

ESTTA Tracking number: **ESTTA555851**

Filing date: **08/23/2013**

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

Proceeding	92056574
Party	Plaintiff Frank Clegg Leatherworks LLC
Correspondence Address	STEVEN WEINBERG HOLMES WEINBERG PC 30765 PACIFIC COAST HIGHWAY, SUITE 411 MALIBU, CA 90265 UNITED STATES msalvatore@holmesweinberg.com, smweinberg@holmesweinberg.com
Submission	Motion to Extend
Filer's Name	Michael J. Salvatore
Filer's e-mail	hwtrademarks@gmail.com, msalvatore@holmesweinberg.com, smweinberg@holmesweinberg.com
Signature	/MJSalvatore/
Date	08/23/2013
Attachments	2013.08.23_Motion to Extend Time.pdf(96661 bytes ) 2013.08.23_Salvatore Declaration ISO Mtn to Extend.pdf(382972 bytes )

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

In re Reg. No. 3872561

Frank Clegg Leatherworks LLC,

Petitioner,

v.

El Group, LLC,

Respondent.

Cancellation No. 92056574

**PETITIONER’S MOTION TO EXTEND DISCOVERY PERIOD AND TRIAL DATES**

Petitioner Frank Clegg Leatherworks LLC (“Petitioner”) respectfully moves the Board, pursuant to Rule 6(b) of the Federal Rules of Civil Procedure, Trademark Rules of Practice 2.120(a)(2) and 2.116(a), and TBMP §§ 403.4 and 509.01, to extend the discovery period and trial dates in this proceeding for the reasons set forth below:

**BACKGROUND FACTS**

1. Petitioner’s counsel, Holmes Weinberg, PC, was substituted into this case only four days ago, on August 19, 2013. Prior to filing this Motion, Petitioner’s counsel attempted to obtain a stipulated extension of the discovery period and trial dates from counsel for Respondent, pursuant to 37 CFR § 2.120(a)(2). Declaration of Michael J. Salvatore (“Salvatore Decl.”), ¶ 2; Ex. A.

2. As of that date, the parties had not yet propounded any discovery in this proceeding, as prior counsel for Petitioner and Respondent’s counsel were trying to settle this proceeding.

3. Immediately after filing our Appearance in this matter, Petitioner's counsel, on August 19, 2013, sent an email to Respondent's counsel, providing a copy of the Appearance, advising that this firm was new counsel of record, and requesting a four month extension of the discovery period so that we could familiarize ourselves with the case, and if necessary conduct discovery. Salvatore Decl., ¶ 2; Ex. A.

4. On August 21, 2013, Respondent's counsel replied to Petitioner's counsel that Respondent would not consent to such an extension because "too many resources have already been expended on this matter." Salvatore Decl., ¶ 3; Ex. A. Counsel did not explain what he meant by this statement, particularly given that no discovery had yet been conducted.

5. Petitioner's counsel responded, explaining that the firm is new to the case and that the attorney responsible for the case, Steven Weinberg, was out of town all week in depositions. Petitioner's counsel explained that additional time was needed to review the file so that we could familiarize ourselves with the matter and determine if the case could be settled. Petitioner's counsel asked for a shorter suspension of thirty days for purposes of continuing the settlement discussions, with a ninety day extension thereafter if a settlement could not be reached. Salvatore Decl., ¶ 4; Ex. A.

6. On August 22, Respondent's counsel still refused to consent to an extension, and did not provide any additional reasons. Salvatore Decl., ¶ 5; Ex. A.

7. Not having been able to obtain a stipulated extension of the discovery period and trial dates, Petitioner served its First Set of Requests for the Production of Documents and Things and its First Set of Requests for Admission to Respondent's counsel on August 21, 2013, and now files this Motion.

## ARGUMENT

8. Good cause exists for an extension of the discovery period when the moving party has not been guilty of a lack of diligence or unreasonable delay, and when the privilege of seeking extensions has not been abused. TBMP § 509.01(a).

9. The Board has previously granted motions to extend under appropriate circumstances when there was a press of other litigation. *See, e.g., Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1384 (TTAB 2001) (granting an extension of opposer’s testimony period upon a finding that opposer’s counsel’s “press of other litigation may indeed constitute good cause for an extension of time, in appropriate circumstances”).

10. Here, Petitioner’s counsel was substituted into this matter just four days ago, on August 19, 2013, and because of counsel’s litigation schedule, Petitioner’s principal counsel was tied up in out of town depositions during that entire week. Petitioner now requests its first and only extension of time so that Petitioner’s counsel may familiarize themselves with the matter and take discovery.

11. Petitioner’s counsel does not have a historical perspective on this matter, and has not had time to familiarize itself with the settlement discussions that occurred between Respondent’s counsel and Petitioner’s prior counsel, which this firm understands to be the reason no discovery was yet conducted. Thus, there has been no lack of diligence or unreasonable delay.

