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Filing date: **12/10/2014**

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

Proceeding	92056644
Party	Plaintiff Summit Entertainment, LLC
Correspondence Address	JILL M PIETRINI SHEPPARD MULLIN RICHTER & HAMPTON LLP 1901 AVENUE OF THE STARS, SUITE 1600 LOS ANGELES, CA 90067-6055 UNITED STATES pbost@sheppardmullin.com, lthompson@sheppardmullin.com, mdanner@sheppardmullin.com
Submission	Reply in Support of Motion
Filer's Name	Paul A. Bost
Filer's e-mail	pbost@sheppardmullin.com, lthompson@sheppardmullin.com, jpietrini@sheppardmullin.com, mdanner@sheppardmullin.com, lmartin@sheppardmullin.com
Signature	/s/ Paul A. Bost
Date	12/10/2014
Attachments	Reply Brief ISO Motion for Leave to Amend.pdf(161590 bytes)

Instead, Infinite argues that Summit unjustifiably delayed in seeking leave to amend and that such delay prejudices Infinite. However, Infinite has failed to establish that the time that elapsed between Summit's discovery of Infinite's position that it uses the BELLA'S ENGAGEMENT RING mark subject to a license agreement with Stephenie Meyer constitutes undue delay. Also, Infinite cannot seriously contend that it needs to conduct discovery to determine the viability of Summit's claim that Infinite's registration is void *ab initio*. Nevertheless, even if it does, discovery has not yet closed in this case. Therefore, Infinite has a sufficient opportunity to conduct discovery. Furthermore, the Board has discretion to reopen or extend discovery, as necessary, to allow Infinite any additional time that Infinite seeks.

II. SUMMIT HAS NOT UNDULY DELAYED TO THE PREJUDICE OF INFINITE

First, contrary to Infinite's claim otherwise, Summit did not become aware of Infinite's claim that it was using the BELLA'S ENGAGEMENT RING mark pursuant to a purported license granted by Stephenie Meyer until July 2013, not February 2013. Yes, Infinite alleged in its February 2013 Answer that it "was authorized by Ms. Meyer to register and use BELLA'S ENGAGEMENT RING for goods and services, including jewelry." (Docket No. 4, ¶ 3, 8.) Nevertheless, such allegation – while consistent with Infinite's later assertion that it was using the mark pursuant to a license granted by Ms. Meyer – is not tantamount to such later assertion. Thus, Summit learned of Infinite's claim that it was using the mark allegedly pursuant to a license in July 2013 at the earliest.

Second, it is well established that whether a party seeking leave to amend has unduly delayed – and whether such delay will result in prejudice to the non-moving party – is directly related to whether discovery has closed. When discovery has not closed at the time leave to amend is sought, as is the case here, there is rarely a finding of undue delay. *Commodore*

Electronics Ltd. v. CBM Kabushiki Kaisha, 26 U.S.P.Q.2d 1503, 1505-06 (TTAB 1993)

(“applicant plainly will not be prejudiced by allowance of a new claim since not only did sufficient time remain in the discovery period for applicant to serve (as it did) additional discovery requests, but opposer has indicated its agreement to allow applicant further time to conduct any follow up discovery with respect to the new claim sought to be added”); *United States Olympic Committee v. O-M Bread Inc.*, 26 U.S.P.Q.2d 1221, 1222 (TTAB 1993)

(“Opposer's motion to amend is granted . . . Second, applicant would not be prejudiced because the proceeding is still in the pre-trial phase and, indeed, discovery has been extended”);

Microsoft Corp. v. Qantel Business Systems Inc., 16 U.S.P.Q.2d 1732, 1733-34 (TTAB 1990)

(granting motion for leave to amend – except as to amendments which were legally futile – because “proceeding is still in the discovery stage.”) Because discovery has not closed in this case, Infinite cannot complain that the amendment prejudices it.

Third, Infinite need not conduct discovery to defend against Summit’s claim that Infinite’s registration is void *ab initio*. Infinite cannot explain how Stephenie Meyer is in possession, custody, or control of any information or documents relevant to *Infinite’s belief* that it was licensed by Stephenie Meyer to use the BELLA’S ENGAGEMENT RING. In any event, Summit will agree to extend discovery in order to allow Infinite ample time to conduct any discovery it believes is necessary to defend against Summit’s added claim. *See Commodore, supra*. Accordingly, there can be no undue delay where any alleged potential prejudice to Infinite is mitigated. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 U.S.P.Q.2d 1355, 1359 (TTAB 1989) (“the concept of ‘undue delay’ is inextricably linked with the concept of prejudice to the non-moving party.”)

