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

Proceeding	92059425
Party	Plaintiff Leonard Cocco
Correspondence Address	ANGELO NOTARO NOTARO MICHALOS & ZACCARIA PC 1270 BROADWAY, SUITE 807 NEW YORK, NY 10001-3224 UNITED STATES anotaro@notaromichalos.com, bcorsello@notaromichalos.com
Submission	Other Motions/Papers
Filer's Name	Angelo Notaro
Filer's e-mail	anotaro@notaromichalos.com
Signature	/J1259-002-AN/
Date	08/02/2014
Attachments	Opposition To EOT-J1259-002.pdf(556641 bytes) AN Decl-J1259-002.pdf(518063 bytes)

J1259-002

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

In the Matter of Trademark Registration No. 4,544,774
For the Mark: The Original Chimes
Date Registered: June 3, 2014

Leonard Cocco, Petitioner, v. Richard Mercado, Patrick DePrisco and John DOrta, Respondents.	Cancellation No. 92059425

Petitioner's Opposition To
<u>Respondents' Request For Extension of Time</u>

Petitioner Leonard Cocco, through his undersigned counsel, opposes Respondents' request for a sixty day extension to answer the Petition to Cancel.

Background

Petitioner commenced the present cancellation proceeding on June 24, 2014.

The "Petition To Cancel" seeks cancellation of United States Trademark Registration No. 4,544,774 for the service mark THE ORIGINAL CHIMES, registered in class 41, for services identified as: "Entertainment in the nature of Live Music Group." The registration is co-owned by Richard Mercado, Patrick DePrisco and John DOrta (collectively "Respondents").

As grounds for cancellation, the Petition To Cancel alleges Petitioner's priority of use of the trademarks and trade names "Lenny Cocco and the Chimes," "The Chimes" and Lenny and the Chimes" since 1959 and likelihood of confusion, false suggestion of connection, Respondents' fraud and non-use of the trademark The Original Chimes registered by the Respondents.

On June 25, 2014, the Board mailed an initial scheduling order (the "Scheduling Order") to Respondent John DOrta t/a The Original Chimes. The Scheduling Order set August 4, 2014 as the deadline for Respondents to answer the Petition To Cancel.

On July 31, 2014, Respondents filed a request for a sixty day extension of the time[1].

Applicable Law

A deadline to file an answer may be extended when a party seeking the extension demonstrates a good cause for doing so. *See* Fed. R. Civ. P. 6(b).

However, a motion for an extension of time is properly denied where the party requesting the extension does not set forth, with particularity, facts that constitute good cause. *See Fairline Boats plc v. The New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000).

Mere conclusory allegations lacking in factual detail are not sufficient. *Id.*; *SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372, 1373 (TTAB 2001) (opposers had not come forward with "detailed facts" required to carry their burden explaining their inaction); *Instruments SA Inc. v. ASI Instruments Inc.*, 53 USPQ2d 1925, 1927 (TTAB

[1] Respondents did not serve the request. The filing of the request was detected by Petitioner in the TTABVUE electronic database.

1999) (cursory or conclusory allegations that were denied unequivocally by the non-movant and were not otherwise supported by the record did not constitute a showing of good cause); *Luemme, Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758, 1760-61 (TTAB 1999) (sparse motion contained insufficient facts on which to find good cause); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) ("the presentation of one's argument and authority should be presented thoroughly in the motion or the opposition brief thereto.").

Respondents, as the moving party, have the burden of persuading the Board that they were diligent in meeting their responsibilities. *National Football League v. DNH Management LLC,* 85 USPQ2d 1852, 1854 (TTAB 2008).

Argument

Here, Respondents fail to satisfy the good cause standard. The answer of Respondents was due on August 4, 2014. Respondents do not indicate that they were unaware of the deadline. Respondents, nevertheless, now ask the Board to extend the deadline to answer so that their answer will not be due until October 4th, some 100 days after the filing of the petition, thereby more than doubling their time to answer to the Petition To Cancel.

Respondents rely on the following as an explanation for the requested extension of time:

> I have spoken to three attorneys on this matter and they do not handle this type of law. I was reffered [sic] to another attorney who does handle this type of law but he is not available to consult with untill [sic] next week.

