

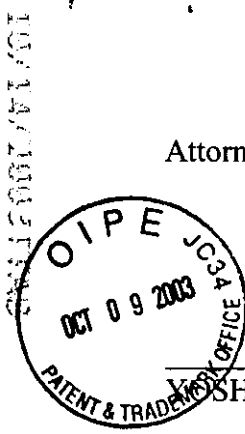
Attorney Docket No.: 231555US33

10-09-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

TTAB

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



YOSHIDA METAL INDUSTRY CO., LTD., )  
)  
Opposer, )  
)  
v. )  
)  
GLOBAL DECOR, INC., )  
)  
Applicant. )  
\_\_\_\_\_ )

Opposition No. 91/156,618  
Appln. Serial No.: 76/179,674  
Mark: GLOBAL DECOR

**OPPOSER'S REPLY TO APPLICANT'S RESPONSE TO**  
**REQUEST FOR EXTENSION OF TIME AND REQUEST FOR**  
**WITHDRAWAL OF REQUEST FOR EXTENSION OF TIME**

Opposer, Yoshida Metal Industry Co., Ltd., replies to Applicant's Response to Opposer's Request for Extension of Time to Respond to Applicant's Motion for Summary Judgment and requests that Opposer's Request for Extension of Time to Respond to Applicant's Motion for Summary Judgment (With Consent) be withdrawn. In support of its motion, Opposer maintains that its request was properly filed with consent, but that the requested extension was rendered unnecessary by subsequent events and should be withdrawn. In support of its Reply, Opposer states as follows.

Opposer contacted counsel for Applicant on September 22, 2003 requesting a thirty day extension of time to respond to Applicant's Motion for Summary Judgment. Applicant's counsel consented to the extension, on the condition that Opposer would consent to the extension of the time for Applicant to file a Reply in support of its motion until January 19, 2004 (Exhibit A).

10/14/2003 11:45

Because Board rules do not permit the extension of time to file a reply, even upon stipulation of the parties, Opposer responded that it would not object to the extended period for Applicant to file a Reply, to the extent permitted by the Board under Trademark Rule 2.127 (Exhibit A).

Opposer then prepared and forwarded Opposer's Request for Extension of Time to Respond to Applicant's Motion for Summary Judgment (With Consent) and Applicant's Request for Extension of Time to File Reply in Support of Motion for Summary Judgment (with Consent) to Applicant's counsel for review. Opposer's counsel advised that barring any objection to the proposed requests before the close of business on September 25, 2003, Opposer would proceed to file its consented Request with the Board and Applicant should file its consented request at its convenience (Exhibit B).

On September 26, 2003 after 5:00 PM, hearing no objection, Opposer filed its Request for Extension of Time to Respond to Applicant's Motion for Summary Judgment (With Consent). Applicant's counsel objected to the form of the dual motions on September 29, 2003, after Opposer's Request had been filed. On September 30, Opposer's counsel informed Applicant's counsel that it would be filing a Motion for Further Discovery under Rule 56(f) and would no longer require the requested extension of time (Exhibit C). On October 1, 2003, counsel for Opposer filed a Motion for Further Discovery under Rule 56(f) and for an Order Compelling Discovery.

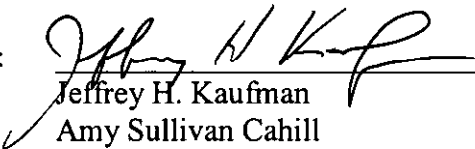
Opposer's Rule 56(f) motion eliminates the need for the requested extension of time to respond to Applicant's Motion for Summary Judgment. Therefore, although Opposer maintains that its Request was in fact filed with the consent of Applicant's counsel, it regrets any

10/14/01 10:31:18 AM

misunderstanding and hereby requests that its Request for Extension of Time to Respond to Applicant's Motion for Summary Judgment (With Consent) be withdrawn as moot.

Respectfully submitted,

YOSHIDA METAL INDUSTRY CO., LTD.

By:   
Jeffrey H. Kaufman  
Amy Sullivan Cahill  
OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
1940 Duke Street  
Alexandria, Virginia 22314  
(703) 413-3000  
Fax: (703) 413-2220

Attorneys for Opposer

Dated: 10/9/01

JHK/ASC/rab {I:\atty\JHK\4646-231555US-rply.doc}

10/14/2003 11:42

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **OPPOSER'S REPLY TO APPLICANT'S RESPONSE TO REQUEST FOR EXTENSION OF TIME AND REQUEST FOR WITHDRAWAL OF REQUEST FOR EXTENSION OF TIME** was served on counsel for Applicant, this 9 day of October 2003, by sending same via First Class Mail, postage prepaid, to:

James B. Conte, Esq.  
BARNES & THORNBURG  
One North Wacker Drive  
Suite 4400  
Chicago, Illinois 60606



\_\_\_\_\_

19/14/1993TTAB

09/24/2003 11:45 AM

**From:** Amy Cahill  
**To:** "jconte@btlaw.com".GWIA.OSGW  
**Date:** 9/24/03 10:15AM  
**Subject:** Re: Yoshida Metal Industry Co., Ltd. v. Global Decor

Mr. Conte:

Thank you for consenting to a thirty day extension of the period for Opposer to respond to Applicant's Motion for Summary Judgment in the above matter. In exchange, we agree not to object to an extension of Applicant's time for reply until January 19, 2003, to the extent that the extension is permitted by the Board under Trademark Rule 2.127.