Fourth, BTL has been on notice of Summit's intention to seek leave to add the claim at issue since at least as early as April 29, 2014. (Supp. Bost Decl. ¶ 2, Ex. G.) Summit tabled filing its instant motion for leave to amend to see if this motion and the relief sought herein might be mooted by the parties' settlement of this dispute. This is the course of action Infinite suggested Summit take. (*Id.* ¶ 3, Ex. H.) Summit only filed this motion when the parties' settlement discussions proved fruitless. (*Id.*)

III. CONCLUSION

Based on the foregoing, Summit respectfully requests that the Board enter an order granting it leave to file its proposed amended pleading and that the Board deem that pleading filed and served.

Respectfully submitted,

Dated: December 10, 2014

/s/Paul A. Bost
Jill M. Pietrini
Paul A. Bost
Attorneys for Petitioner and Counterclaim-Defendant
Summit Entertainment, LLC

SUPPLEMENTAL DECLARATION OF PAUL A. BOST

I, Paul A. Bost, declare as follows:

1. I am an attorney duly licensed to practice before the Board and I am an associate in the law firm of Sheppard Mullin Richter Hampton, LLP, counsel of record for Summit in this matter. I am the lawyer primarily responsible for this case, along with my partner, Jill Pietrini. I have personal knowledge of the facts set forth in this declaration and if called to testify, I could and would testify competently thereto.

2. On April 29, 2014, I emailed counsel for Infinite, Brett Evanson, to inform him that, in addition to certain topics we intended to discuss during an upcoming phone call, I also wanted to determine “if Infinite Jewelry will stipulate to the amendment of the petition for cancellation to add a claim for cancelation on the grounds that the registration is void ab initio.” A true and correct copy of this email is attached hereto as **Exhibit G**.

3. On May 1, 2014, Mr. Evanson and I had a telephone conversation regarding a number of things, including Infinite’s willingness to stipulate to the amendment of Summit’s Petition for Cancellation. On May 6, 2014, I sent Mr. Evanson a follow-up email inquiring as to Infinite’s willingness to stipulate in order to avoid motion practice. Mr. Evanson replied to my email on May 7, 2014, and, because he had not been able to discuss the matter with Infinite due to its principal’s health issues, refused to enter the requested stipulation. Mr. Evanson further advised as follows: “I would suggest that prior to seeking leave to amend, you take the cost of that action, and include it in a settlement offer. I still believe we can resolve this matter without further litigation.” A true and correct of this email exchange is attached hereto as **Exhibit H**.

4. After this discussion, Summit continued to meet and confer with Infinite regarding its supplementation of its discovery responses and document production. Some of the

information Summit sought from Infinite in discovery, such as Infinite's updated gross receipts for sales of goods under its mark, was important to Summit's ability to consider Infinite's outstanding settlement proposal. In August 2014, and after Summit received discovery responses from Infinite sufficient to allow Summit to consider Infinite's outstanding settlement proposal, I sent an email to Mr. Evanson responding to Infinite's settlement proposal and making a counter-proposal. In September 2014, Mr. Evanson responded to my email and informed me that Infinite would not settle pursuant to the terms of Summit's counter-proposal. Thus, pursuant to Mr. Evanson's instructions, Summit did not file the instant motion until it had undertaken further settlement negotiations with Infinite.

I declare all of the foregoing under the penalty of perjury under the laws of the United States of America.

Executed this 10th day of December, 2014 in Los Angeles, California.

/s/Paul A. Bost
Paul A. Bost

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that **PETITIONER AND COUNTERCLAIM-DEFENDANT SUMMIT ENTERTAINMENT, LLC'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR LEAVE TO AMEND; SUPPLEMENTAL DECLARATION OF PAUL A. BOST** is being transmitted electronically through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 10th day of December, 2014.

/s/Lynne Thompson _____

Lynne Thompson

CERTIFICATE OF SERVICE

I hereby certify that **PETITIONER AND COUNTERCLAIM-DEFENDANT SUMMIT ENTERTAINMENT, LLC'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR LEAVE TO AMEND; SUPPLEMENTAL DECLARATION OF PAUL A. BOST** is being deposited with the United States Postal Service, postage prepaid, first class mail, in an envelope addressed to Registrant:

R. Brett Evanson
EVANSON WEBER PLLC
2975 W. Executive Parkway, Suite 201
Lehi, UT 84043

on this 10th day of December, 2014.

