

ESTTA Tracking number: **ESTTA1001986**

Filing date: **09/14/2019**

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

Proceeding	92070278
Party	Defendant Poste Premier, LLC
Correspondence Address	ILARIA MAGGIONI SILLS CUMMIS & GROSS PC 101 PARK AVENUE, 28TH FLOOR NEW YORK, NY 10178 UNITED STATES pto@sillscummis.com, imaggioni@sillscummis.com, sseuradge@sillscummis.com, malmonte@sillscummis.com, emarcus@sillscummis.com, lmkonkel@michaelbest.com, mkeipdock- et@michaelbest.com 212-643-7000
Submission	Motion to Compel Discovery or Disclosure
Filer's Name	Ilaria Maggioni
Filer's email	pto@sillscummis.com, imaggioni@sillscummis.com, sseuradge@sillscummis.com, malmonte@sillscummis.com, emarcus@sillscummis.com, lmkonkel@michaelbest.com, mkeipdock- et@michaelbest.com
Signature	/Ilaria Maggioni/
Date	09/14/2019
Attachments	Motion to Compel Initial Disclosures.pdf(11899 bytes ) Exhibit A.pdf(176716 bytes )

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

Office Holdings Limited,

Petitioner,

-against-

Poste Premier, LLC,

Respondent.

Cancellation No.: 92070278

**RESPONDENT’S MOTION TO COMPEL INITIAL DISCLOSURES**

**I. Introduction**

Pursuant to TBMP §523, Respondent, Poste Premier, LLC (“Respondent”) hereby moves the Board for an Order (1) compelling Office Holdings Limited, (“Petitioner”) to serve its Initial Disclosures on Respondent, and (2) suspending this cancellation proceeding with respect to all matters not germane to the motion, pursuant to 37 CFR §2.120 (f), including granting a corresponding extension of all discovery and testimony periods, until non-compliance has been remedied. This motion is timely pursuant to TBMP §523.03, as the Petitioner’s deadline to serve Initial Disclosures was August 16, 2019 (as set by the Board’s Order dated July 16, 2019), and Petitioner to date has not served its Initial Disclosures on Respondent. Respondent’s counsel has met the required good faith obligations pursuant to TBMP §523.02, as set forth herein.

## **II. History of Proceedings To Date**

Petitioner filed a Petition for Cancellation in this proceeding on January 2, 2019. Respondent filed its Answer on February 13, 2019. Counsel for the respective parties held a discovery conference on or about March 13, 2019. Thereafter, the parties engaged in settlement negotiations and, subject to the Board's approval, stipulated to extend the case discovery and trial dates to explore prospects of settlement, until settlement talks reached an impasse.

During suspension, the parties exchanged settlement terms, but could not reach a mutually-agreeable resolution. Proceedings resumed on July 15, 2019, with Initial Disclosures due by July 16, 2019 (as set by Board's Order dated June 14, 2019). Respondent served its Initial Disclosures on Petitioner on July 16, 2019. However, the same day upon Petitioner counsel's request, Respondent consented to an additional 30-day motion to extend the case deadlines (including Petitioner's deadline to file Initial Disclosures) while the parties continued efforts to find common ground for settlement. The Board approved the stipulated extension by Order dated July 16, 2019 setting the time for serving Initial Disclosures on August 16, 2019. During the month of August 2019, the parties continued to communicate on the possibility of settlement, however on or about August 15, 2019 it became clear that the parties were too far apart for a dispositive resolution. The proceedings resumed on August 15, 2019, with Petitioner's Initial Disclosures being due on August 16, 2019. As detailed below, in an effort to avoid undue motion practice and expenses to carry on proceedings that Petitioner seems not inclined to prosecute, Respondent's counsel reached out to Petitioner's counsel stating that it did not receive the mandatory disclosures and asked whether Petitioner had lost

interest or intends to pursue this case. To date, Respondent has received no response to these inquiries and no Initial Disclosures from Petitioner.

