

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

NORTH ATLANTIC OPERATING  
CO., INC.

Opposer

vs.

NEW IMAGE GLOBAL, INC.

Applicant

Opposition No.:91187188  
Re: Application No.:77316130  
Mark: THE PAPER  
Published: May 27, 2008

APPLICANTS OPPOSITION TO  
OPPOSER'S MOTION FOR  
EXTENSION OF TIME;  
DECLARATION OF DON  
FINKELSTEIN;  
REQUEST TO DISMISS  
OPPOSITION

Applicant New Image Global Opposes the Motion of Opposer for the Extension of Time  
of All Dates.

A. BACKGROUND

1. By Board Order dated October 27, 2008, this Board set forth the following trial dates

herein:

Time to Answer	12/6/2008
Deadline for Discovery Conference	1/5/2009
Discovery Opens	1/5/2009
Initial Disclosures Due	2/4/2009
Expert Disclosures Due	6/4/2009
Discovery Closes	7/4/2009
Plaintiff's Pretrial Disclosures	8/18/2009
Plaintiff's 30-day Trial Period Ends	10/2/2009
Defendant's Pretrial Disclosures	10/17/2009
Defendant's 30-day Trial Period Ends	12/1/2009
Plaintiff's Rebuttal Disclosures	12/16/2009
Plaintiff's 15-day Rebuttal Period Ends	1/15/2010

(These dates have not been extended by any Order of this Board)



The Board Order of October 27 further specified, in part:

“As noted in the schedule of dates for this case, the parties **are required** to have a conference to discuss: (1) the nature of and basis for their respective claims and defenses, (2) the possibility of settling the case or at least narrowing the scope of claims or defenses, and (3) arrangements relating to disclosures, discovery and introduction of evidence at trial, should the parties not agree to settle the case...” (Emphasis added.)

2. As shown by the attached Declaration of Don Finkelstein:

a. Applicant sent a letter dated December 17, 2008 to Opposer and this letter specifically requested Opposer to advise Applicant as to how Opposer desired to handle the Discovery Conference by the deadline of January 5, 2009 as set by the Board. No response to this letter was received prior to the due date of the conference. (It is noted that Opposer does not even seek to reopen the time for the Discovery Conference in its main Motion, which conference, as noted by the Board, is required.) Opposer not only failed to respond to Applicant’s letter by the deadline for the Discovery Conference, but did not try any time to set a time for the required Discovery Conference before the deadline therefor.

b. Opposer did not submit any Initial Disclosure by the due date of February 4, 2009.

c. Opposer did not submit any Expert Disclosures by the due date of June 4, 2009, or at all.

d. There is no declaration of any kind submitted by Opposer in support of the present Motion despite the alleged facts set out in the Motion.

## B. ARGUMENT

1. Opposer seeks to imply that Applicant did not timely file its Answer herein. This implication is absolutely untrue. Applicant was granted an Extension of Time to Answer to

December 17, 2008 by one of Opposer's attorney of record, Arlana S. Cohen, Esq. Applicant's Answer was timely filed by this date.

2. As shown by the Declaration of Don Finkelstein, Opposer made no effort to contact Applicant regarding the Discovery Conference before the due date of the Conference. As shown by the Notice of Opposition on file herein, the lead attorneys for Opposer are listed as, apparently, Arlana S. Cohen, Esq. and Heather L. Jensen, Esq. Despite the fact that Ms. Cohen is still one of the attorneys for Opposer as shown by the signature to the present Motion, there is no Declaration from Ms. Cohen or Ms. Jensen, or either of them, of any scheduled absence from Opposer's office during the week of January 5, 2009 as alleged in the Motion. Thus, Ms. Cohen at all times from the filing date of the Opposition to the filing date of the present Motion and as of the date hereof was and is one of the attorneys of record for Opposer. In fact, as shown by the declaration of Don Finkelstein, there was no contact from Ms. Cohen or Ms. Jensen **at any time** regarding re-scheduling the required Discovery Conference. The statement by Opposer in the Motion that Opposer tried to contact Applicant to reschedule the Conference is misleading. The letter of Mr. Greene dated May 8, 2009, attached to Opposer's Motion, clearly shows **and admits** that Opposer did not even make an attempt to contact Applicant until March 31, 2009, or **two and one half months after the required Discovery Conference date**. In fact, as further admitted by Mr. Greene in this letter, he did not "take over" this Opposition until March 30, 2009. It is noted that Mr. Greene did not even file a change of correspondence address listing him as one of the attorneys for Opposer until June 30, 2009, the same date that he filed the present Motion. Applicant had no obligation at any time to relieve Opposer from the consequences of its negligent conduct. As shown by Exhibit 2 to the Declaration of Don

Finkelstein, there are 54 attorneys listed in Opposer's law firm of Cowan, Liebowitz & Latman, PC.

