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

Proceeding	92051006
Party	Defendant 12 Interactive, LLC
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Submission	Opposition/Response to Motion
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Signature	/Michael G. Kelber/
Date	06/21/2010
Attachments	response_to_motion_to_extend_-_PerkSpot.pdf (4 pages)(15774 bytes) Exhibit A.pdf (2 pages)(163934 bytes)

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

COUCH/BRAUNSDORF AFFINITY, INC.,	)	Cancellation No. 92051006	
	)		
Petitioner/Counter-Registrant,	)	Mark:	PERKSPOT
	)	Reg. No.	3,355,480
v.	)		
	)	Mark:	PERKS
12 INTERACTIVE, LLC,	)	Reg. Nos.	1,786,961 & 2,580,914
	)		
Registrant/Counter-Petitioner	)	Mark:	PERKS CARD
	)	Reg. Nos.	3,156,685 & 3,210,654

REGISTRANT'S OPPOSITION TO PETITIONER'S MOTION FOR AN EXTENSION OF DISCOVERY AND TRIAL DATES

Petitioner/Counter-Registrant, Couch/Braunsdorf Affinity Inc. ("Petitioner") has not, and cannot, demonstrate good cause for its requested extension. Rather, its requested extension is necessitated only by Petitioner's own lack of diligence and delay in proceeding with discovery. Discovery and trial dates have already been extended in this proceeding four times, and Petitioner has been aware for over six months that settlement discussions were unsuccessful and would not continue. However, Petitioner waited until the day expert disclosures were due to file this Motion for Extension. Accordingly, Petitioner's motion should be denied.

Petitioner can point to no facts that would justify prolonging this proceeding. The standard for allowing an extension of discovery and trial dates prior to the expiration of the discovery period is good cause. *See* Fed. R. Civ. P. 6(b)(1); TBMP § 509.01(a). "Moreover, a party moving to extend time must demonstrate that the requested extension of time is not necessitated by the party's own lack of diligence or unreasonably delay in taking the required action during the time previously allotted therefor." TBMP § 509.01(a). In this case, Registrant has consented to extend time four times over the last year to conduct settlement negotiations, and

those extensions were granted by the Board. However, settlement discussions between the parties ended in January, 2010. (*See* email dated January 11 from counsel for Petitioner, Phillip Jones, attached as Exhibit A.) Petitioner alleges that discovery "until now has been held pending settlement discussions," but cannot show good cause why it has not conducted discovery over the last six months. Indeed, Petitioner has had more than sufficient time to initiate whatever discovery it needs. *See Instruments SA Inc. v. ASI Instruments Inc.*, 53 U.S.P.Q.2d 1925, 1928 (TTAB 1999) (holding that two and one-half months was sufficient time to conduct necessary discovery and denying motion to extend).

Where settlement discussions have broken down, there is no justification for failing to move forward with the proceedings. "[E]ven if the parties had been discussing settlement, the mere existence of such negotiations, without more, would not justify petitioner's delay in proceeding with testimony." *Fairline Boats plc v. New Howar Boats Corp.*, 59 U.S.P.Q.2d 1479, 1480 (TTAB 2001); *see also Instrumnets SA Inc.*, 53 U.S.P.Q.2d at 1927 (denying motion to extend where "opposer knew, or should have known, that settlement, or even serious talk of settlement, was unlikely"). Here, Petitioner had more than ample notice that there would be no further settlement negotiations—indeed, it was Petitioner who informed Registrant that settlement negotiations broke down—and, despite that, decided not to proceed with retaining an expert or taking discovery. Petitioner took that risk and should not now, by means of a contested motion on the day expert disclosures were due, be permitted to rectify its own failure to proceed with discovery.

Furthermore, Petitioner's delay in bringing this motion belies its assertion that it "requires additional time." Petitioner requests that, even if its Motion to Extend is denied, that the Board extend the due date for expert disclosures by thirty days. Again, Petitioner can show

no good cause for this request. Rather, Petitioner waited until the day expert disclosures were due to file the instant motion, which weighs against a finding of good cause. *See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 U.S.P.Q.2d 1848, 1851 (TTAB 2000) (denying motion to extend even where there were valid reasons to grant the motion, in part because the applicant waited until the penultimate day in the period to move for extension). This proceeding was initiated over a year ago, on May 22, 2009, and this Board has entered four extensions of time. Petitioner's lack of diligence should not be permitted to further prejudice Registrant by allowing this cancellation proceeding to continue to hang over Registrant's head. The Motion to Extend should therefore be denied.

Respectfully submitted,

Dated: June 21, 2010

/Michael G. Kelber/
One of the Attorneys for Registrant,
12 Interactive, LLC

Michael G. Kelber, Esq.
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CERTIFICATE OF SERVICE

I, Katherine Dennis Nye, an attorney, state that I served a copy of ***REGISTRANT'S OPPOSITION TO PETITIONER'S MOTION FOR AN EXTENSION OF DISCOVERY AND TRIAL DATES*** upon counsel for Petitioner-Counter Registrant:

Philip A. Jones
BRINKS HOFER GILSON & LIONE
455 N. Cityfront Plaza Dr., Ste 3600
Chicago, IL 60611-5599

via First Class U.S. Mail on this 21st day of June, 2010.

__/Katherine Dennis Nye/_____
Katherine Dennis Nye

Exhibit A

Nye, Katherine Dennis

From: Kelber, Michael G.
Sent: Monday, June 14, 2010 1:15 PM
To: Nye, Katherine Dennis
Subject: FW: Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC

From: Jones, Philip [mailto:pjones@brinkshofer.com]
Sent: Monday, January 11, 2010 9:22 AM
To: Kelber, Michael G.
Subject: Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC

Michael –

I have just heard from my client that settlement negotiations have not been successful.

We have initial disclosures due today. I will need more time to put these together. I suggest that we extend the initial disclosure deadline 30 days along with all the other outstanding deadlines in this proceeding.

Please let me know if you agree.

Regards,

Philip Jones
Intellectual Property Attorney
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