

ESTTA Tracking number: **ESTTA752098**

Filing date: **06/13/2016**

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

Proceeding	92062380
Party	Plaintiff D.B.C. Corporation
Correspondence Address	CARLA C CALCAGNO CALCAGNO LAW 2101 L STREET NW, SUITE 400 WASHINGTON, DC 20037 UNITED STATES cccalcagno@gmail.com
Submission	Other Motions/Papers
Filer's Name	Carla C. Calcagno
Filer's e-mail	cccalcagno@gmail.com,trademarks@canopyparalegal.com
Signature	/Carla C. Calcagno/
Date	06/13/2016
Attachments	Petitioner Motion to SUSPEND AND EXTEND.pdf(64273 bytes)

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

D.B.C. Corporation,)	
)	
Petitioner)	
)	
v.)	Cancellation Nos.: 92062379
)	and 92062380
Nucita Venezolana C.A.,)	
)	
Defendant)	

**PETITIONER’S MOTION SUSPEND PENDING
DISPOSITION OF PETITIONER’S MOTION TO AMEND,
AND THEREAFTER TO EXTEND DISCOVERY BY
FORTY-FIVE DAYS**

Pursuant to Rule 6 of the Federal Rules of Civil Procedure and the Trademark Rules of Practice, Petitioner moves the Board to suspend this case, and to extend discovery for forty-five days once proceedings are resumed.

As good cause for this motion, Petitioner cites the following:

On today’s date, June 13, 2016, Petitioner has filed a Motion to Amend and to Consolidate these proceedings. The facts pertaining to those motions are articulated in the briefs supporting those motions. While Petitioner believes, based on the representations of prior counsel, that Respondent consents to these motions and to discuss ACR as noted below, Petitioner has been unable to obtain Respondent’s new counsel’s attendance to a phone conversation with the undersigned regarding this and other matters despite several attempts in the two weeks since new counsel appeared. And until these motions and ACR are resolved, Petitioner cannot proceed correctly to trial.

Specifically, on May 18, 2016, Respondent’s counsel sent the undersigned an

email providing his written consent to the Motion to Amend, which Petitioner had requested long prior to that email. In that email, Respondent first also indicated a willingness to discuss ACR, which Petitioner had suggested in their discovery conference on these cases. A true and accurate copy of that email is set forth below:

From: Justin R. Young [<mailto:jyoung@dineff.com>]
Sent: Wednesday, May 18, 2016 5:09 PM
To: cccacagno@gmail.com; trademarks@canopyparalegal.com
Cc: 'Carla Calcagno'; sent@dineff.com
Subject: Cancellation Proceedings Nos. 92062379 and 92062380 - Our Ref.: OT1148US30 & OT1147US3

Dear Carla:

I am writing in relation to the above referenced cases.

1. As you may recall, I had inquired earlier if your clients were willing to consent to the consolidation of the proceedings and you had indicated that your clients will consent to and file the consolidation provide that my clients consented to tan amendment of the petitions to plead in the issuance of DBC mark CREME DE PIROULINE. I hereby confirm that my clients do consent to the amendment and consolidation of the petitions. In view of this, please let me know if you want to file a consented motion to amend and consolidate the petitions or if you prefer to proceed differently.
2. Also, we had briefly discussed during the discovery conference the possibility of processing these cases via Accelerated Case Resolution (ACR). I would like to request that your clients give serious consideration to using ACR, once the cases have been consolidated, as it should allow the parties to greatly reduce costs and streamline the proceeding. We can work together setting up limitations to discovery and establishing stipulations as to fact that would greatly reduce the scope of litigation; we can also establish simpler means of introducing evidence and testimony (i.e. by declarations/affidavits attached to briefs) and we can set up the ACR proceeding to be conducted, for instance, as if proceeding on summary judgment. If interested, I can send you a draft Joint Stipulation to elect ACR for your review.

I look forward to hearing from you regarding the aforementioned two issues.