12. Without an extension of the discovery deadline, Petitioner’s counsel will be unable to take any depositions in this matter after it reviews Respondent’s responses to Petitioner’s recently served written discovery.

13. Further, Petitioner has not previously requested any extensions of time in this matter. Thus, Petitioner has not engaged in a pattern of extensions or in any way sought to unnecessarily prolong these proceedings in bad faith. This fact supports a finding of good cause for granting Petitioner's first and only request for an extension of the discovery period.

14. Since no discovery has yet been conducted in this matter by either party, conducting discovery will certainly lead to the production of at least some additional evidence, and serve the interests of justice. Respondent's counsel's assertion is his August 21 email that there is "little chance that extending discovery would lead to the production of additional evidence that would substantially impact the resolution of this matter" is not reasonable or logical, considering that no discovery has yet taken place. Salvatore Decl., Ex. A.

15. Further, as no discovery has yet been conducted, conducting discovery over the course of the next three months will not add significant costs to this proceeding. The parties have not yet expended any resources propounding or responding to discovery.

16. While this law firm has only recently substituted into this matter, and is not fully familiar with the settlement negotiations that took place between the parties previously, it is our understanding that no discovery was taken earlier in the discovery period because the parties had been engaged in good faith settlement negotiations.

17. Allowing an extension of time so that Petitioner's newly substituted counsel may familiarize itself with the matter and for purposes of taking discovery is in the interest of justice and is supported by good cause. Respondent's counsel's arguments do not demonstrate any prejudice to Respondent that would be caused by a ninety-day extension of the discovery deadline in this matter.

## CONCLUSION

Petitioner's counsel substituted into this matter only four days ago, which was five days before the end of the discovery period, and has since diligently pursued an extension of the discovery deadline as it familiarizes itself with this matter. At this time, no discovery has yet been conducted, other than the requests propounded by Petitioner's counsel on August 21. Petitioner therefore respectfully prays for its first and only extension of time in this matter, so that it may conduct further discovery, which will in no way prejudice Respondent. Petitioner requests a ninety day extension of the discovery deadline and trial dates in this proceeding, beginning on the date of the Board's Order with respect to this Motion based on the good cause shown herein.

Dated: August 23, 2013

Respectfully submitted,

HOLMES WEINBERG, PC

/Michael J. Salvatore/

Michael J. Salvatore

30765 Pacific Coast Hwy, Suite 411

Malibu, CA 90265

Tel: 310.457.6100

Fax: 310.457.9555

Email: [msalvatore@holmesweinberg.com](mailto:msalvatore@holmesweinberg.com)

Attorneys for Petitioner, Frank Clegg  
Leatherworks LLC

**CERTIFICATE OF SERVICE**

I hereby certify that on August 23, 2013, a true and correct copy of this PETITIONER'S MOTION TO EXTEND TIME was served by Priority Mail to Respondent's counsel at the below address:

James C. Duda  
Bulkley, Richardson and Gelinas, LLP  
1500 Main Street, Suite 2700  
P.O. Box 15507  
Springfield, MA 01115-5507

/Nelda Piper/ \_\_\_\_\_  
Nelda Piper

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

In re Reg. No. 3872561

Frank Clegg Leatherworks LLC,

Petitioner,

v.

El Group, LLC,

Respondent.

Cancellation No. 92056574

**DECLARATION OF MICHAEL J. SALVATORE**

I, Michael J. Salvatore, hereby declare as follows:

1. I am a counsel of record for Petitioner Frank Clegg Leatherworks LLC (“Petitioner”). I submit this declaration in support of Petitioner’s Motion to Extend Time. I have personal knowledge of the facts set forth herein and if called as a witness, I could and would testify competently thereto.

2. On August 19, 2013, I sent an email to Respondent’s counsel requesting a four month extension of the discovery period in this matter due to the fact that no discovery had yet been conducted, and because my law firm had just substituted into the matter that day, which was five days before the close of discovery. I asked that counsel respond to my request by the close of business on August 20.

3. On August 21, Respondent’s counsel replied that Respondent would not consent to such an extension because “too many resources have already been expended on this matter.”

4. On August 21, I sent another email to Respondent’s counsel explaining that Steven Weinberg, the principal attorney in this case was tied up in depositions out of town, and requesting a thirty day suspension of all dates in the present matter for purposes of resuming

settlement discussions, with a ninety day extension of the discovery deadline thereafter if a settlement could not be reached. I asked that counsel respond to my request by the close of business on August 21.

5. On August 22, Respondent's counsel replied that he could not consent to an extension of the discovery period, and did not provide any additional reasons.

6. Attached hereto as **Exhibit A** is a true and correct copy of the email chain between myself and Respondent's counsel discussed in Paragraphs 2 through 5 above.

I declare under penalty of perjury, under the laws of the United States of America, that the foregoing is true and correct. Executed this 23rd day of August, 2013.

