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

Proceeding	92055800
Party	Defendant Susoix LLC
Correspondence Address	SUSOIX LLC 85 8TH AVENUE APT 5B NEW YORK, NY 10011 UNITED STATES
Submission	Motion to Extend
Filer's Name	Stuart Gillespie
Filer's e-mail	stugillespie1@gmail.com
Signature	/Stu Gillespie/
Date	08/07/2012
Attachments	92055800, City v. Susoix, Motion to extend time for Answer re Skateboarder Mark.pdf (7 pages)(50076 bytes)

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

**City of New York, By And Through Its
Department of Parks & Recreation,**

Opposer,

v.

Cancellation No. 92055800

Susoix LLC,

Applicant.

**Request for Enlargement of Time
To File an Answer**

Under Fed. R. Civ. P. 6(b), Susoix respectfully requests an enlargement of time to respond to the Notice of Opposition (“Notice”) filed by the City of New York, By and Through Its Department of Parks & Recreation (the “City”). Rule 6(b) authorizes the Board to extend the time for a responsive pleading for good cause if a request is made before the original time expires. *See* Fed. R. Civ. P. 6(b)(1); *see also* TBMP § 509.01. This request is timely given that Susoix’s Answer is not due until August 12, 2012. Thus, the sole question is whether Susoix has good cause for the motion. *See* TBMP § 509.01. As explained in the accompanying memorandum, there is good cause for extending the time for an Answer until this Board has ruled on Susoix’s partial motion to dismiss.

Dated: 8/7/2012

Respectfully submitted,

/Stu Gillespie/
Stuart C. Gillespie
Member, Susoix LLC

215 Walter St. NE
Albuquerque, NM 87102
(347) 409 4311
Colorado Bar # 42861

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**Memorandum in Support of
Request for Enlargement of Time To File an Answer**

Pursuant to TBMP § 509.01(a), a motion to extend must set forth with particularity the facts said to constitute good cause for the requested extension. Here, an extension is appropriate to avoid confusion and increase efficiency.

The City of New York, By and Through Its Department of Parks & Recreation (the “City”), filed a Petition to Cancel (“Petition”) Susoix’s registration for the mark Central Park Skateboarder Global Rolling (the “Skateboarder Mark”) (Serial No. 85255147). In total, the City alleges six claims in opposition to the Skateboarder Mark. In response, Susoix moved to dismiss four of those claims. It did not, however, move to dismiss the entire case. It is thus unclear whether Susoix needs to submit an Answer to the unchallenged claims within 40 days of the filing of the Notice, that is by August 12, 2012.¹ In an abundance of caution, Susoix has filed the instant motion to extend the time for an Answer until the Board has rules on the partial motion to dismiss.

¹ As a general matter, when a respondent files a Rule 12(b)(6) motion to dismiss, the Board extends the time for an answer.

Whether a party is required to answer unchallenged counts after a Rule 12(b) motion has been filed as to certain, but not all, of the counts is an issue that has not received significant judicial attention. Indeed, Susoix has been unable to find any cases from the Board addressing this issue. Fortunately, there is a well-written and researched law review article on point: Michael D. Moberly & Andrea G. Lisenbee, *To Plead or Not to Plead?: Assessing the Effect of A Partial Motion to Dismiss on the Duty to Answer*, 13 SUFFOLK J. TRIAL & APP. ADVOC. 45, 58 (2008) (hereinafter “Moberly & Lisenbee”).

In that law review article, Mr. Moberly and Ms. Lisenbee explain that the majority of courts have decided that a party does not need to file an answer while a partial motion to dismiss is pending. *Id.* at 51-57. Cases in support of this position include: *Oil Express Nat., Inc. v. D’Allesandro*, 173 F.R.D. 219, 221 (N.D. Il. Mar. 31, 1997), *Brocksopp Engineering, Inc. v. Bach–Simpson Ltd.*, 136 F.R.D. 485, 486-87 (E.D. Wis. 1991), and *Business Incentives Co. v. Sony Corp. of America*, 397 F.Supp. 63, 64 (S.D.N.Y. 1975).