Best regards,

Justin R. Young
Licensed to practice Law in New York and Paraguay

As this consent was received less than two business days before the undersigned (and

opposing counsel) left for INTA and one week prior to the undersigned counsel moving her offices, the undersigned on May 19, 2016 agreed and notified Respondent's prior counsel that the Motions to Amend and Consolidate would be filed after both counsel returned. Respondent agreed, and undertook to send the proposed ACR stipulation to Petitioner and to set up a call to discuss that ACR stipulation the week after INTA that is the first week of June. See, the complete record of counsel communications attached as Exhibit A to this Motion:

Before that call could occur however, on May 20, 2016, the undersigned received a Notice of Appearance from an alleged new counsel for Respondent. This Notice however did not bear proof of service on either prior counsel for Respondent or the Respondent. Further, this appearance seemed quite inconsistent with the prior communications between counsel of record.

On May 27, 2016, in response to the undersigned inquiries, the prior counsel advised that after checking with his client that day, he had confirmed that he had just received instructions that he no longer represented the Respondent. See Exhibit A.

On that same date, the undersigned sent an email to both prior and current counsel for Respondent advising them that the undersigned intended to represent to the Board that Respondent had consented to this portion of the Motion (and other matters) unless new counsel advised otherwise. No response from new counsel was received.

In response, prior counsel represented that he has advised his prior client of inter alia the agreements on the motion to amend, to consolidate and to engage in good faith discussions regarding ACR. See Exhibit A. However, not proposed ACR Stipulation has been received.

Since then, Petitioner has tried on several occasions to arrange a call with new

counsel to confirm their continuing consent to the Motions, to confirm the acceptability of email service, and to discuss whether Respondent still intended to discuss and send a stipulation as to ACR. Finally, a time was confirmed for counsel to speak today, but the undersigned was advised today that this call had to be cancelled as Respondent's counsel was out of town. Further, rather than sending a proposed ACR draft to the undersigned as promised, Respondent on Friday June 10, 2016 instead sent the undersigned counsel a first set of discovery requests directed to Petitioner. This again seems inconsistent with a proposed discussion of ACR.

For the information of the Board, this is not the first dispute between the parties relating to Respondent's attempted registration of marks confusingly similar to Petitioner's PIROU formative marks, including PIROULINE.

Petitioner pleads ownership of registrations and prior use of a well-known series of PIROU formative marks, including the marks PIROULINE and CRÈME DE PIROULINE for rolled wafers. Despite these prior rights and registrations, prior to the cases now at bar, Respondent registered the mark PIRULIN for the same goods.

On June 4, 2013, Petitioner filed a cancellation proceeding against that registration based on Petitioner's prior and superior rights in its PIROULINE mark based on Section 2(d) of the Lanham Act. The Board entered judgment in that case against Respondent on March 4, 2015. See, TTABVUE Cancellation No. 92057303, Docket No. 21.

Well after receiving this judgment on March 4, 2015, Respondent filed to register the PIRUCREAM marks presently at issue for the same goods as Petitioner's.

Thus, this case does as suggested by Petitioner's counsel in the initial discovery conference and acknowledged by Respondent's counsel in his May 18 email, seem

suitable to some form of reduced discovery and testimonial requirements if the parties stipulate to at least some facts, such as priority and the nature of the goods and consumers, that are in fact well-known by both parties.

The Board also should note that as Respondent's prior counsel was aware, discovery disputes Petitioner had issues with Respondent's answers and objections to Petitioner's discovery. If these were not resolved by ACR, Petitioner will need to move to compel answers to create a proper evidentiary record for trial.

In light of the above, Respondent's position on the Motion to Amend, to Consolidate and ACR is highly material to the remainder of the case and unclear. In the meantime, however, expert disclosures are due today, and discovery is scheduled to close on July 11, 2016. If the parties do not reduce the issues by engaging in ACR, Petitioner will need additional time to complete discovery.