/Michael J. Salvatore/

Michael J. Salvatore

# EXHIBIT A

**From:** [Duda, James](#)  
**To:** [Michael J. Salvatore](#)  
**Cc:** [Steven M. Weinberg](#); [Nelda Piper](#)  
**Subject:** RE: Cancellation No. 92056574 / Frank Clegg v. El Group, LLC /Request to Extend Discovery  
**Date:** Thursday, August 22, 2013 10:43:34 AM

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Dear Michael,

For the reasons stated in my email of yesterday, we cannot consent to an extension of discovery in this matter.

Jim

**James C. Duda, Partner**

Bulkley, Richardson and Gelinas, LLP  
1500 Main Street, Suite 2700 | P.O. Box 15507 | Springfield, MA 01115-5507  
Direct: 413-272-6284 | Fax: 413-272-6806  
[jduda@bulkley.com](mailto:jduda@bulkley.com) | [www.bulkley.com](http://www.bulkley.com)

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**From:** Michael J Salvatore [mailto:MSalvatore@holmesweinberg.com]  
**Sent:** Wednesday, August 21, 2013 11:20 AM  
**To:** Duda, James  
**Cc:** Steven M. Weinberg; Nelda Piper  
**Subject:** Re: Cancellation No. 92056574 / Frank Clegg v. El Group, LLC /Request to Extend Discovery

Dear James:

Thank you for your response. While we appreciate the issues raised, we are new to the case and the principal counsel on our side, Steven Weinberg, is in depositions all week out of town. We do not have a historical perspective on this matter and clearly need an appropriate amount of time to look into it and then, if settlement is a possibility, to explore that with you. That being said, if settlement is not possible, we will need to go forward with the case. My understanding is that no discovery has taken place, and we need to give ourselves the flexibility to take discovery should settlement not occur. In that vein I suggest the following: suspend the case for 30 days to see if settlement is possible with the understanding that if it does not occur, the close of discovery will be reset to 90 days from the date the suspension ends with all other dates extended accordingly. Please let me know by the close of business today if you are agreeable or not to this proposal so that, if not, we can file our motion to extend the discovery period.

Thank you,

Mike

Michael J. Salvatore  
**Holmes Weinberg, PC**  
30765 Pacific Coast Highway, Ste. 411 | Malibu CA 90265  
t: 310.457.6100 x 201 | c. 914.263.1001 | f: 310.457.9555  
[msalvatore@holmesweinberg.com](mailto:msalvatore@holmesweinberg.com) | [www.holmesweinberg.com](http://www.holmesweinberg.com)

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## EXHIBIT A

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On Aug 21, 2013, at 7:11 AM, "Duda, James" <[jduda@bulkley.com](mailto:jduda@bulkley.com)> wrote:

Dear Mike,

My clients believe that too many resources have already been expended on this matter, they are frustrated with its progression, and they would like to bring it to a resolution at the earliest possible date. In light of (1) the little chance that extending discovery would lead to the production of additional evidence that would substantially impact the resolution of this matter; (2) the significant costs that the parties likely would incur as a result of any extension; and (3) the more than ample time that has been available for discovery during the past eight months, we see no value to extending the discovery period at this time.

[REDACTED]

Please call me if you would like to discuss any aspect of this matter.

Thank you.

Jim

**James C. Duda, Partner**

Bulkley, Richardson and Gelinas, LLP

1500 Main Street, Suite 2700 | P.O. Box 15507 | Springfield, MA 01115-5507

Direct: 413-272-6284 | Fax: 413-272-6806

[jduda@bulkley.com](mailto:jduda@bulkley.com) | [www.bulkley.com](http://www.bulkley.com)

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**From:** Michael J Salvatore [mailto:MSalvatore@[holmesweinberg.com](mailto:MSalvatore@holmesweinberg.com)]

**Sent:** Monday, August 19, 2013 3:55 PM

**To:** Duda, James

**Cc:** Steven M. Weinberg; Nelda Piper

**Subject:** Cancellation No. 92056574 / Frank Clegg v. El Group, LLC / Substitution of Attorney

Dear James:

Our firm has just substituted into the above-referenced cancellation proceeding. The attached is

## EXHIBIT A

being sent to you today via US Mail. We are writing to request a 4-month extension of all pending dates, since no discovery has yet been conducted in this proceeding.

Please let us know if you will agree to the 4-month extension by close of business tomorrow, August 20, 2013.

Thank you very much,

Mike

Michael J. Salvatore

**Holmes Weinberg, PC**

30765 Pacific Coast Highway, Ste. 411 | Malibu CA 90265

t: 310.457.6100 x 201 | c. 914.263.1001 | f: 310.457.9555

[msalvatore@holmesweinberg.com](mailto:msalvatore@holmesweinberg.com) | [www.holmesweinberg.com](http://www.holmesweinberg.com) | [Bio](#)

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