Moberly and Lisenbee note, however, that some courts – the minority – have held that a partial motion to dismiss only enlarges the time to answer the *challenged* claims. *See Moberly & Lisenbee*, 13 SUFFOLK J. TRIAL & APP. ADVOC. at 46-48. According to this view, a defendant who files a partial motion to dismiss must also file a partial answer to the unchallenged claims. *See, e.g., Gerlach v. Michigan Bell Tele. Co.*, 448 F. Supp. 1168, 1174 (E.D. Mich. 1978).

This Board, however, need not take a position on this split in authority as there remains time for an eminently practical solution: granting an extension of time for the Susoix’s Answer until the Board has ruled on the motion to dismiss. The purposes of

Rule 12(b) are best served by this approach. First, this approach is more efficient insofar as not reading Rule 12(a) as extending the time to answer, in the presence of a partial Rule 12(b) motion, could result in duplicative sets of pleadings. That is, Susoix would first file an answer to the unchallenged counts. Then, if the motion to dismiss is successful on less than all the counts challenged in the motion, Susoix would have to file a second answer regarding the remaining counts that survived the partial motion to dismiss. *See Oil Express Nat. Inc.*, 173 F.R.D. at 221. The result would be a confusing set of two Answers. Simply extending the time frame for Susoix's answer avoids such duplicative pleadings.

More importantly, extending the deadline for Susoix's Answer avoids confusion as to the scope of discovery. Normally, filing an answer triggers the timing for a discovery conference under TBMP § 401 and the subsequent commencement of discovery. *See* TBMP § 401.01 (“an answer must be filed to all claims and counterclaims, and issues related to the pleadings resolved before the parties can have a meaningful discovery conference”). Yet, in this case, if Susoix were required to file an answer to the unchallenged claims, there would be pending, simultaneously, a partial answer and a partial motion to dismiss. “Proceeding with litigation while a partial motion to dismiss is pending may indeed raise difficult issues concerning the proper scope of discovery.” *Moberly & Lisenbee*, 13 SUFFOLK J. TRIAL & APP. ADVOC. At 60-61. One obvious question would be whether the parties should be permitted to initiate discovery regarding the claims challenged in the partial motion to dismiss. To avoid confusion regarding the scope of discovery, the Board should grant an extension for Susoix's Answer. Such an approach would stay the discovery conference as well as the

commencement of discovery. *See* TBMP § 401.01 (where “a pleading motion under Fed. R. Civ. P. 12 or counterclaim has been filed, the parties’ obligation to have a discovery conference is effectively stayed”).

Finally, extending the time for Susoix’s Answer ensures that the Board will be able to rule on Susoix’s partial motion to dismiss. Some courts have held that a partial motion to dismiss submitted pursuant to Rule 12(b) might be “rendered moot by the filing of an answer,” *Brisk v. City of Miami Beach*, 709 F. Supp. 1146, 1147 (S.D. Fla. 1989), making it “procedurally impossible” for the court to rule on the motion (or at least to grant the motion), *See Walburn v. City of Naples, No.*, 2005 WL 2322002, at *10 n.16 (M.D. Fla. Sept. 22, 2005) (stating that because defendant moved to dismiss a count but then answered, the motion to dismiss was denied) (citation omitted). This outcome need not be the case if the Board grants the request for extension of the time to file an Answer.

WHEREFORE, to avoid confusion and in the interests of efficiency, Susoix respectfully requests that this Board extend the time for an Answer until after it has ruled on the partial motion to dismiss.

Dated: 8/7/2012

Respectfully submitted,

/Stu Gillespie/
Stuart C. Gillespie
Member, Susoix LLC
215 Walter St. NE
Albuquerque, NM 87102
(347) 409 4311
Colorado Bar # 42861

Certificate of Service

I hereby certify that a true and complete copy of the foregoing motion to dismiss and memorandum in support thereof has been served on the City by electronic transmission mutually agreed upon by the parties to:

Gerald Singleton,
NYC Department of Law
100 Church Street
New York, NY 10007
gsinglet@law.nyc.gov

/Stu Gillespie/
Stuart C. Gillespie
Member, Susoix LLC
215 Walter St. NE
Albuquerque, NM 87102
(347) 409 4311
Colorado Bar # 42861