As further good cause for this motion, Petitioner's counsel notes that she moved her offices on May 23, 2016 which caused substantial expenditure of time and effort, in the weeks directly prior to INTA. And, under the current schedule the July 4 holiday occurs one week prior to the close of discovery and Petitioner's counsel has plans for vacation that week. These events further erode the available time for discovery.

This motion is not filed for delay and is the first extension that Petitioner has sought in this proceeding.

Wherefore, Petitioner respectfully requests that the Board grant this Motion to Suspend and to Extend. If granted, Petitioner respectfully requests that the Board suspend this Case pending disposition of the Motions to Amend and to Consolidate, and once proceedings resume to reset the close of discovery by 45 days, including the parties' time to serve expert disclosures.

Dated June 13, 2016

Respectfully submitted,

By: /Carla C. Calcagno/
Carla C Calcagno, Esq.
Janet G Ricciuti, Esq.
Calcagno Law PLLC
2101 L Street, N.W.
Suite 400
Washington, D.C. 20037
Telephone: (202) 466-0544

CERTIFICATE OF SERVICE

I hereby certify that pursuant to Trademark Rule 2.119(d), a true copy of the foregoing:

**PETITIONER'S MOTION TO SUSPEND AND TO EXTEND AND EXHIBIT
A**

was served this 13th day of June on Registrant's counsel of record at the address identified in the records of the United States Patent and Trademark Office, via first class mail, postage prepaid, to:

Chris Sanchelima
SANCHELIMA &
ASSOCIATES PA
234 SW LEJEUNE
ROAD MIAMI, FL
33134

with a courtesy copy by email to chris@sanchelima.com

/Carla C. Calcagno/

EXHIBIT A

From: Justin R. Young [mailto:jyoung@dineff.com]
Sent: Friday, May 27, 2016 4:53 PM
To: 'Carla Calcagno'
Cc: 'Jessica Pedroza'; jesus@sanchelima.com; sent@dineff.com
Subject: RE: Cancellation Proceedings Nos. 92062379 and 92062380 - DBC v NUCITA

Dear Carla:

Please note that I have received confirmation that I no longer represent Registrant.

Rest assured that I had already conveyed to Registrant's representatives our prior discussions, including our agreement to amending the petitions and consolidating the proceedings, as well as agreement to engage in good faith discussions to use ACR in this case.

Please direct all future correspondence on the above referenced cases directly to Mr. Sanchelima.

Best regards,

Justin R. Young
Licensed to practice Law in New York and Paraguay

From: Carla Calcagno [mailto:carla.calcagno@calcagnolaw.com]
Sent: Friday, May 27, 2016 3:41 PM
To: jyoung@dineff.com; jesus@sanchelima.com
Cc: Jessica Pedroza
Subject: FW: Cancellation Proceedings Nos. 92062379 and 92062380 - DBC v NUCITA

Dear Justin and Jesus

I am unsure as to who is, as of today's date, representing Nucita Venezolana in this case. However, in accordance with the authorization given by Mr. Young, the sole attorney acting on behalf of Nucita on May 19, 2016, I am filing the consented motion to extend discovery by thirty days. These are courtesy copies of the motions. Please note that this consent was given before the notice of appearance was filed by Sanchelima and associates.

Please note that I plan on filing the motion to amend and to consolidate by close of business on Tuesday May 31, 2016. Unless I hear otherwise I will style that as a consented motion. In any event I will note that Mr. Young consented to those motions prior to the new representation, and it is our position that Nucita is bound by that – and that good cause for those motions exist in any event.

I am available for a call once the question of representation is clarified. Could you both confer and send me an email confirming who is the attorney of record in this case? I ask as the notice of appearance was not served on Nucita as is usually required to change the

attorney of record per the TBMP.

