

ESTTA Tracking number: **ESTTA435570**

Filing date: **10/13/2011**

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

Proceeding	92052950
Party	Plaintiff John S. Franklin
Correspondence Address	DOUGLAS M KAUTZKY ATTORNEY AT LAW 3868 CARSON ST, SUITE 105 TORRANCE, CA 90503-6706 UNITED STATES dmk@dslextreme.com
Submission	Other Motions/Papers
Filer's Name	DOUGLAS M. KAUTZKY, ESQ.
Filer's e-mail	iplaw@dslextreme.com
Signature	/DMK/
Date	10/13/2011
Attachments	ttab opposition to motion 92052163-92052950.pdf (22 pages)(5556153 bytes)

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

KING PAR, LLC.)	
)	
PETITIONER/COUNTERCLAIM)	CANCELLATION NO. 92052163
DEFENDANT)	
V.)	
)	
JOHN S. FRANKLIN)	
)	
RESPONDENT)	
)	
AND)	
)	
JOHN S. FRANKLIN)	
)	
PETITIONER/COUNTERCLAIM)	CANCELLATION NO. 92052950
PLAINTIFF)	
V.)	
)	
KING PAR, LLC.)	
)	
RESPONDENT)	
_____)	

TTAB
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

**OPPOSITION TO PETITIONER'S/COUNTERCLAIM DEFENDANT'S
MOTION TO EXTEND TIME FOR FILING PLAINTIFF'S BRIEF**

NOW COMES THE above-named defendant and counterclaim plaintiff, by and through its attorney, hereby opposes plaintiff and counterclaim defendant's motion to extend time for filing of plaintiff's brief for the following reasons:

On October 25, 2010, the parties stipulated to consolidate the proceedings. On November 8, 2010 the Board granted said stipulation, but noticed that the current trial schedule if adopted would cut-off defendant's discovery period. The Board allowed the parties 10 days from the date of the order (mailed November 12, 2010) to either adopt the alternate trial schedule put forth in the order or, "the parties are free to adopt an alternate schedule for this consolidated proceeding..." (**see exhibit "A"**).

On November 17, 2010, plaintiff filed with the TTAB a Motion for an Extension of Answer or Discovery or Trial Periods with consent. Said consented motion explicitly granted a 30 extension of time for discovery to close and all subsequent dates be reset accordingly (**see exhibit "B"**).

This is the only consented to and filed motion to extend the trial dates, and is the only such motion to extend the trial dates on the record before the TTAB (**see exhibit "C"**).

The Board granted the motion to extend as filed on November 17, 2010 (**see exhibit "D"**).

Therefore, the trial dates as consented to were extended by 30 days. Thus, the plaintiff's **trial brief was due by October 1, 2011** and not October 21, 2011 as alleged by plaintiff. According to Trademark Rule §2.128 Briefs at final hearing. (a)(1) The brief of the party in the position of plaintiff shall be due not later than sixty days after the date set for the close of rebuttal testimony. The brief of the party in the position of defendant, if filed, shall be due not later than thirty days after the due date of the first brief. A reply

brief by the party in the position of plaintiff, if filed, shall be due not later than fifteen days after the due date of the defendant are brief. Plaintiff's 15-day rebuttal period ended on August 1, 2011 (**see exhibit "B"**). **Thus, the brief was due by October 1, 2011.**

Plaintiff's attorney is trying to use the consented to motion to extend discovery and trial dates by 30 days to the Board's PROPOSED schedule in its November 8, 2010 order. This application of the consented to motion cannot be construed in this manner. Plaintiff's attorney himself electronically filed the consented to motion and must abide by the stipulated schedule and the dates contained therein.

Therefore, plaintiff's motion to extend time for filing plaintiff's brief is moot. Further, plaintiff's attorney's declaration is erroneous and should not be considered by the Board. Defendant did not stipulate to the scheduling order as contained therein (**see exhibit "E"**). Defendant never received said order and there is no record of said order ever filed with the Board. Plaintiff indicates that the stipulated order was sent to Eric H. Geffner. Mr. Geffner did not represent defendant before the Board and any notices should have been forwarded directly to the defendant up to the time present counsel appeared before the Board.

However, defendant did not stipulate to said order and since, there is no record of the order being filed with the Board, the actual consented to motion to extend time as electronically filed with the Board on November 17, 2010 is operative and binding on the parties.

