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Filing date: **09/21/2009**

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

Proceeding	91183799
Party	Plaintiff Pure Entertainment, LLC
Correspondence Address	Anne L. Turner Phelps Dunbar LLP 111 East Capitol Street, Suite 600 Jackson, MS 39201 UNITED STATES anne.turner@phelps.com
Submission	Opposition/Response to Motion
Filer's Name	Anne L. Turner
Filer's e-mail	turnera@phelps.com
Signature	/ANNE L. TURNER/
Date	09/21/2009
Attachments	Response to Request for Extension of Time.pdf (13 pages)(333374 bytes)

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

In the Matter of Trademark Application Serial No. 77/071,279
Filed December 26, 2006
For the Mark BUTTER LOUNGE
Published in the Official Gazette on January 1, 2008 and
Trademark Registration No. 3380349
for the Mark BUTTER RESTAURANT
Registration Date February 12, 2008

PURE ENTERTAINMENT, LLC,)	
)	
Opposer,)	Opposition No.: 91183799
)	Cancellation No.: 92049767
v.)	
)	
BUTTER LICENSING, LLC,)	
)	
Applicant.)	

**OPPOSER’S RESPONSE TO APPLICANT’S MOTION FOR
EXTENSION OF TIME TO RESPOND TO SUMMARY JUDGMENT**

INTRODUCTION

1. Opposer’s summary judgment motion was filed April 29, 2009. Now, nearly five months later, after being allowed sixty (60) days from the date on which its request for Rule 56(f) discovery was approved on July 31, 2009, to respond to Opposer’s summary judgment motion, Applicant asks for an additional extension of “16 days” past the presently unexpired deadline of September 29, 2009, to respond. Because the circumstances of Applicant’s request for such extension do not meet the test of “good cause,” Applicant’s Motion should be denied.

ARGUMENT

2. Applicant misrepresents to the Board that the instant Motion is its first request for an extension of time to respond to summary judgment. *See* Motion at 2. Applicant has sought an extension on at least two prior occasions — first, in its Rule 56(f) discovery request filed on

June 3, 2009, and, later, in conjunction with its request for additional Rule 56(f) discovery on September 2, 2009. In response to the first request, the Board granted Applicant sixty (60) days from the date the Board adjudicated Applicant's Rule 56(f) motion to complete its permitted Rule 56(f) discovery and to respond to Opposer's motion for summary judgment. *See* Order mailed July 31, 2009. This extended the deadline for Applicant's response until September 29, 2009.¹ Applicant's second request, which sought an additional thirty days for Rule 56(f) discovery and an additional thirty days thereafter to respond to the summary judgment motion, was denied. *See* Order mailed September 8, 2009. Applicant's instant Motion apparently seeks reconsideration of the September 8 Order.

3. Applicant cites two bases for its latest extension request. Applicant first contends that its "attorneys will have difficulty complying with the deadline due to religious obligations arising out of the Jewish holidays of Rosh Hashanah and Yom Kippur." *See* Motion at 1, ¶ 2. The first time that Opposer learned of such a basis for the extension request was upon review of Applicant's Motion.² When Applicant's counsel asked Opposer's counsel via electronic mail on the evening of September 14, 2009, to consent to an additional extension, no mention of any religious obligations of Applicant's counsel was made, nor was any other reason offered for the extension request. *See* attached Exhibit A, a true and correct copy of the September 14, 2009, e-mail from Applicant's counsel to Opposer's counsel. Opposer, through its counsel, advised

¹ The due date for Applicant's response is not September 30, 2009 as Applicant asserts in its Motion, but rather is September 29, 2009, which is the sixtieth day after July 31, with the counting of the days beginning with August 1, 2009.

² If Opposer's counsel had not reviewed the docket in this proceeding late Friday afternoon, September 18, 2009, Opposer would not yet have known that Applicant's instant Motion had been filed. Inconsistent with the presumed urgency of Applicant's request and the course of conduct between the parties to send pleadings by electronic mail, even when such pleadings are served by regular mail, Applicant did not send the Motion to Opposer by electronic mail on the day it was filed and, as of the date of this response, Opposer has not yet received the mailed copy. The copy of the Motion Opposer obtained from the TTAB's website indicates that it was served upon Opposer by United States mail addressed to Opposer's attorneys in Jackson, Mississippi, on September 17, 2009. Correspondence

Applicant's counsel the next day that Opposer would oppose any request for an extension; *see* attached Exhibit B, a true and correct copy of the September 5, 2009, reply e-mail from Opposer's counsel to Applicant's counsel; and Opposer heard nothing further from Applicant on the subject.