3. The statement by Mr. Greene in the Motion that Opposer only "allegedly" missed the deadline for the Discovery Conference is, again, misleading. Opposer did not "allegedly" miss the date for the Discovery Conference: the files and records herein including the admissions of Opposer show that Opposer did, **in fact**, miss the date for the Discovery Conference of January 5, 2009 and did not even attempt to contact Applicant with respect thereto until March 31, 2009. By then Opposer had also missed the Initial Discovery Date of February 4, 2009. Opposer has presented no reason or explanation for Opposer negligent and inexcusable behavior in not following the due dates set by this Board herein.

4. Opposer missed not only the date for the Discover Conference but also the date for the Initial Disclosures of February 4, 2009 as well as the Expert Disclosures due date of June 4, 2009. Opposer waited until June 30, 2009 to file its Motion herein which is only four days from the date of Closing of Discovery of July 4, 2009.

5. Opposer also seeks by its Motion herein a reopening of the Discovery Opening date which was January 5, 2009. Opposer made no discovery of any kind or nature at any time herein. With Opposer having through its own negligence missed three dates set by this Board by the time Opposer sent the letter of May 8, 2009, (attached to the Motion) and four dates by the time Opposer had the conversation with Applicant's counsel on June 26, 2009, it is apparent that Applicant had no obligation to help relieve Opposer of its own negligent acts. Totally missing from the Motion is any reason not only for the delay until March 31, 2009 in even trying to contact Applicant's attorney but also why Opposer did not immediately seek relief from this

Board to have the missed dates re-opened by the Board within a reasonable time after the missed date of the Discovery Conference and Applicant's failure to respond to the alleged voice mail and telephone call (what is the difference between the two?) of March 31, 2009. Certainly, it is inexcusable for Opposer to have missed all these dates. Ms. Cohen and Ms. Jensen were at all times from the filing of the Notice of Opposition to at least June 30, 2009, listed as the attorneys of record for Opposer herein (and Ms. Cohen still is) and no reason is given why neither of them, or anyone else, took any timely action with the Board between January 5, 2009 and March 31, 2009 to attempt to obtain relief from their negligent acts.

6. Contrary to the allegations in the Motion which are unsupported by Declaration, Applicant has not refused to cooperate in discovery. In the very last paragraph of Applicant's letter of December 17, 2009 to Ms Arlana S. Cohen, Esq. (Exhibit 1 to declaration of Don Finkelstein) it states:

"I look forward to mutual cooperation in resolving this matter at the earliest time".

The inexcusable acts of Opposer has prevented both the cooperation by Applicant in discovery **(there has been no discovery conducted by Opposer)** and the speedy resolution of this Opposition. Opposer offers no explanation why Opposer has not conducted any discovery since discovery opened January 5, 2009. Opposer in its main Motion does not seek to re-open the Discovery Conference, blaming some purported (and untrue) lack of cooperation by Applicant herein, but only as an alternative does Opposer seeks to have the proceedings herein suspended so that a Discovery Conference can be scheduled. It is inconceivable that Opposer in this Opposition can just do nothing, not even contacting Applicant, for two and one half months after a due date is past (e.g. the Discovery Conference) and then seek to blame Applicant and get by

without even having the required Discovery Conference.

7. Since the due dates for four separate actions herein were missed by Opposer, Opposer is seeking, after the time for taking the action, to re-open these dates under Federal Rules of Civil Procedure Rule 6 (b)(1)(B). As such, Opposer must show "excusable neglect". This Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ 2d 1582 (TTAB 1997) adopted the analysis of what constitutes excusable neglect as set down by the U.S. Supreme Court in *Pioneer Investment Services Company v. Brunswick Associates Ltd Partnership* 507 U.S. 380 (1993). In the *Pioneer* case, the Court set out eight factors some or all of which are to be considered in determining whether or not the neglect was excusable. These eight factors are:

- a. The prejudice to the opponent;
- b. The length of the delay and its potential impact on the course of the judicial proceedings;
- c. The causes for the delay, and whether those causes were within the reasonable control of the moving party;
- d. The moving party's good faith;
- e. Whether the omission reflected professional incompetence, such as an ignorance of the procedural rules;
- f. Whether the omission reflected an easily manufactured excuse that the court could not verify;
- g. Whether the moving party had failed to provide for a consequence that was readily foreseeable; and
- h. Whether the omission constituted a complete lack of diligence.

