

ESTTA Tracking number: **ESTTA745430**

Filing date: **05/10/2016**

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

Proceeding	91215100
Party	Plaintiff Emilio Pucci International BV
Correspondence Address	JULIA ANNE MATHESON FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP 901 NEW YORK AVENUE NW WASHINGTON, DC 20001-4413 UNITED STATES docketing@finnegan.com, julia.matheson@finnegan.com, TTAB-Legal-Assistants@finnegan.com, morgan.smith@finnegan.com
Submission	Other Motions/Papers
Filer's Name	Julia Anne Matheson
Filer's e-mail	docketing@finnegan.com, julia.matheson@finnegan.com, morgan.smith@finnegan.com, TTAB-Legal-Assistants@finnegan.com
Signature	/Julia Anne Matheson/
Date	05/10/2016
Attachments	5-10-16 Declaration of Morgan E. Smith in Support of Opposers Motion for Sanctions.pdf(649780 bytes)

4. Attached as Exhibit 2 is a true and correct copy of a letter sent by Opposer's counsel Julia Anne Matheson to Applicant's counsel Darren Rimer on March 30, 2016 enclosing a revised settlement agreement and asking to hear from Applicant's counsel promptly.

5. Attached as Exhibit 3 is a true and correct copy of an email sent by Opposer's counsel Julia Anne Matheson to Applicant's counsel Darren Rimer on April 26, 2016 regarding the March 30th settlement agreement. In the email, Opposer's counsel reminded Applicant that she was in breach of the Board's Order to provide discovery responses, and indicated Opposer's unwillingness to tolerate further delays.

6. Attached as Exhibit 4 is a true and correct copy of an email sent by Applicant's counsel Darren Rimer to Opposer's counsel Julia Anne Matheson on April 30, 2016 requesting a 30 or 60-day extension, citing medical issues with one of Applicant's family members.

7. Attached as Exhibit 5 is a true and correct copy of an email sent by Opposer's counsel Julia Anne Matheson to Applicant's counsel Darren Rimer on May 2, 2016, informing him of Opposer's intent to proceed with a motion for sanctions.

I declare under penalty of perjury that the foregoing is true and correct pursuant to 28 U.S.C. § 1746.

Date: May 10, 2016



Morgan E. Smith

CERTIFICATE OF SERVICE

This will certify that a copy of the foregoing Declaration of Morgan E. Smith in Support of Opposer's Motion for Sanctions has been served upon counsel for Applicant via first class mail, postage prepaid, on May 10, 2016, at the following address of record:

DARREN S RIMER
RIMER & MATHEWSON LLP
30021 TOMAS, SUITE 300
RANCHO SANTA MARGARITA, CA 92688



Opposition No. 91215100
Declaration of Morgan E. Smith
in Support of Opposer's Motion for Sanctions

Exhibit 1

JULIA ANNE MATHESON
202.408.4020
julia.matheson@finnegan.com

February 19, 2016

FRE 408 – SETTLEMENT COMMUNICATION

Darren S. Rimer, Esq.
Rimer & Mathewson LLP
30021 Tomas, Suite 300
Rancho Santa Margarita, CA 92688
darren@rimermath.com

VIA EMAIL

Emilio Pucci Int'l BV v. Sachdev. Opposition No. 91215100

Dear Darren:

We write regarding the Trademark Trial and Appeal Board's recent ruling in this case. As you are undoubtedly aware, the Board granted Pucci's motion to strike Applicant's first through ninth affirmative defenses and denied Applicant's motion for a protective order. Order Den. Mot. for Protective Order, TTABVUE 18, Jan. 20, 2016. In its order, the Board granted Applicant fifteen days (i.e., until February 4, 2016) to show good cause as to why the Board should not sanction Applicant by finding that "(1) she has forfeited her right to object to Opposer's discovery requests on the merits, and (2) Opposer's requests for admission are deemed admitted pursuant to Fed. R. Civ. P. 36(a)(3)." *Id.* at 11. As Applicant did not file a response, we expect the Board to issue such sanctions in due course.

The Board also reset the case schedule and discovery is now set to close on March 13, 2016. Pucci intends to fully prosecute this opposition proceeding and will not agree to any further extensions. To date, Applicant has not responded to Pucci's discovery requests or produced any documents, even though Pucci's discovery requests have been pending for over *ten months*. See Order Suspending Proceedings Pending Disposition of Mot., TTABVUE 14, May 2, 2015 (suspension of proceedings did not toll time for either party to respond to any outstanding discovery). As Applicant has now waived any objections to Pucci's discovery requests on the merits, we expect to receive Applicant's full and complete responses to Pucci's First Set of Interrogatories and First Set of Requests for the Production of Documents and Things, along with all responsive documents, immediately. If Applicant refuses to do so and/or if you wish to discuss this matter, please let us know so we may schedule a meet-and-confer telephone conference as soon as possible.

Darren S. Rimer, Esq.
Page 2

Despite Applicant's dilatory conduct designed to frustrate the discovery process, Pucci is willing to consider an amicable resolution of this matter. To that end, we enclose a draft settlement agreement for your client's consideration. The sooner we receive confirmation of your client's intention to enter into the attached Settlement Agreement, the sooner we can move to temporarily suspend the opposition to allow the parties to conclude the dispute.

Given the upcoming deadlines, we look forward to your prompt response.

Sincerely,

A handwritten signature in black ink, appearing to read "Julia Anne Matheson". The signature is fluid and cursive, with a long horizontal flourish extending to the right.