WE ARE MOVING, EFFECTIVE MAY 23, 2016 . PLEASE NOTE OUR NEW OFFICE ADDRESS:

Calcagno Law PLLC
2101 L Street N.W.
Suite 400
Washington, D.C. 20037
Tel: 202 466-0544
Fax: 866 400 8464
carla.calcagno@calcagnolaw.com

From: Justin R. Young [<mailto:jyoung@dineff.com>]
Sent: Friday, May 27, 2016 11:34 AM
To: 'Carla Calcagno'; cccagno@gmail.com; trademarks@canopyparalegal.com
Cc: sent@dineff.com
Subject: RE: Cancellation Proceedings Nos. 92062379 and 92062380 - Our Ref.: OT1148US30 & OT1147US3

Hi Carla:

I just got back from INTA and learned that a new attorney has made an appearance on behalf of the registrant in the above referenced cases. I have not received any instructions from my clients so I do not know what is going on.

I will touch basis with you once I hear from them but it looks like you will have to deal with new counsel for registrant in these matters. I would still recommend consolidation of proceedings and adopting ACR, but it is something that you will have to check with the registrant's new counsel.

Best regards,

Justin R. Young
Licensed to practice Law in New York and Paraguay

From: Justin R. Young [<mailto:jyoung@dineff.com>]
Sent: Thursday, May 19, 2016 12:42 PM
To: 'Carla Calcagno'; cccagno@gmail.com'; trademarks@canopyparalegal.com'
Cc: sent@dineff.com'
Subject: RE: Cancellation Proceedings Nos. 92062379 and 92062380 - Our Ref.: OT1148US30 & OT1147US3

Dear Carla:

Thank you for your prompt response. We consent to a one month extension of the close of discovery and all remaining dates.

If you don't mind, I will send you the proposed ACR stipulation upon my return from INTA. We can set up a conference call shortly afterwards.

Best regards,

Justin R. Young
Licensed to practice Law in New York and Paraguay

From: Carla Calcagno [<mailto:carla.calcagno@calcagnolaw.com>]
Sent: Thursday, May 19, 2016 11:34 AM
To: jyoung@dineff.com; cccagno@gmail.com; trademarks@canopyparalegal.com
Cc: sent@dineff.com
Subject: RE: Cancellation Proceedings Nos. 92062379 and 92062380 - Our Ref.: OT1148US30 & OT1147US3

Dear Justin

Thank you for the note. First please note the change of address below. I will file a formal change of address with the TTAB shortly.

Second, thank you for your email below. As I am sure you know, INTA is this week, which I am scheduled to attend. To allow us time to consider the ACR proposal and to discuss, please send over a proposal and let's set a time to speak at the end of next week. I will then be able to confer with my client.

Meantime in light of this, to allow us time to consider your proposal, please let me know if your client will stipulate to a one extension month of the close of discovery and all remaining dates.

With kindest regards

Carla

WE ARE MOVING, EFFECTIVE MAY 23, 2016 . PLEASE NOTE OUR NEW OFFICE ADDRESS:

Calcagno Law PLLC
2101 L Street N.W.
Suite 400
Washington, D.C. 20037
Tel: 202 466-0544
Fax: 866 400 8464
carla.calcagno@calcagnolaw.com

From: Justin R. Young [<mailto:jyoung@dineff.com>]
Sent: Wednesday, May 18, 2016 5:09 PM

To: cccacagno@gmail.com; trademarks@canopyparalegal.com

Cc: 'Carla Calcagno'; sent@dineff.com

Subject: Cancellation Proceedings Nos. 92062379 and 92062380 - Our Ref.: OT1148US30 & OT1147US3

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1. As you may recall, I had inquired earlier if your clients were willing to consent to the consolidation of the proceedings and you had indicated that your clients will consent to and file the consolidation provide that my clients consented to tan amendment of the petitions to plead in the issuance of DBC mark CREME DE PIROULINE. I hereby confirm that my clients do consent to the amendment and consolidation of the petitions. In view of this, please let me know if you want to file a consented motion to amend and consolidate the petitions or if you prefer to proceed differently.
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Best regards,

Justin R. Young

Licensed to practice Law in New York and Paraguay