAS & PARRY LLP
1040 Avenue of the Americas
New York, NY 10018
Tel: 212-708-1926
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From: Roa, Reinaldo
Sent: Monday, May 19, 2014 3:11 PM
To: Khoffman@mckennalong.com; jdanager@mckennalong.com
Cc: Cathcart, Ralph
Subject: Intercast Europe S.r.l. v. Kenko Tokina USA, Inc. (formerly T H K Photo Products, Inc.) - Opposition No. 91/210,772 (Our Ref: C13650025)

Dear Ms. Hoffman and Mr. Danaher:

Please see the attached letter and its attachment.

Very truly yours,
Reinaldo M. Roa
Litigation Support Manager
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5/22/2014