Julia Anne Matheson

JAM/MES
cc: Emilio Pucci
Enclosure: Settlement Agreement

Opposition No. 91215100
Declaration of Morgan E. Smith
in Support of Opposer's Motion for Sanctions

Exhibit 2

JULIA ANNE MATHESON
202.408.4020
julia.matheson@finnegan.com

March 30, 2016

FRE 408 – SETTLEMENT COMMUNICATION

Darren S. Rimer, Esq.
Rimer & Mathewson LLP
30021 Tomas, Suite 300
Rancho Santa Margarita, CA 92688
darren@rimermath.com

VIA EMAIL

Emilio Pucci Int'l BV v. Sachdev, Opposition No. 91215100

Dear Darren:

Enclosed with this letter is a revised settlement agreement for your client's consideration. We have attached a clean copy and a redline detailing the changes. We have modified several terms, specifically:

REDACTED - SETTLEMENT COMMUNICATION

Darren S. Rimer, Esq.
Page 2

REDACTED - SETTLEMENT COMMUNICATION

We trust these revisions address your client's concerns and look forward to hearing from you promptly.

Sincerely,

A handwritten signature in black ink, appearing to read "Julia Anne Matheson". The signature is fluid and cursive, with a long horizontal flourish extending to the right.

Julia Anne Matheson

JAM/MES

cc: Emilio Pucci

Enclosure: Settlement Agreement Clean
Settlement Agreement Redline

Opposition No. 91215100
Declaration of Morgan E. Smith
in Support of Opposer's Motion for Sanctions

Exhibit 3

Valusek, Judy

From: Matheson, Julia Anne
Sent: Tuesday, April 26, 2016 5:48 PM
To: Darren S. Rimer
Cc: Smith, Morgan; Valusek, Judy
Subject: Emilio Pucci Int'l BV v. Sachdev: Opposition No. 91215100
Attachments: Pucci.pdf

Importance: High

FRE 408 – SETTLEMENT COMMUNICATION

Darren,

We write to follow up on our letter and proposed settlement agreement of March 30th, to which we have received no response.

We note that you are also in breach of the Board's February 23, 2016 order to provide "full and complete responses" to Pucci's interrogatories and document requests. See TTABVUE 19.

As mentioned previously, Pucci is prepared to prosecute this opposition proceeding through trial, but would prefer to reach a prompt and amicable settlement. It is not willing to tolerate further delays. Accordingly, please immediately advise whether and when we will receive your substantive response to the attached proposal. Unless we hear from you by the close of this week, we will be forced to file an additional motion with the Board.

Julia Anne Matheson

Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

901 New York Avenue, NW, Washington, DC 20001-4413

+1 202 408 4020 | fax +1 202 408 4400 | julia.matheson@finnegan.com | www.finnegan.com

FINNEGAN



From: Ball, Rose
Sent: Wednesday, March 30, 2016 3:32 PM
To: darren@rimermath.com
Cc: Matheson, Julia Anne; Smith, Morgan
Subject: Emilio Pucci Int'l BV v. Sachdev: Opposition No. 91215100

Please see the attached from Julia Anne Matheson, Esq.

Rose Ball

Assistant to Julia Anne Matheson, Esq
and Anna Balishina Naydonov, Esq.

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW, Washington, DC 20001-4413

☎ 202.216.5271 | 📠 202.408.4400 | ✉ rose.ball@finnegan.com

FINNEGAN

Opposition No. 91215100
Declaration of Morgan E. Smith
in Support of Opposer's Motion for Sanctions

Exhibit 4

Valusek, Judy

From: Darren S. Rimer <darren@rimermath.com>
Sent: Saturday, April 30, 2016 10:38 AM
To: Matheson, Julia Anne
Cc: Smith, Morgan; Valusek, Judy
Subject: RE: Emilio Pucci Int'l BV v. Sachdev: Opposition No. 91215100

Julia,

Thank you for your e-mail. I apologize for the delay, but I am unable to communicate with my client. Her last communication advised that she was traveling out of the country to help care for her mother, who was being hospitalized and was extremely sick. As such, my client is unavailable and we will need to try to preserve the status quo until her return.

I would propose filing a stipulated suspension for 30 or 60 days and hopefully we will have some news in that time. Please let me know, and I can file the suspension. Thank you.

Darren

Darren S. Rimer
Rimer & Mathewson LLP
30021 Tomas, Suite 300
Rancho Santa Margarita, CA 92688
(949) 367-1541 x 304
(949) 265-9010 (fax)
darren@rimermath.com
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From: Matheson, Julia Anne [<mailto:julia.matheson@finnegan.com>]
Sent: 04/26/2016 2:48 PM
To: Darren S. Rimer
Cc: Smith, Morgan; Valusek, Judy
Subject: Emilio Pucci Int'l BV v. Sachdev: Opposition No. 91215100
Importance: High

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Julia Anne Matheson

Partner

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Rose Ball

Assistant to Julia Anne Matheson, Esq.

and Anna Balishina Naydonov, Esq.

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Opposition No. 91215100
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Exhibit 5

Valusek, Judy

From: Matheson, Julia Anne
Sent: Monday, May 02, 2016 8:49 AM
To: Darren S. Rimer
Cc: Smith, Morgan; Valusek, Judy
Subject: RE: Emilio Pucci Int'l BV v. Sachdev: Opposition No. 91215100

Darren -- I'm afraid you did not apparently read our email. Pucci is not willing to tolerate further delays.

We will proceed accordingly.

Julia

Julia Anne Matheson

Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

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