4. Applicant has not raised religious obligations of its counsel as grounds for an extension of time to file its summary judgment response at any prior point during the pendency of the summary judgment motion — not in its request for Rule 56(f) discovery; not during the parties' August 7, 2009, phone conference with the Board on Applicant's *ore tenus* motion for leave to take an additional Rule 56(f) deposition; not in the September 2, 2009, letter of Applicant's counsel seeking additional Rule 56(f) discovery and an extension to respond to summary judgment;³ and not two weeks ago during the parties' September 4, 2009, phone conference with the Board regarding the requests in the September 2 letter. Applicant cannot honestly contend that it did not previously have the opportunity to raise such grounds as the basis for an extension.

5. Given that the 2009 dates for Rosh Hashanah and Yom Kippur are fixed by the calendar and presumably well known to Applicant's counsel, it stretches the bounds of credulity that Applicant and its counsel are just now raising them as purported obstacles to responding to summary judgment. While Opposer and its counsel respect Applicant's counsel's religious obligations and observances, Opposer notes that the Board has repeatedly reminded Applicant of the due date for its summary judgment response. *See* Order mailed July 31, 2009 ("Applicant is

mailed to Opposer's attorneys in Mississippi from Applicant's attorneys in New York has typically taken at least five business days to be received by Opposer's attorneys.

³ Applicant did not mention religious obligations in the September 2, 2009 e-mail that its counsel sent to Opposer's counsel asking Opposer to consent to an additional sixty days to conduct Rule 56(f) discovery. *See* attached Exhibit C, a true and correct copy of the September 2, 2009 e-mail from Applicant's counsel to Opposer's counsel.

allowed until SIXTY DAYS from the mailing date of this order to file its response to opposer's motion for summary judgment on the merits"); Order mailed August 9, 2009 ("Dates remain as set in the Board's order of July 31, 2009"); Order mailed September 8, 2009 ("Applicant's response to the motion for summary judgment remains due pursuant to the Prior Order"). Applicant's use of its religious observances to justify an extension at this late date appears to be disingenuous.

6. Based on the 2009 calendar of Opposer's counsel, as well as the understanding of Opposer and its counsel, Rosh Hashanah began at sundown this past Friday, September 18, and Yom Kippur begins at sundown on Sunday, September 27, with each observance lasting approximately one day. Therefore, at the most, only one business day—Monday, September 28—would be implicated by Opposer's counsel's observance of these obligations. Such simply does not justify the 16-day extension Applicant requests.

7. The only other ground cited by Applicant for the additional extension is that it received the transcript of the August 29, 2009, deposition of Opposer on September 16, 2009. That Saturday deposition⁴ of Opposer in San Francisco lasted less than three hours. If Applicant thought it needed the transcript for its summary judgment response, Applicant could have requested that it be transcribed sooner or could have obtained a "rough" copy of the transcript until the final was completed, particularly if the upcoming religious observances were an impediment to Applicant finishing its response by September 29. Applicant's failure to take any of those steps should not excuse its obligation to respond to the summary judgment motion by the present deadline set by the Board.

⁴ Applicant initially confirmed Monday, August 31, 2009 as the date for the deposition; *see* attached Exhibit D, a true and correct copy of the correspondence from Opposer's counsel; which choice Opposer acknowledged in writing. Despite the confirmation, Applicant then noticed the deposition to proceed on Saturday, August 29, in San Francisco, *see* Exhibit E, which Opposer and its counsel accommodated.