Examining each of these factors, the facts, even as admitted by Opposer show:

- a. There is extreme prejudice to Applicant. Opposer seeks a six month extension of time and thus delay the final adjudication herein and determination of Applicant's rights for half a year. This is unfair to Applicant and prejudices Applicant's prospective rights in respect to obtaining a trademark registration. Applicant is entitled to a speedy determination of this Opposition in order to determine Applicant's rights and Opposer's Motion defeats these rights.

b. The length of the delay between the time for taking the first action on or before January 5, 2009 for the Discovery Conference and when Opposer filed its Motion herein was almost six months and Opposer seeks yet an additional six months delay in reopening all of the dates herein and thus would totally delay the proceedings in this matter far beyond the times set by the Board.

c. The cause for the delay was entirely in the control of Opposer. Applicant was ready to cooperate with Opposer at the onset of this Opposition but when Opposer did nothing between December 17, 2008 and March 31, 2009, Applicant has no obligation to do anything to help Opposer rectify its negligence. Opposer could have made a Motion to this Board immediately after it missed the Discovery Conference date of January 5, 2009 but it did not do so at anytime until June 30, 2009.

d. Opposer has shown bad faith. In its Motion, Opposer seeks to blame Applicant for the predicament in which it now finds itself. Once Opposer missed the three (or four) dates it now seeks to re-open without ever taking any action, this is bad faith by Opposer and shows a lack of diligence by Opposer alone.

e. It is submitted that the delay from December 17, 2008 to March 31, 2009 certainly could be interpreted by this Board as a level of professional incompetence.

f. No excuse or reason whatsoever for the omission to take the necessary actions in a timely fashion is presented in this Motion and there is no Declaration setting forth any pertinent facts. Certainly, from January 5, 2009 to March 31, 2009, Opposer can not even make any claim that Applicant was not cooperative: Opposer did nothing, not even contact Applicant, in this time span. This delay is totally inexcusable.

g. The consequences if missing a due date are readily foreseeable and apparently Opposer

did not provide for the consequences. One example of the failure to provide is the apparent failure of Opposer to maintain a due date log which would have advised Opposer that there were dates to be met herein.

h. It is obvious that the omission of Opposer's counsel herein to contact Applicant at all from December 17, 2008 (the date of Applicant's letter to Opposer and the filing of the Answer herein) until March 31, 2009, and considering the very lackadaisical and the alleged sporadic efforts made by Opposer (March 31, 2009, April 22, 2009, May 1, 2009 and May 8, 2009) to contact Applicant's attorney shows a lack of diligence.

Thus, it is respectfully submitted that all of the eight *Pioneer* factors favor Applicant herein and the Board should deny in its entirety Opposer's motion herein.

The courts have ruled extensively on what does and doesn't constitute excusable neglect. For example, in *Lewis v. School District #70*, 523 F.3d 730 (CA7, 2008) the Court found, *inter alia* that an attorney's inexplicable failure to read and apply crystal clear legal rules will not be deemed excusable neglect. The Board's Order of October 27, 2008 is crystal clear. Also, clients will be held responsible for the omissions of the of their attorney's, even if the clients are not otherwise culpable for the error. See *Allen v. Murph* 194 F.3d 722, 724 (CA6 1999). The courts have held that demonstrating excusable neglect is not easily done, and was not intended to be. See *Thompson v. E.I. DuPont de Nemours & Co.* 76 F.3d 530 (CA4 1996).

8. There is no rule or regulation in this Opposition proceeding or by the Trademark Trial and Appeal Board or by the courts that requires a party to stipulate to any re-opening of time when the opposing party has missed required due dates. This is not a lack of cooperation. That is, Opposer's letter of March 31, 2009 would seem to require Applicant to somehow stipulate to

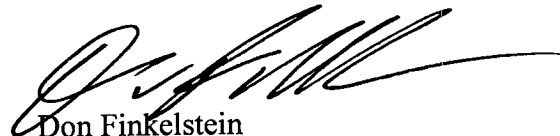


the re-opening of the Discovery Conference of January 5, 2009 and the due date for the Initial Disclosures of February 4, 2009. While Applicant would, of course, cooperate with Opposer, when the proceedings were timely, there is nothing that requires Applicant to stipulate to relieve Opposer of its negligent actions. It is up to the Board to make the determination of whether or not Opposer's actions constitute the required excusable neglect.