The sparse information provided by Respondents does not set forth detailed facts, with particularity, that adequately meets their burden to either explain their inaction or explain and justify their request that the deadline to answer be extended by sixty days. The provided explanation is not even conclusory, leaving the Petitioner and the Board to infer, surmise and speculate as to how these unspecific and unaverred statements caused delay, and demonstrate diligence and good cause justifying the grant of the extraordinarily long extension of time requested by Respondents.

The statements, moreover, do not withstand close scrutiny.

Respondents do not identify the counsel with whom they purport to have spoken. They have not provided dates. They do not state when such conversations took place. They do not explain why, if true, they consulted not one, not two, but three attorneys - all purportedly not versed in trademark law – before deciding to confer with a trademark lawyer, after the deadline to answer to justify their delay. They have not provided any basis for concluding that a further consultation will lead to a timely answer. Respondents also do not even attempt to explain or justify their arbitrary selection of October 4th as a new deadline to answer the Petition To Cancel.

Simply stated, Respondents' statements do not provide specific facts either explaining why they did not answer the petition during the forty days allotted by the Scheduling Order and do not evidence diligence on their part. Further, failure to engage counsel in a timely manner does not demonstrate good cause. *See, for example, Splawn v. Zavala*, 652 S.W.2d 578, 579 (Tex. App. Austin 1983) (finding that difficulty in securing assistance of counsel not a reasonable explanation to justify extension).

In fact, in this case, Respondents are and have been in a better position to timely

answer than most respondents in a cancellation proceeding. On January 23, 2014, Respondents were notified of Petitioner's rights, false statements in their application and given an opportunity to withdraw their application (Notaro Decl. ¶¶ 2-3, Exh. A).[2] At that time, they could have conferred with counsel and presumably investigated the facts. A prudent respondent could and would have engaged trademark counsel when they were explicitly placed on notice of Petitioner's rights. Instead, Respondents choose to ignore the demands and proceeded to perpetuate the bad acts complained of in the Petition To Cancel. *Id.*

In sum, Respondents have not shown that they undertook specific steps to timely answer the petition. They have not shown that the request for an extension is not in consequence of their own malfeasance, carelessness, inattention, indifference or disregard of the process. They have not shown that an extension is warranted due to the consequence of some unexpected or unavailable situation or due promises made by the adverse party. To the contrary, their conduct evidences what Petitioner can only assume is their true intent - to stall this proceeding.

While the courts recognize the need to provide special accommodation to parties who proceed in litigation without the benefit of counsel, such parties are not relieved of the obligations to comply with scheduling orders and conduct themselves responsibly in the litigation.

It is not unusual to have the passage of time benefit one party to litigation and harm the other. However, it is incumbent upon the Board to manage cases in a way that fosters

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[2] "Notaro Decl." refers to the accompanying declaration of Angelo Notaro which Petitioner submits in support of its opposition to Respondents' extension request.

prompt determinations; to grant extensions of time only if all parties consent or if the enlargement of time is permitted by applicable law, justified by the circumstances and appears to be necessary to a fair adjudication; and to be vigilant about prohibiting parties from creating intentional delay in order to advance their own goals or in some way harm their adversary. The Respondents are using their trademark registration to cast uncertainty on the legitimacy and legality of Petitioner's use of his performing group's name which is employed in connection with commercially rendered services in the marketplace for some fifty years. The existence of the registration clouds Petitioner's plans, adversely affects the value and viability of his name, the ability to obtain bookings and inhibits his use thereof in rendering his services. An expeditious resolution of the cancellation is needed to remove this uncertainty. Consequently, delays in this proceeding will prejudice Petitioner.

If the Board were to grant the Respondents' motion for additional time to respond, the proceedings here would, inevitably, be further delayed. Such a delay is not warranted.

The Board's scheduling order is exceedingly clear. The Board should not relieve a party of a manageable deadline absent a truly emergent situation that warrants relaxation of a reasonable schedule. The Respondents failure to retain counsel until after the expiration of the time to answer the petition is a consequence of their own choices and inactions and has already had the effect of delaying these proceedings.