8. In view of the facts described above, Applicant has not demonstrated good cause to warrant an extension until October 16, 2009, to respond to Opposer's summary judgment motion. Based on the authority Applicant cites in its Motion, the Board's liberal standard in granting extensions of time should be followed only when "the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused." *American Vitamin Prods., Inc. v. DowBrands, Inc.*, 22 U.S.P.Q.2d 1313, 1315 (TTAB 1992). Applicant's instant extension request indicates negligence on its part given that the summary judgment motion was filed nearly five months ago and Applicant had already received a 60-day extension. Also, Applicant's representation to the Board that the instant Motion comprises its first request for an extension of time to respond, when it clearly is not, indicates bad faith. Applicant's motion for Rule 56(f) discovery was made the very day its response to the summary judgment motion was originally due (thirty days from the date of its filing with five days added for mailing), the result of which provided Applicant with 58 days delay while the Rule 56(f) motion was under consideration, plus an additional 60 days from the date of the July 31 ruling. Applicant's subsequent request for an extension of time was denied, Applicant was repeatedly reminded of the present due date by the Board, and Applicant could have secured the transcript of Opposer's deposition before now. Any inability by Applicant to respond to the summary judgment motion by the present due date is attributable solely to Applicant's own failures, and indicates Applicant's abuse of the time it has been previously allowed.⁵

⁵ Applicant's conduct further implies bad faith, given that it failed to serve Opposer with Applicant's Motion in a manner providing expedited receipt, which delay appears to have been intended to push back Opposer's response to the instant Motion until uncomfortably close to the present deadline and may have also put the Board in a position where it had little choice other than to grant Applicant's motion given the anticipated timing of Opposer's response. Opposer has expedited its response herein to avoid any further delay, notwithstanding Opposer's entitlement to the entire response period.

CONCLUSION

9. For the reasons set forth above, Applicant's Motion should be denied and Opposer granted all other relief deemed appropriate under the circumstances.

This the 21st day of September, 2009.

Respectfully submitted,

PHELPS DUNBAR LLP

By:



Jerome C. Hafter

Debra M. Brown

Anne L. Turner

111 East Capitol Street, Suite 600

Jackson, Mississippi 39201

Telephone: (601) 352-2300

E-Mail: hafterj@phelps.com


brownd@phelps.com

turnera@phelps.com

Attorneys for Pure Entertainment, LLC

CERTIFICATE OF SERVICE

I hereby certify and declare under penalty of perjury that I served a true and correct copy of this document upon Ken Sussmane, Keith G. Sklar and Craig M. Spierer, McCue Sussmane & Zapfel, P.C., attorneys for Applicant Butter Licensing, LLC, by electronic mail and by depositing such copy with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to same at 521 5th Avenue, 28th Floor, New York, New York 10175-2199, on the 21st day of September, 2009.

A handwritten signature in black ink, appearing to read 'Debra M. Brown', written over a horizontal line. The signature is stylized and cursive.

Debra M. Brown
Attorney for Pure Entertainment, LLC

Debra M. Brown (3352)

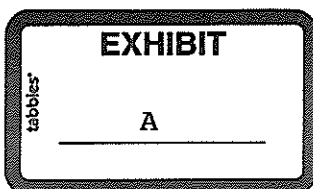
From: Keith Sklar [ksklar@mszpc.com]
Sent: Monday, September 14, 2009 5:22 PM
To: Debra M. Brown (3352)
Subject: Pure Entertainment, LLC v. Butter Licensing, LLC, United States Patent and Trademark Office, Trademark Trial and Appeal Board Opposition No.: 91183799

Ms Brown:

We are requesting a two week extension for the submission of our opposition to the motion for summary judgment. Please contact me to discuss.

Sincerely,

Keith Sklar
McCue, Sussmane & Zapfel, P.C.
521 Fifth Avenue, 28th Floor
New York, New York 10175
(212) 931 5500 ext. 212 (phone)
(212) 931 5508 (fax)



Debra M. Brown (3352)

From: Debra M. Brown (3352)
Sent: Tuesday, September 15, 2009 5:02 PM
To: 'Keith Sklar'
Subject: RE: Pure Entertainment, LLC v. Butter Licensing, LLC, United States Patent and Trademark Office, Trademark Trial and Appeal Board Opposition No.: 91183799

Keith -- we would oppose any extension to respond to the summary judgment motion.