/s/Lynne Thompson _____

Lynne Thompson

SMRH:435115566.1

EXHIBIT G

Paul Bost

From: Brett Evanson <brett@evansonweber.com>
Sent: Wednesday, April 30, 2014 9:21 AM
To: Paul Bost
Subject: RE: today's meeting

Paul:
No problem on re-scheduling. Things come up, and you have already provided me the same courtesy. Can you please give me some information about why you need to amend the petition to add your new claim at this point? Have you recently discovered new information that wasn't available to you at the time of the original filing? Just trying to understand why at this point there needs to be a change. That will help me make a decision on if I can grant your stipulation request.

Regards,

R. Brett Evanson
Attorney at Law
2975 W. Executive Parkway, Suite 201
Lehi, UT 84043
Tel: (801) 753-8084
Fax: (801) 407-1639
www.evansonweber.com
Email: brett@evansonweber.com



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From: Paul Bost [<mailto:PBost@sheppardmullin.com>]
Sent: Tuesday, April 29, 2014 3:13 PM
To: Brett Evanson
Subject: RE: today's meeting

Let's do Thursday morning at 9:30 a.m./10:30 a.m. Please be prepared to let me know if Infinite Jewelry will stipulate to the amendment of the petition for cancelation to add a claim for cancelation on the grounds that the registration is void ab initio. Thanks, and sorry for rescheduling at the last minute.

Paul Bost
Los Angeles | x12249
SheppardMullin

From: Brett Evanson [<mailto:brett@evansonweber.com>]
Sent: Tuesday, April 29, 2014 1:36 PM
To: Paul Bost
Subject: RE: today's meeting

Paul:
I have a packed schedule the rest of today and tomorrow. Can we bump it back until Thursday or Friday? I'm pretty flexible those days.

Regards,

R. Brett Evanson
Attorney at Law
2975 W. Executive Parkway, Suite 201
Lehi, UT 84043
Tel: (801) 753-8084
Fax: (801) 407-1639
www.evansonweber.com
Email: brett@evansonweber.com



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From: Paul Bost [<mailto:PBost@sheppardmullin.com>]
Sent: Tuesday, April 29, 2014 2:32 PM
To: Brett Evanson (brett@evansonweber.com)
Subject: today's meeting

Can you push back an hour? If not, are you available tomorrow morning? Thanks.

Paul Bost

310.228.2249 | direct
310.228.3960 | direct fax
PBost@sheppardmullin.com | [Bio](#)

SheppardMullin

Sheppard Mullin Richter & Hampton LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, CA 90067-6017
310.228.3700 | main
www.sheppardmullin.com

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EXHIBIT H

Paul Bost

From: Brett Evanson <brett@evansonweber.com>
Sent: Wednesday, May 07, 2014 11:28 AM
To: Paul Bost
Cc: Jill Pietrini; Beth Anderson
Subject: RE: Summit v. Infinite Jewelry - Leave to Amend Petition for Cancellation

Paul:
I apologize for being slow in responding. I was hoping to discuss this issue in greater detail with my client, but still have not been able to as a result of her health issues. As a result, I cannot stipulate to your request. I would suggest that prior to seeking leave to amend, you take the cost of that action, and include it in a settlement offer. I still believe we can resolve this matter without further litigation.

Regards,

R. Brett Evanson
Attorney at Law
2975 W. Executive Parkway, Suite 201
Lehi, UT 84043
Tel: (801) 753-8084
Fax: (801) 407-1639
www.evansonweber.com
Email: brett@evansonweber.com



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From: Paul Bost [<mailto:PBost@sheppardmullin.com>]
Sent: Tuesday, May 06, 2014 2:20 PM
To: Brett Evanson (brett@evansonweber.com)
Cc: Jill Pietrini; Beth Anderson
Subject: Summit v. Infinite Jewelry - Leave to Amend Petition for Cancellation

Brett:

On Thursday, May 1, 2014, we discussed Infinite Jewelry's willingness to enter a stipulation granting Summit leave to amend its petition for cancellation. I asked if you'd let me know by the end of that day Infinite's final position and you said you would. I have not heard from you since then. Please let me know Infinite's final position by 9 a.m. tomorrow morning. If Infinite will not stipulate, Summit will move for leave to amend and will take its attorneys' fees expended on any such motion into account when considering settlement of the parties' dispute. Thanks.

Paul Bost

310.228.2249 | direct
310.228.3960 | direct fax
PBost@sheppardmullin.com | [Bio](#)

SheppardMullin

Sheppard Mullin Richter & Hampton LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, CA 90067-6017
310.228.3700 | main
www.sheppardmullin.com

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