The Board should deny Respondent's request for an extension of time to answer the Petition. Respondents failed to demonstrate good cause (although it is their burden to do so) and, instead, request an incredibly long extension for an additional sixty days without any demonstrated need showing good cause. Respondents provide no explanation why, given that they have had notice of Petitioner's rights, they could not

answer within the prescribed deadline. Meanwhile, Respondents continue to competitively injure Petitioner, under the guise of the registration at issue, through continued misstatements of ownership rights to the industry in which the Petitioner renders his services. Even if the Board sees fit to grant Respondents' request, it should not give them until October 4th to respond. The request for a sixty day extension is clearly excessive.

Respondents' answer should be immediately due.

Conclusion

For these reasons, Respondents fail to show good cause. The Board should deny Respondents request or, in the alternative, order them to immediately answer.

Dated: August 2, 2014

Respectfully submitted,

NOTARO, MICHALOS & ZACCARIA P.C.

/s/ Angelo Notaro

Angelo Notaro
anotaro@notaromichalos.com
John Zaccaria
jzaccaria@notaromichalos.com
Bradley S. Corsello
bcorsello@notaromichalos.com
1270 Broadway, Suite 807
New York, NY 10001-3224
(212) 278-8600

Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **Petitioner's Opposition To Respondent's Request For Extension of Time** has been served on Respondents, by mailing said copy on August 2, 2014 via First Class Mail, postage prepaid, to:

John DOrta
t/a The Original Chimes
54 Windermere Dr.
Holbrook, New York 11741

Pharah Miranda

J1259-002

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

In the Matter of Trademark Registration No. 4,544,774
For the Mark: The Original Chimes
Date Registered: June 3, 2014

Leonard Cocco, Petitioner, v. Richard Mercado, Patrick DePrisco and John DOrta, Respondents.	Cancellation No. 92059425

Declaration of Angelo Notaro

Angelo Notaro, declares that:

1. I am an attorney with the law firm of Notaro, Michalos & Zaccaria P.C., which maintains an office at 1270 Broadway, Suite 807, New York, New York 10001-3224, and represent Leonard Cocco, Petitioner in the above-captioned matter.
2. Attached hereto as Exhibit A is a true and correct copy of a letter which I sent to each of the Respondents, Richard Mercado, Patrick DePrisco and John DOrta, on January 23, 2014, by certified mail, return receipt requested, with copies of the postal return receipts evidencing delivery.
3. I did not receive a response to the letter shown in Exhibit A from any of the respondents, nor was I otherwise ever contacted by any of the Respondents or

any person representing the Respondents with respect to the letter or the matters set forth therein.

I hereby declare under penalty of perjury that the foregoing is true and correct. Executed on the 2nd day of August, 2014.

Angelo Notaro

Angelo Notaro

Exhibit A

LAW OFFICE
NOTARO, MICHALOS & ZACCARIA P.C.

ANGELO NOTARO
PETER C. MICHALOS
JOHN ZACCARIA
NADER A. ABADIR
BRADLEY S. CORSELLO
AARON MILLER

PATENTS
TRADEMARKS
COPYRIGHTS

OF COUNSEL
FRANK J. COLUCCI
MILTON WOLSON

January 23, 2014

Via Certified Mail
Return Receipt Requested

Mr. John Dorta
54 Windmere Dr.
Holbrook, NY 11741-5614
(RRR No. 7099 3220 0006 5124 7669)

Mr. Patrick DePrisco
1531 Glendale Ave. NW
Palm Bay, FL 32907
(RRR No. 7099 3220 0006 5124 7683)

Mr. Richard Mercado
4 Snowdance Lane
Nesconset, NY 11767
(RRR No. 7099 3220 0006 5124 7690)

Re: Cease & Desist Demand
Our Ref. J1259-001

Dear Messrs. Dorta, Deprisco & Mercado:

We are writing to you on behalf of our clients, Leonard M. Cocco. Mr. Cocco has, since the 1950s, used and owns The Chimes, Lenny Cocco & The Chimes, The Original Chimes and Lenny Cocco & The Original Chimes as common law trademarks identifying doo-wop musical group services.