Regards,

Debra M. Brown
Phelps Dunbar LLP
111 East Capitol Street
Suite 600
Jackson, Mississippi 39201
(601) 352-2300

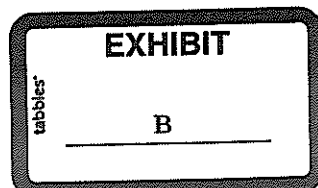
From: Keith Sklar [mailto:ksklar@mszpc.com]
Sent: Monday, September 14, 2009 5:22 PM
To: Debra M. Brown (3352)
Subject: Pure Entertainment, LLC v. Butter Licensing, LLC, United States Patent and Trademark Office, Trademark Trial and Appeal Board Opposition No.: 91183799

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Sincerely,

Keith Sklar
McCue, Sussmane & Zapfel, P.C.
521 Fifth Avenue, 28th Floor
New York, New York 10175
(212) 931 5500 ext. 212 (phone)
(212) 931 5508 (fax)



Debra M. Brown (3352)

From: Ken Sussmane [ksussmane@mszpc.com]
Sent: Wednesday, September 02, 2009 4:30 PM
To: Debra M. Brown (3352); Anne Turner (3725)
Subject: Butter

We are going to request an additional 60 days to complete discovery, namely the production of documents by opposer which were requested during the deposition. Once we receive the transcript we will prepare a formal request. Will you consent?

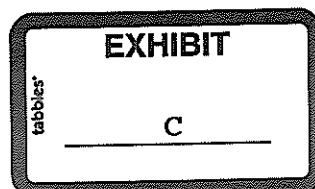
Please let me know a convenient time for you to conference with the interlocutory attorney to discuss.

Thanks.

Ken Sussmane
McCue Sussmane & Zapfel, P.C.
521 Fifth Avenue, 28th Floor
New York, New York 10175
212 931 5500
212 931 5508 (fax)
646 219 6925 (efax)
ksussmane@mszpc.com

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TELEPHONE: (212) 931-5500
FACSIMILE: (212) 931-5508

July 31, 2009

Copy by Email

Original by Mail

Debra Brown

Phelps Dunbar LLP

111 East Capitol Street, Suite 600

Jackson, Mississippi 39201-2122

Re: Pure Entertainment, LLC v. Butter Licensing, LLC
Opposition No. 91183799
Cancellation No. 92049767

Dear Ms. Brown:

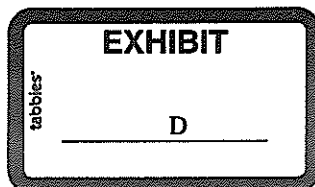
We are in receipt of your letter dated July 31, 2009 regarding the decision of the Board on Butter Licensing's Rule 56(f) motion issued today. We confirm the available date of August 31, 2009 for depositions. We are not willing to waive your prior agreement to conduct depositions in New York.

Additionally, will be requesting that the Board permit Butter Licensing to depose your affiant Mr. Solle as well as Mr. Paine on the condition that both depositions will occur on August 31, 2009 and will total six hours.

Please give us a call on Monday to discuss this matter.

Sincerely,


Ken Sussmane



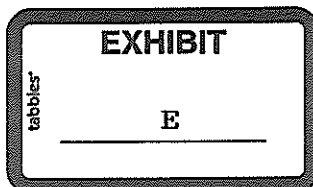
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

<p><i>PURE ENTERTAINMENT, LLC,</i></p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">- against -</p> <p><i>BUTTER LICENSING, LLC,</i></p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No.: 91183799</p> <p>Serial No.: 77/071279</p> <p>Mark: BUTTER LOUNGE</p>
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DEPOSITION NOTICE FOR ORAL TESTIMONY

PLEASE TAKE NOTICE that, pursuant to 37 C.F.R. Section 2.120 and Rule 30(b)(6) of the Federal Rules of Civil Procedure and without prejudice to renewal of this notice after additional discovery has been taken Applicant Butter Licensing, LLC, will take the deposition upon oral examination of Oliver Paine to testify in accordance with the decision of Michael B. Adlin dated July 31, 2009, commencing at 9:00 a.m. on August 29, 2009, before a notary public or other officer duly authorized to administer oaths at the offices of Barkley Court Reporters, 222 Front Street, Suite 600, San Francisco California 94111.

The deposition will be recorded by stenographic means. You are invited to attend and cross examine.



PLEASE TAKE NOTICE that Applicant may videotape the deposition.

Dated: New York, New York
August 11, 2009

McCue Sussmane & Zapfel, P.C.

By: _____ \Ken Sussmane_____
Kenneth Sussmane

521 Fifth Avenue, 28th Floor
New York, New York 10175
Phone: (212) 931-5500
Fax: (212) 931-5508

Attorneys for Applicant
Butter Licensing, LLC

To: Deborah Brown
Phelps Dunbar LLP
111 East Capitol Street Suite 600
Jackson, Mississippi 39225-3066
601 352 2300