Lastly, plaintiff through its attorney is asking the Board to extend time to file its

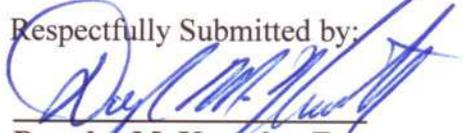
trial brief. In it's Declaration of Marshall MacFarlane of October 11, 2011, the attorney states "in beginning preparation of the brief due on October 20, I instructed my staff to retrieve the applicable file...from our law firm file storage room". Plaintiff's attorney does not provide the Board with a date in which said request was made. It could have been made 2 months ago or 2 days ago (**see exhibit "F"**). However, as of October 12, 2011, the file was found! Defendant's attorney, Mr. Douglas M. Kautzky spoke to Linda, Mr. Marshall Macfarlane's assistant who stated that "the file was located". Attorney for defendant was returning the call of plaintiff's attorney from October 11, 2011 when the information was provided to Mr. Kautzky.

Thus, the motion to extend time is again moot.

Further, the Board issued on October 12, 2011 indicating that plaintiff has not filed a brief under Trademark Rule 2.128(a)(3) (**see exhibit "G"**). Thus, the Board is in agreement with defendant that the trial brief was due by October 1, 2011, and no brief was therefore filed.

Therefore, respondent prays that plaintiff's motion to extend time for filing plaintiff's brief not be granted by the Board and quashed for the above reasons and that the Board's current order of October 12, 2011 remains in effect.

Date 10/13/2011

Respectfully Submitted by:


Douglas M. Kautzky, Esq.
Attorney for Defendant/Respondent
3868 Carson Street, Suite 105
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(310) 540-2699
iplaw@dslextreame.com

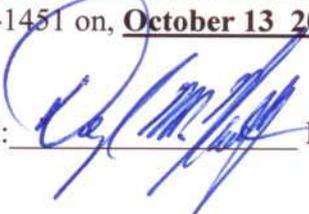
CERTIFICATE OF SERVICE (pursuant to 37 CFR Sec. 2.119)

I hereby certify that I served a copy of the foregoing, **OPPOSITION TO PETITIONER'S/COUNTERCLAIM DEFENDANT'S MOTION TO EXTEND TIME FOR FILINGS PLAINTIFF'S BRIEF**, on the Attorney for Petitioner/Counterclaim Defendant, by placing true copies thereof in a sealed envelope via United States Postal Service (USPS), First Class Mail, postage prepaid, on **October 13, 2011**, and via fax transmission on **October 13, 2011**.

Signed:  Douglas M. Kautzky, Esq.

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence, **OPPOSITION TO PETITIONER'S/COUNTERCLAIM DEFENDANT'S MOTION TO EXTEND TIME FOR FILINGS PLAINTIFF'S BRIEF**, is being electronically filed with the TTAB, COMMISSIONER FOR TRADEMARKS, P.O. BOX 1451, ALEXANDRIA, VA 22313-1451 on, **October 13 2011**.

Signed:  Douglas M. Kautzky, Esq.

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

am

Mailed: November 12, 2010

Cancellation No. 92052163

King Par, LLC

v.

John S. Franklin

Cancellation No. 92052950

John S. Franklin

v.

King Par, LLC

Elizabeth A. Dunn, Attorney (571-272-4267):

The parties' stipulation (filed October 25, 2010) to consolidate proceedings is hereby granted. See Fed. R. Civ. P. 42(a); and Trademark Trial and Appeal Board Manual of Procedure (TBMP) §511 (2d ed. rev. 2004).

In Cancellation No. 92052163, King Par, LLC pleads its Registration No. 2087314 (DIAMOND for golf clubs) and seeks cancellation of John S. Franklin's Registration No. 3231278 (DIAMOND GOLF for clothing and sporting goods, including golf clubs) on the ground of priority and likelihood of

EXHIBIT "A"

Cancellation Nos. 92052163 and 92052950

confusion.¹ In Cancellation No 92052950, John S. Franklin seeks cancellation of King Par, LLC's Registration No. 2087314 on the ground of abandonment. Answers have been filed in both proceedings. Because the two proceedings have common issues of law and fact, the stipulation to consolidate Cancellation Nos. 92052163 and 92052950 is approved, and Cancellation Nos. 92052163 and 92052950 are hereby consolidated and may be presented on the same record and briefs.