#### CONCLUSION

From the above it is apparent that Opposer has missed four due dates herein and is now seeking to reopen these due dates. It is respectfully submitted that Opposer's actions herein do not constitute excusable neglect and there are no grounds for this Board to reopen any of the missed due dates. Since one of the due dates which Opposer missed is the required deadline for the Discovery Conference, if it truly is a deadline, then the Board should not re-open this date and since it is a required deadline it is respectfully submitted that the Board should not only deny the Motion in its entirety but should dismiss this Opposition. That is, if a party misses such a required deadline by not doing anything at all and then come to the Board to seek relief without providing any reason or excuse for missing the deadline then, in fact, is neither required nor a deadline.

Respectfully submitted,



Don Finkelstein  
Attorney for Applicant  
Date: July 8, 2009

Don B. Finkelstein, Esq.  
LAW OFFICES OF DON FINKELSTEIN  
3858 Carson Street, Suite 216  
Torrance, CA 90503  
Phone: (310) 543 0070  
Fax: (310) 543 7570

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

<b>NORTH ATLANTIC OPERATING</b>	)	<b>Opposition No.:91187188</b>
<b>CO., INC.</b>	)	<b>Re: Application No.:77316130</b>
<b>Opposer</b>	)	<b>Mark: <u>THE PAPER</u></b>
	)	<b>Published: May 27, 2008</b>
<b>vs.</b>	)	
<b>NEW IMAGE GLOBAL, INC.</b>	)	<b>DECLARATION OF DON</b>
	)	<b>FINKELSTEIN</b>
<b>Applicant</b>	)	
	)	

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Comes now Don Finkelstein and hereby declares:

1. I am attorney of Record for Applicant herein and have been since being appointed by the Probate Court of the Superior Court of the State of California as Practice Administrator for the Law Office of Edward Sokolski. I prepared and served and filed the Answer herein on behalf of Applicant. The answer was served and filed by certificate of service on December 17, 2008.

Ms. Alana Cohen, Esq., one of the attorney's for Opposer granted Applicant an extension of time to file the Answer until December 22, 2008.

2. On December 17, 2008 I sent a letter to Opposer and a true and correct copy thereof is attached hereto as Exhibit 1. This is the letter referred to by Opposer in its Motion since it is the only letter I have sent to Opposer. As shown by Exhibit 1, I specifically asked Opposer how Opposer desired to handle the Discovery Conference and if by phone, who would initiate the call, at what time, and the like. OI did not receive any answer to this letter or other communication from Opposer prior to the time for the Discovery Conference. I also advised Opposer that I was looking forward to mutual cooperation in resolving the matter at the earliest time. Consequently, no Discovery Conference was held on or before the deadline therefor.

3. Opposer did not submit any Initial Disclosures by the due date of February 4, 2009.

4. Opposer did not submit any Expert Disclosures by the due date of June 4, 2009.

5. Opposer did not submit any discovery of any kind or nature since the opening of discovery to date.

6. I have never received any communication from Ms. Cohen of Ms Jensen in response to my letter of December 17, 2009. I have never received any communication from Ms. Cohen or Ms Jensen at specifying.

7. I did not make a request in my letter of December 17, 2009 to schedule "...a required discovery conference." (as alleged in Opposer's Motion) Rather, Exhibit 1 hereto shows, as noted above, that I requested Opposer to advise of the time for the required Discovery Conference. I did not receive any communication from Opposer advising that the "lead attorney" would be away from her office "...on a scheduled absence..." the week of January 5, 2009 and requesting any other time for the Conference. No attempt was made by Opposer concerning the Discovery Conference until, at the earliest, the alleged date of March 31, 2009. The attempt by Opposer to contact me on March 31, 2009 is hardly "...accordingly..." to the alleged scheduled absence of the lead attorney the week of Jan 5, 2009.

8. Attached hereto as Exhibit 2 is a true and correct printout of the date of July 8, 2009

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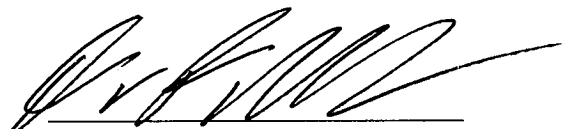
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from the web site (cfl.com) of the attorneys in Opposer's counsel firm of Cowan, Liebowitz Latman. As such, it shows 54 attorneys in the firm. Thus there was at all times more than sufficient "manpower" to handle this Opposition properly.

9. Further Declarant sayeth not.

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of my own knowledge are true and all statements made on information and belief are believed to be true.

Executed at Torrance, Los Angeles County, State of California this 8<sup>th</sup> day of July, 2009.