### **III. Good Faith Effort to Resolve Issue**

Respondent's counsel has made good faith efforts to resolve the outstanding issue with Petitioner's counsel as required by 37 CFR §2.120(f) and TBMP §523.02, to no avail. In particular, after proceedings resumed, on August 20, 2019 Respondent's counsel emailed Petitioner's counsel advising that it did not receive Petitioner's Initial Disclosures by the deadline August 16, 2019 and asking whether Petitioner was no longer interested to pursue the cancellation proceeding. Respondent's counsel received no response.

On September 10, 2019, in a good faith effort to avoid filing this motion, with the deadline to compel approaching, Respondent's counsel contacted again Petitioner's counsel and asked whether Petitioner intended to serve the disclosures and continue the proceedings and discovery, and expressly advised Petitioner's counsel that absent response or action from Petitioner, Respondent would move to compel. *See* copies of emails dated August 20, 2019 and September 10, 2019 attached as Exhibit A hereto.

Respondent's counsel has, therefore, been diligent in its attempts to resolve the impasse with Petitioner's counsel. On the contrary, to date, Petitioner has neither acknowledged nor made any attempt to address the issues raised by Respondent's counsel.

### **IV. Conclusion**

Consequently, for all of the foregoing reasons, Respondent respectfully requests the Board issue an Order: (1) compelling Petitioner to serve its Initial Disclosures on Respondent, and (2) suspending this cancellation proceeding with respect to all matters not germane to the motion, pursuant to 37 CFR §2.120 (f), including granting a corresponding

extension of all discovery and testimony periods, until non-compliance has been remedied.

Respectfully submitted,

Dated: September 14, 2019  
New York, NY

SILLS CUMMIS & GROSS P.C.

By: /Ilaria Maggioni/  
Ilaria Maggioni  
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New York, NY 10178  
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[imaggioni@sillscummis.com](mailto:imaggioni@sillscummis.com)

*Attorneys for Respondent*

**CERTIFICATE OF SERVICE**

I hereby certify that I caused a copy of the foregoing RESPONDENT’S MOTION TO COMPEL INITIAL DISCLOSURES to be served on Petitioner’s counsel, this 14<sup>th</sup> day of September, 2019, via email at the address designated by said counsel for that purpose:

LAURA M. KONKEL, ESQ.  
MICHAEL BEST & FRIEDRICH LLP  
ONE SOUTH PINCKNEY STREET, SUITE 700  
MADISON, WI 53703  
lmkonkel@michaelbest.com, mkeipdocket@michaelbest.com

*/Ilaria Maggioni/*

## **EXHIBIT A**

## Ilaria Maggioni

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**From:** Ilaria Maggioni  
**Sent:** Tuesday, September 10, 2019 6:00 PM  
**To:** Konkel, Laura M (22254)  
**Cc:** Ilaria Maggioni  
**Subject:** RE: Office Holdings Limited / Poste Premier, LLC

Dear Laura:

I am following up since our deadline to compel is coming up. Please let us know if your client intends to serve the disclosures and continue the proceedings and discovery, or we will have to move to compel.

Thanks and best regards,  
Ilaria

**Ilaria Maggioni**  
Of Counsel



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**From:** Ilaria Maggioni  
**Sent:** Tuesday, August 20, 2019 4:25 PM  
**To:** Konkel, Laura M (22254) <lmkonkel@michaelbest.com>  
**Cc:** Ilaria Maggioni <imaggioni@sillscummis.com>  
**Subject:** RE: Office Holdings Limited / Poste Premier, LLC

Dear Laura:

I am writing further to our email of August 15, 2019. We have not heard from you. Meanwhile, we did not receive Office Holdings' initial disclosures, which were due on August 16, 2019 and so it is in default of that obligation. As a reminder, our client served its disclosures on July 16, 2019. Please indicate if your client is no longer interested to pursue and intends to drop the cancellation proceedings.

Thanks,  
Ilaria

**Ilaria Maggioni**  
Of Counsel



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