Cancellation No. 92052163 is the "parent" case. Papers should bear the number of each of the consolidated cases in ascending order as shown at the beginning of this order and the parties should file a single copy of each paper only in the parent case. Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. See Wright & Miller, Federal Practice and Procedure: Civil §2382 (1971).

The stipulation that the March 4, 2010 scheduling order entered in Cancellation No. 92052163 will be in effect for the consolidated proceeding presents two problems. First, because the parties are in reverse position in the two

¹ The petition to cancel also pleaded King Par, LLC's Registration Nos. 1558172 and 1556973, but those registrations have since expired under Trademark Act Sec. 9 and petitioner's amended petition withdrawing reference to those registrations was accepted.

Cancellation Nos. 92052163 and 92052950

proceedings, the usual schedule is inappropriate, and the parties must use a counterclaim schedule which reflects that King Par, LLC is plaintiff as to the priority and likelihood of confusion claim (treated in the schedule as plaintiff), and Mr. Franklin is plaintiff as to the abandonment claim (treated in schedule as counterclaim plaintiff).

Second, according to the March 4, 2010 order in Cancellation No. 92052163 which would be effective for this consolidated proceeding, discovery is scheduled to close November 9, 2010, and in Cancellation No. 92052950, that same date is the deadline for the parties' discovery conference. If the parties have been treating these cases as consolidated and addressed both proceedings in the discovery conference and initial disclosures served in Cancellation No. 92052163, this should have been part of the stipulation. Similarly, if the parties agreed to waive the discovery conference or initial disclosures in Cancellation No. 92052950, this should have been part of the stipulation. Trademark Rule 2.120(a)(2) ("Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board."). While the Board generally accommodates stipulations filed by the parties, in this case the stipulation imposes the wrong type of schedule and has the potential effect of waiving the required initial

Cancellation Nos. 92052163 and 92052950

disclosures and the opportunity to seek discovery in the cancellation filed by Mr. Franklin.²

Accordingly, proceedings herein are suspended, and the parties are allowed until TEN DAYS to file a stipulation with the Board indicating how the parties have addressed disclosure and discovery issues in Cancellation No. 92052950 (e.g. disclosure and discovery has been completed or waived), and if they wish to adopt the schedule set forth below which incorporates the November 9, 2010 close of discovery, but otherwise employs the counterclaim form which is necessary for this consolidated proceeding.

The parties are free to adopt an alternate schedule for this consolidated proceeding, but it must employ the counterclaim form used below.

Discovery Closes	November 9, 2010
Plaintiff's Pretrial Disclosures	December 24, 2010
30-day testimony period for plaintiff's testimony to close	February 7, 2011
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	February 22, 2011

² The Board notes that Mr. Franklin is acting without counsel. While Patent and Trademark Rule 10.14 permits any person to represent himself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board to secure the services of an attorney who is familiar with such matters. Strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1212 (TTAB 2006).

Cancellation Nos. 92052163 and 92052950

30-day testimony period for defendant and plaintiff in the counterclaim to close	April 8, 2011
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	April 23, 2011
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	June 7, 2011
Counterclaim Plaintiff's Rebuttal Disclosures Due	June 22, 2011
15-day rebuttal period for plaintiff in the counterclaim to close	July 22, 2011
Brief for plaintiff due	September 20, 2011
Brief for defendant and plaintiff in the counterclaim due	October 20, 2011
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	November 19, 2011
Reply brief, if any, for plaintiff in the counterclaim due	December 4, 2011

Proceedings herein are suspended pending the parties' response to this order.

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ESTA Tracking number: ESTTA378986

Filing date: 11/17/2010

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

Proceeding.	92052163
Applicant	Plaintiff King Par, LLC
Other Party	Defendant John S. Franklin

Motion for an Extension of Answer or Discovery or Trial Periods With Consent

The Close of Discovery is currently set to close on 12/19/2010. King Par, LLC requests that such date be extended for 30 days, or until 01/18/2011, and that all subsequent dates be reset accordingly.

Time to Answer :	CLOSED
Deadline for Discovery Conference :	CLOSED
Discovery Opens :	CLOSED
Initial Disclosures Due :	CLOSED
Expert Disclosure Due :	12/19/2010
Discovery Closes :	01/18/2011
Plaintiff's Pretrial Disclosures :	03/04/2011
Plaintiff's 30-day Trial Period Ends :	04/18/2011
Defendant's Pretrial Disclosures :	05/03/2011
Defendant's 30-day Trial Period Ends :	06/17/2011
Plaintiff's Rebuttal Disclosures :	07/02/2011
Plaintiff's 15-day Rebuttal Period Ends :	08/01/2011

The grounds for this request are as follows:

Parties are unable to complete discovery/testimony during assigned period

King Par, LLC has secured the express consent of all other parties to this proceeding for the extension and resetting of dates requested herein.