As a result of the long and continuous use of Mr. Cocco, the Chimes trademarks possess significant goodwill, are of great value to Mr. Cocco and are well known in the doo-wop genre as identifying Mr. Cocco and doo-wop group musical services emanating from Mr. Cocco.

It has recently come to our client's attention that despite actual knowledge of our client and his long use of the Chimes trademarks, you have filed an intent-to-use United States trademark application to register "The Original Chimes" as a service mark for entertainment in the nature of a live musical group. The application falsely states that no other person is known to have the right to use the mark for such services despite the warning that "willful false statement and the like so made are punishable" under 18 U.S.C. §1001. Further, you and/or persons acting on your behalf are intentionally, knowingly, and

1270 Broadway, Suite 807, New York, NY 10001-3224 • Tel: (212) 278-8600 • Fax: (212) 278-8687
100 Dutch Hill Road, Orangeburg, NY 10962-2107 • Tel: (845) 359-7700 • Fax: (845) 359-7798
nmpc@notaromichalos.com • www.notaromichalos.com

without reasonable justification, unfairly competing, slandering and interfering with the business of our client by falsely informing others that you own, have a court order or have issued a cease and desist demand against our client's use of the Chimes trademarks.

Your activities constitute unfair competition, false and deceptive acts and practices, fraud, slander and civil conspiracy in violation of federal and state laws.

We demand on behalf our client that you:

1. Cease and desist from any further claims that you own any of the Chimes trademarks and discontinue any and all use of, or plans to use, the Chimes trademarks.

2. Immediately withdraw your U.S. trademark application for registration of The Original Chimes.

3. Cease and desist from communicating with persons with whom our client has business or prospective business relationships, and discontinue any and all claims that you have obtained a court order or have the right to otherwise cause our client to refrain from use of any of the Chimes trademarks.

4. Confirm in writing that you will do so by no later than Thursday, January 30 2014.

Our client fully reserves all of his rights, without prejudice, in the absence of a prompt and satisfactory resolution of this matter as set forth above. This letter is not intended to be a complete recitation of our client's rights. We reserve the right to modify and amend the claims contained herein, and to assert other claims that may not have been asserted herein.

We look forward to receiving a prompt response from either you or your attorney.

Very truly yours,

Notaro, Michalos & Zaccaria P.C.

Angelo Notaro

Angelo Notaro

AN:aae

U.S. Postal Service
CERTIFIED MAIL RECEIPT
(Domestic Mail Only; No Insurance Coverage Provided)

7099 3220 0006 5124 7669

Article Sent To:

Postage	$ .46
Certified Fee	3.10
Return Receipt Fee (Endorsement Required)	2.55
Restricted Delivery Fee (Endorsement Required)	
Total Postage & Fees	$ 6.11

Postmark Here

USPS JAN 23 2014 ORANGEBURG, NY 10962

Name (Please Print Clearly) (to be completed by mailer)
Mr. John Dorta
Street, Apt. No.; or PO Box No.
54 Windmere Drive
City, State, ZIP+ 4
Holbrook, NY 11741-5614

PS Form 3800, July 1999 See Reverse for Instructions

SENDER: *COMPLETE THIS SECTION*

- Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.
- Print your name and address on the reverse so that we can return the card to you.
- Attach this card to the back of the mailpiece, or on the front if space permits.

1. Article Addressed to:

Mr. John Dorta
54 Windmere Drive
Holbrook, NY 11741-5614

COMPLETE THIS SECTION ON DELIVERY

A. Signature
X ☐ Agent ☐ Addressee

B. Received by (Printed Name) JANE
C. Date of Delivery 1/23

D. Is delivery address different from item 1? ☐ Yes
If YES, enter delivery address below: ☐ No

3. Service Type
☒ Certified Mail ☐ Express Mail
☐ Registered ☐ Return Receipt for Merchandise
☐ Insured Mail ☐ C.O.D.

4. Restricted Delivery? *(Extra Fee)* ☐ Yes

2. Article Number
(Transfer from service label) 7099 3220 0006 5124 7669

PS Form 3811, February 2004 Domestic Return Receipt 102595-02-M-1540

U.S. Postal Service
CERTIFIED MAIL RECEIPT
(Domestic Mail Only; No Insurance Coverage Provided)