Amy Sullivan Cahill

>>> "Conte, James" <jconte@btlaw.com> 09/23/03 08:35PM >>>

I received your voice mail message requesting an additional 30 days to respond to our motion for Summary Judgment. Granting the request will move my reply date into a particularly hectic period. Assuming you will consent to move our reply date back to January 19, 2004 we will consent.

**CC:** Kaufman, Jeffrey

10/14/2003TAS

09/14/2003 TTAB

**From:** Amy Cahill  
**To:** "jcont@btlaw.com".GWIA.OSGW  
**Date:** 9/25/03 11:01AM  
**Subject:** RE: Yoshida Metal Industry Co., Ltd. v. consent means w Global Decor

Mr. Conte:

We attach consented requests to extend Opposer's deadline to respond to Applicant's Motion for Summary Judgment until November 1 and to extend Applicant's time to file a reply in support of Applicant's Motion for Summary Judgment until January 19, 2004, as agreed.

If you do not object, we will proceed to file Opposer's request with the TTAB tomorrow (with a service copy to you). You may sign and file the Applicant's request at your convenience.

Thank you,

Amy Sullivan Cahill

>>> "Conte, James" <jcont@btlaw.com> 09/24/03 12:12PM >>>  
You misunderstand. We will only agree to the 30 day extension provided you consent to move our reply date back to January 19. I use the term consent to mean we will file an agreed motion resetting the response and reply dates. If you do not want to file an agreed motion resetting the dates than you have not given us your consent and we do not consent to your extension.

Sincerely,

J Conte

-----Original Message-----

From: ASULLIVAN@oblon.com [mailto:ASULLIVAN@oblon.com]

Sent: Wednesday, September 24, 2003 10:24 AM

To: jcont@btlaw.com

Cc: JKAUFMAN@oblon.com

Subject: Re: Yoshida Metal Industry Co., Ltd. v. Global Decor

Mr. Conte:

Thank you for consenting to a thirty day extension of the period for Opposer to respond to Applicant's Motion for Summary Judgment in the above matter. In exchange, we agree not to object to an extension of Applicant's time for reply until January 19, 2003, to the extent that the extension is permitted by the Board under Trademark Rule 2.127.

Amy Sullivan Cahill

>>> "Conte, James" <jcont@btlaw.com> 09/23/03 08:35PM >>>

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CC: Kaufman, Jeffrey

07/14/2007 11:50

Attorney Docket No.: 231555US-33

TTAB

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

YOSHIDA METAL INDUSTRY CO., LTD.,	)
	)
Opposer,	)
	)
v.	)
	)
GLOBAL DECOR, INC.	)
	)
Applicant.	)
	)

Opposition No. 91/156,618  
Appl. Serial No.: 76/179,674  
Mark: GLOBAL DECOR

**OPPOSER'S REQUEST FOR EXTENSION OF TIME TO RESPOND  
TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT (WITH CONSENT)**

Opposer, Yoshida Metal Industry Co., Ltd., requests an extension of the period of time for Opposer to respond to Applicant's Motion for Summary Judgment until November 1, 2003.

This extension was consented to by counsel of Applicant, James Conte, Esquire, by e-mail correspondence of September 23, 2003 and September 24, 2003.

Respectfully submitted,

YOSHIDA METAL INDUSTRY CO., LTD.

By: \_\_\_\_\_  
 Jeffrey H. Kaufman  
 Amy Sullivan Cahill  
 OBLON, SPIVAK, McCLELLAND,  
 MAIER & NEUSTADT, P.C.  
 1940 Duke Street  
 Alexandria, Virginia 22314  
 (703) 413-3000  
 Fax: (703) 413-2220  
 Attorneys for Opposer

Dated: September 2003  
JHK/ASC/tmq (I:\ATTY\JHK\4646-231555US-REQ.DOC)

10/14/2003 11:45

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **OPPOSER'S REQUEST FOR EXTENSION OF TIME TO RESPOND TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT (WITH CONSENT)** was served on counsel for Applicant, this \_\_\_\_ day of September 2003, by sending same via First Class Mail, postage prepaid, to:

James B. Conte, Esq.  
BARNES & THORNBURG  
One North Wacker Drive  
Suite 4400  
Chicago, Illinois 60606

Attorney Docket No.: 231555US-33

TTAB

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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YOSHIDA METAL INDUSTRY CO., LTD.,	)
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GLOBAL DECOR, INC.	)
	)
Applicant.	)
	)

Opposition No. 91/156,618  
Appl. Serial No.: 76/179,674  
Mark: GLOBAL DECOR

**APPLICANT'S REQUEST FOR EXTENSION OF TIME TO FILE REPLY IN  
SUPPORT OF MOTION FOR SUMMARY JUDGMENT (WITH CONSENT)**

Applicant Global Décor, Inc. submits this request for an extension of the period of time for Applicant to file a reply in support of Applicant's Motion for Summary Judgment until January 19, 2004.