King Par, LLC has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Respectfully submitted,
/Marshall G. MacFarlane/
Marshall G. MacFarlane
macfarlane@youngbasile.com
john@salesquest1.com
11/17/2010



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Cancellation

Number: 92052163**Filing Date:** 03/04/2010**Status:** Pending**Status Date:** 03/04/2010**Interlocutory Attorney:** [ELIZABETH A DUNN](#)

Defendant

Name: [John S. Franklin](#)**Correspondence:** [DOUGLAS M KAUTZKY](#)
3868 CARSON STREET, SUITE 105
TORRANCE, CA 90503-6706
UNITED STATES
dmk@dslextreme.com**Serial #:** [78655479](#) [Application File](#)**Registration #:** [3231278](#)**Application Status:** Cancellation Pending**Mark:** DIAMOND GOLF

Plaintiff

Name: [King Par, LLC](#)**Correspondence:** [MARSHALL MACFARLANE](#)
YOUNG BASILE
301 EAST LIBERTY, SUITE 680
ANN ARBOR, MI 48104
UNITED STATES
macfarlane@youngbasile.com**Serial #:** [75107078](#) [Application File](#)**Registration #:** [2087314](#)**Application Status:** Cancellation Pending**Mark:** DIAMOND**Serial #:** [73719123](#) [Application File](#)**Registration #:** [1556973](#)**Application Status:** Cancelled - Section 8**Mark:** DIAMOND**Serial #:** [73720133](#) [Application File](#)**Registration #:** [1558172](#)**Application Status:** Cancelled - Section 8**Mark:** TOUR DIAMOND SOLITAIRE

Prosecution History

#	Date	History Text	Due Date
22	10/11/2011	P'S MOTION FOR AN EXTENSION OF TIME	
21	10/12/2011	RESPONSE DUE 30 DAYS (DUE DATE)	11/11/2011
20	12/07/2010	D'S CHANGE OF ADDRESS	
19	12/07/2010	D'S CHANGE OF ADDRESS	
18	11/17/2010	EXTENSION OF TIME GRANTED	
17	11/17/2010	STIPULATION FOR AN EXTENSION OF TIME	
16	11/12/2010	SUSPENDED PENDING DISP OF OUTSTNDNG MOT	
15	10/25/2010	P'S MOTION TO CONSOLIDATE	
14	10/19/2010	BOARD'S COMMUNICATION	
13	09/21/2010	REPORT OF RULE 26 CONFERENCE	
12	09/10/2010	BOARD'S ORDER: TRIAL DATES REMAIN AS SET	

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

November 17, 2010

PROCEEDING NO. 92052163
King Par, LLC

v.

John S. Franklin

MOTION TO EXTEND GRANTED

By the Board:

King Par, LLC's consent motion to extend, filed Nov 17, 2010, is granted. Dates are reset as set out in the motion.

.oOo.

EXHIBIT "D"

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

CANCELLATION NO. 92052163

KING PAR, LLC,

v.

JOHN S. FRANKLIN

CANCELLATION NO. 92052950

JOHN S. FRANKLIN

v

KING PAR, LLC

Consistent with the order of the Trademark Trial and Appeal Board mailed November 8, 2010, and stipulate to the entry of the following Scheduling Order.

STIPULATED SCHEDULING ORDER

Discovery Closes	December 19, 2010
Plaintiff's Pretrial Disclosures	January 24, 2011
30-day testimony period for plaintiff's testimony to close	March 9, 2011
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	March 24, 2011
30-day testimony period for defendant and plaintiff in the counterclaim to close	May 8, 2011
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	May 23, 2011

30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	July 7, 2011
Counterclaim Plaintiff's Rebuttal Disclosures Due	July 22, 2011
15-day rebuttal period for plaintiff In the counterclaim to close	August 22, 2011
Brief for plaintiff due	October 20, 2011
Brief for defendant and plaintiff in The counterclaim due	November 20, 2011
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	December 19, 2011
Reply brief, if any, for plaintiff in the counterclaim due	January 4, 2012