Don Finkelstein

LAW OFFICES

**DON B. FINKELSTEIN ESQ.**

ATTORNEYS AT LAW  
PATENT LAWYERS

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December 17, 2008

Arlana S. Cohen, Esq.  
Heather L. Jensen, Esq.  
COWAN, LIEBOWITZ & LATMAN, P.C.  
1133 Avenue of the Americas  
New York, NY 10036

Re: NORTH ATLANTIC OPERATING COMPANY, INC. v NEW IMAGE  
GLOBAL, INC.; TTAB. Opposition No. 91187188

Dear Ms. Cohen and Ms. Jensen:

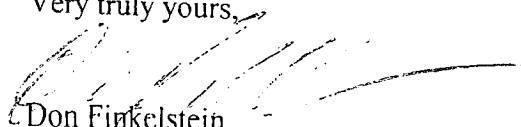
Enclosed herewith and served upon you is the ANSWER TO NOTICE OF OPPOSITION AND AFFIRMATIVE DEFENSES in the subject Opposition.

As you know, Mr. Sokolski passed away on November 9, 2008. I have been appointed by the Probate Court as Practice Administrator to handle the pending matters in Mr. Sokolski law office. Consequently, I will be representing New Image Global, Inc. in this Opposition.

According to the Trademark Trial and Appeal Board Notice, the deadline for the Discovery Conference is January 5, 2009. Please advise how you desire to handle the conference. If by phone, who will initiate the call and at what time, etc.

I look forward to mutual cooperation in resolving this matter at the earliest time.

Very truly yours,

  
Don Finkelstein

DBF/cc

enc.

mc: Doug Kautzky

Keith Scott

**EXHIBIT 1**



# Our people, our talent



Our attorneys are recognized year after year for their professional accomplishments and experience. Always committed to being top quality lawyers, we focus on your business needs and do not lose sight of your pocketbook.

William M. Borchard

Baila H. Celedonia

Sujata Chaudhri  
Robert W. Clarida

Ariana S. Cohen

Lewis R. Cowan  
Marvin S. Cowan

Richard Dannay

Kieran Doyle

Jeffrey H. Epstein  
C.J. Erickson

Eugene L. Flanagan

Lynn S. Fruchter

R. Lewis Gable  
Simon Gerson

Robert J. Giordanella

Morton David Goldberg

Arthur J. Greenbaum

Lawrence W. Greene

Robert Halper

Midge M. Hyman  
J. Christopher Jensen

Lindsey F. Jones

Elise C. Kasell  
Mary L. Kevin

Jonathan Z. King

Thomas Kjellberg

John C. Laurence  
Roberto Ledesma

Martin P. Levin

Maryann E. Licciardi

Sidney I. Liebowitz  
Meichelle R. MacGregor

Richard S. Mandel

Laurie B. Marshall

Michael F. Maschio

Lloyd McAulay

Ronald W. Meister

Mark Montague  
Jeremy Nussbaum

Peter R. Porcino

Morton L. Price  
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Anastasia Zhadina

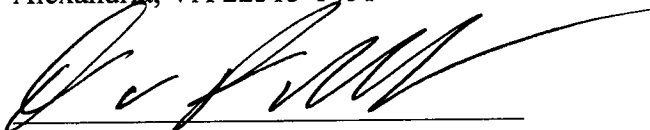
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EXHIBIT 2

## CERTIFICATE OF MAILING

I hereby certify that the Original and Two Copies of the attached  
**APPLICANTS OPPOSITION TO OPPOSER'S MOTION FOR EXTENSION OF TIME;  
DECLARATION OF DON FINKELSTEIN;  
REQUEST TO DISMISS OPPOSITION**  
are being deposited in the United States Postal Service on July 8, 2009 as First Class Mail in an envelope, postage paid, addressed to :

COMMISSIONER FOR TRADEMARKS  
P.O.Box 1451  
Alexandria, VA 22313-1451

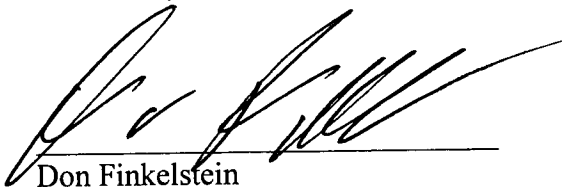


Don Finkelstein  
Date: July 8, 2009

### PROOF OF SERVICE

It is hereby certified that a true and correct copy of the foregoing:  
**APPLICANTS OPPOSITION TO OPPOSER'S MOTION FOR EXTENSION OF TIME;  
DECLARATION OF DON FINKELSTEIN;  
REQUEST TO DISMISS OPPOSITION**  
was served on Opposer on July 8, 2009 by first class mail postage prepaid in an envelope addressed to:

Lawrence W. Greene, Esq.  
COWAN, LIEBOWITZ & LATMAN, PC  
1133 Avenue of the Americas  
New York, NY 10036



Don Finkelstein  
Date: July 8, 2009