This extension was consented to by counsel for Opposer, Amy Sullivan Cahill, Esquire, by e-mail correspondence of September 23, 2003 and September 24, 2003.

Respectfully submitted,

GLOBAL DÉCOR, INC.

By:

\_\_\_\_\_  
James B. Conte  
BARNES & THORNBURG  
One North Wacker Drive  
Suite 4400  
Chicago, Illinois 60606  
Attorney for Applicant

Dated: September 2003  
(I:\ATTY\JHK\4848-231555US-REQ-APP.DOC)

10/14/2003TAP

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **APPLICANT'S REQUEST FOR EXTENSION OF TIME TO FILE REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT (WITH CONSENT)** was served on counsel for Opposer, this \_\_\_\_\_ day of September 2003, by sending same via First Class Mail, postage prepaid, to:

Jeffrey H. Kaufman  
Amy Sullivan Cahill  
OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.  
1940 Duke Street  
Alexandria, Virginia 22314

---

10/14/1983TTAB

**From:** Amy Cahill  
**To:** "jconte@btlaw.com".GWIA.OSGW  
**Date:** 9/30/03 12:13PM  
**Subject:** RE: Yoshida Metal Industry Co., Ltd. v. consent means w Global Decor

Mr. Conte:

In preparing our reply to Applicant's motion for summary judgment, we have again reviewed Applicant's responses to Opposer's First Set of Interrogatories and First Request for Production of Documents. We continue to find these responses to be inadequate, particularly with respect to Applicant's refusal to produce any responsive documents to date, notwithstanding the parties' previous agreement to treat confidential documents as "attorneys eyes only" until a protective order could be agreed on.

Given the insufficient information and documentation provided, we have no choice but to request an opportunity for further discovery and for an Order from the Board directing Applicant to produce the information and documents requested, in order adequately to respond to Applicant's Motion for Summary Judgment. Unless you are able to supplement these responses by our deadline of October 1, 2003, we will seek the Board's assistance and move to compel Applicant's responses. Of course, filing a motion under Rule 56(f) would obviate the need for a request for extension of time to respond to the pending motion.

Amy Sullivan Cahill

>>> "Conte, James" <jconte@btlaw.com> 09/29/03 06:24PM >>>

Your motion should include the resetting of the reply dates. My email consented to "an agreed motion resetting the response and reply dates". Additionally your own responsive email on the 24th confirmed you would file a single motion.

Separate motions create needless duplication, work and possible confusion for the TTAB.

You should file the single motion as you stated you would in your 24th email.

Sincerely,

J. Conte.

-----Original Message-----

From: [ASULLIVAN@oblon.com](mailto:ASULLIVAN@oblon.com) [mailto:[ASULLIVAN@oblon.com](mailto:ASULLIVAN@oblon.com)]  
Sent: Thursday, September 25, 2003 11:10 AM  
To: [jconte@btlaw.com](mailto:jconte@btlaw.com)  
Cc: [JKAUFMAN@oblon.com](mailto:JKAUFMAN@oblon.com)  
Subject: RE: Yoshida Metal Industry Co., Ltd. v. consent means w Global Decor

Mr. Conte:

We attach consented requests to extend Opposer's deadline to respond to Applicant's Motion for Summary Judgment until November 1 and to extend Applicant's time to file a reply in support of Applicant's Motion for Summary Judgment until January 19, 2004, as agreed.

If you do not object, we will proceed to file Opposer's request with the TTAB tomorrow (with a service copy to you). You may sign and file the Applicant's request at your convenience.

Thank you,

Amy Sullivan Cahill

>>> "Conte, James" <[jconte@btlaw.com](mailto:jconte@btlaw.com)> 09/24/03 12:12PM >>>  
You misunderstand. We will only agree to the 30 day extension provided you consent to move our reply date back to January 19. I use the term consent to mean we will file an agreed motion resetting the response and reply dates. If you do not want to file an agreed motion resetting the dates than you have not given us your consent and we do not consent to your extension.

Sincerely,

J Conte

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From: [ASULLIVAN@oblon.com](mailto:ASULLIVAN@oblon.com) [<mailto:ASULLIVAN@oblon.com>]

Sent: Wednesday, September 24, 2003 10:24 AM

To: [jconte@btlaw.com](mailto:jconte@btlaw.com)

Cc: [JKAUFMAN@oblon.com](mailto:JKAUFMAN@oblon.com)

Subject: Re: Yoshida Metal Industry Co., Ltd. v. Global Decor

Mr. Conte:

Thank you for consenting to a thirty day extension of the period for Opposer to respond to Applicant's Motion for Summary Judgment in the above matter. In exchange, we agree not to object to an extension of Applicant's time for reply until January 19, 2003, to the extent that the extension is permitted by the Board under Trademark Rule 2.127.

Amy Sullivan Cahill

>>> "Conte, James" <[jconte@btlaw.com](mailto:jconte@btlaw.com)> 09/23/03 08:35PM >>>

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CC: Kaufman, Jeffrey