DATED: November 12, 2010

s/Marshall G. MacFarlane

 Marshall G. MacFarlane

 Reg. No. 30,403

 301 E. Liberty, Suite 680

 Ann Arbor, MI 48104

 (734) 662-0270

 (734) 662-1014 (Facsimile)

macfarlane@youngbasile.com

DATED: November 12, 2010

s/John S. Franklin

 John S. Franklin

 2562 Via Tejon

 Palos Verdes Estates, CA 90274

 (310) 697-8520

 (310) 791-2700 (Facsimile)

john.franklin@sportssourceinc.com

CERTIFICATE OF MAILING

I hereby certify that this correspondence: Stipulated Scheduling Order, is being filed with the TTAB electronically, on November 17, 2010.

s/Marshall G. MacFarlane

Marshall G. MacFarlane

CERTIFICATE OF SERVICE

I hereby certify that this correspondence: Stipulated Scheduling Order, is being deposited with the United States Postal Service, 1st Class Mail, postage prepaid, in an envelope addressed to Eric H. Geffner, 815 Moraga Drive, Los Angeles, CA 90049-1633, on November 17, 2010.

s/Marshall G. MacFarlane

Marshall G. MacFarlane

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

KING PAR, LLC,)
)
PETITIONER,)
) CANCELLATION NO. 92052163
v)
)
SPORTS SOURCE, INC.,)
)
RESPONDENT.)

AND

JOHN S. FRANKLIN,)
)
PETITIONER,)
) CANCELLATION NO. 92052950
v)
)
KING PAR, LLC)
)
RESPONDENT.)

DECLARATION OF MARSHALL G. MACFARLANE

1. I am of full age, and familiar with the facts as described herein, and make this Declaration under penalties of perjury.

2. I am the principal attorney representing the Plaintiff, King Par, LLC, in the above-captioned cancellation proceedings.

3. Attached hereto is the stipulated scheduling order submitted by the parties on or about November 12, 2010.

4. Pursuant to the stipulated scheduling order in this matter, Plaintiff's initial trial brief is due on October 20, 2011.

5. In beginning preparation of the brief due on October 20, I instructed my staff to retrieve the applicable file, our File No. KPC-469, from our law firm file storage room. A few minutes after making this request, I was advised by my assistant that the entire file, including depositions, pleadings, and documentary evidence was missing from the file room.

6. I instructed my staff to undertake a thorough search of the entire office, and to interrogate each of the attorneys in the office to determine whether or not they had custody of the file. We determined, after a thorough search and investigation that the entire file was missing from our office.

7. There is some possibility that the file was mistakenly transmitted to our long term storage facility, and I have instructed my staff to undertake immediate efforts to attempt to locate the file in that facility. However, our long term storage facilities are maintained by an outside contractor, and files placed in long term storage can take several days to retrieve. Further, because it is apparent that the file was not transmitted to long term storage in the usual fashion, since we do not have a record of the transmittal, it is entirely possible that we will need to conduct a search of all of our archive files for a period of as much as twenty-four months.

8. Because of the loss of these file materials, it may be necessary for me to reconstruct the entire file, including obtaining new copies of deposition transcripts and the associated exhibits, and to attempt to reconstruct all of the remaining documentary exhibits which will be required to support Plaintiff's brief.

9. For all the foregoing reasons, the undersigned counsel has filed a motion with this Board to extend the dates for the filing of Plaintiff's brief, and to extend dates for responsive briefs, accordingly.



Marshall G. MacFarlane

DATED: October 1, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: October 12, 2011

Cancellation No. 92052163

King Par, LLC

v.

John S. Franklin

Cancellation No. 92052950

John S. Franklin

v.

King Par, LLC

Amy Matelski, Paralegal Specialist:

It is noted by the Board that petitioner's time for filing a brief on the case has expired, and no brief has been filed. Trademark Rule 2.128(a)(3) provides that when a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than 15 days, in which to show cause why the Board should not treat such failure as a concession of the case. The rule further provides that if plaintiff fails to file a response to the order, or files a response indicating that it has lost

interest in the case, judgment may be entered against plaintiff.

In view of the above, petitioner is allowed until thirty days from the mailing date of this order to show cause why the Board should not treat its failure to file a brief as a concession of the case, failing which a judgment dismissing the petition for cancellation with prejudice will be entered against petitioner.