7099 3220 0006 5124 7683

Article Sent To:

Postage	$ .46
Certified Fee	3.10
Return Receipt Fee (Endorsement Required)	2.55
Restricted Delivery Fee (Endorsement Required)	
Total Postage & Fees	$ 6.11

ORANGE
JAN 2 2 2008
Postmark Here

Name (Please Print Clearly) (To be completed by mailer)
Mr. Patrick DePrisco
Street, Apt. No.; or PO Box No.
1531 Glendale Ave. NW
City, State, ZIP+ 4
Palm Bay, FL 32907

PS Form 3800, July 1999 — See Reverse for Instructions

SENDER: *COMPLETE THIS SECTION*

- Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.
- Print your name and address on the reverse so that we can return the card to you.
- Attach this card to the back of the mailpiece, or on the front if space permits.

1. Article Addressed to:

Mr. Patrick DePrisco
1531 Glendale Ave, NW
Palm Bay, FL 32907

COMPLETE THIS SECTION ON DELIVERY

A. Signature
X Frances DePrisco ☐ Agent ☐ Addressee

B. Received by *(Printed Name)* FRANCES DEPRISCO
C. Date of Delivery 1.22.08

D. Is delivery address different from item 1? ☐ Yes
If YES, enter delivery address below: ☐ No

3. Service Type
☒ Certified Mail ☐ Express Mail
☐ Registered ☐ Return Receipt for Merchandise
☐ Insured Mail ☐ C.O.D.

4. Restricted Delivery? *(Extra Fee)* ☐ Yes

2. Article Number
(Transfer from service label) 7099 3220 0006 5124 7683

PS Form 3811, February 2004 Domestic Return Receipt 102595-02-M-1540

U.S. Postal Service
CERTIFIED MAIL RECEIPT
(Domestic Mail Only; No Insurance Coverage Provided)

7099 3220 0006 5124 7690

Article Sent To:

ORANGE

Postage	$ .46
Certified Fee	3.10
Return Receipt Fee (Endorsement Required)	2.55
Restricted Delivery Fee (Endorsement Required)	
Total Postage & Fees	$ 6.11

ORANGEBURG NY 10962
JAN 23 2014

Postmark Here

Name (Please Print Clearly) (To be completed by mailer)
Mr. Richard Mercado
Street, Apt. No.; or PO Box No.
4 Snowdance Lane
City, State, ZIP+4
Nesconset, NY 11767

PS Form 3800, July 1999 See Reverse for Instructions

SENDER: COMPLETE THIS SECTION

- Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.
- Print your name and address on the reverse so that we can return the card to you.
- Attach this card to the back of the mailpiece, or on the front if space permits.

1. Article Addressed to:

Mr. Richard Mercado
4 Snowdance Lane
Nescon, NY 11767

COMPLETE THIS SECTION ON DELIVERY

A. Signature
X R MERCADO ☐ Agent ☐ Addressee

B. Received by (Printed Name) R Mercado
C. Date of Delivery 1-25-14

D. Is delivery address different from item 1? ☐ Yes
If YES, enter delivery address below: ☐ No

3. Service Type
☒ Certified Mail ☐ Express Mail
☐ Registered ☐ Return Receipt for Merchandise
☐ Insured Mail ☐ C.O.D.

4. Restricted Delivery? (Extra Fee) ☐ Yes

2. Article Number
(Transfer from service label) 7099 3220 0006 5124 7690

PS Form 3811, February 2004 Domestic Return Receipt 102595-02-M-1540

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **Declaration of Angelo Notaro** and **Exhibit A** thereto have been served on Respondents, by mailing said copy on August 2, 2014 via First Class Mail, postage prepaid, to:

John DOrta
t/a The Original Chimes
54 Windermere Dr.
Holbrook, New York 11741

Pharah Miranda