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Filing date: **10/09/2009**

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

Proceeding	91189287
Party	Plaintiff TechSmith Corporation
Correspondence Address	James R. Duby, Jr. DUBY & ASSOCIATES, PLC 3511 Coolidge RoadSuite 200 East Lansing, MI 48823 UNITED STATES Jim@Dubylaw.com
Submission	Motion to Suspend for Settlement Discussions
Filer's Name	James R. duby, Jr.
Filer's e-mail	Jim@Dubylaw.com
Signature	/James R. Duby, Jr./
Date	10/09/2009
Attachments	Combined Motion for Suspension and Extension Snag-It 100909.pdf ( 9 pages ) (567938 bytes )

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

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TECHSMITH CORPORATION

Opposer

v.

TIMOTHY WHITEHURST,

Applicant.

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Opposition No: **91189287**  
Serial No.: 77/505,306  
Mark: SNAG-IT  
International Class: 28  
Published: Nov. 18, 2008

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Box TTAB  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**OPPOSER'S COMBINED MOTION AND BRIEF FOR REQUEST FOR  
SUSPENSION AND EXTENSION OF TIME TO RESPOND TO APPLICANT'S  
WRITTEN DISCOVERY REQUESTS**

Pursuant to 37 C.F.R. §2.117(c) and Trademark Rule 2.117(c), and 37 C.F.R. §2.120(a)(3) and Trademark Rule 2.120(a)(3), Opposer, TECHSMITH CORPORATION, files this motion to respectfully request the Trademark Trial and Appeal Board ("TTAB") to suspend the proceedings for purposes of settlement negotiations and extend the time for Opposer to respond to Applicant's written discovery requests by a period of 60 days from date of resumption of the proceedings, if the matter is not settled; or in the alternative, if the Motion for Suspension is not granted, the time to respond to the Applicant's discovery requests be extended 60 days from the of date of the ruling is issued on the present combined Motion.

The grounds for this combined Motion are as follows:

1. On July 15, 2009, Opposer, after a conversation with Applicant's counsel (hereinafter referred to throughout as "Applicant") regarding a possible settlement for this opposition proceeding, prepared and forwarded to Applicant a draft Coexistence Agreement, **Exhibit A** Declaration of James R. Duby, Jr. in support of Opposer's Combined Motion for Suspension and Extension of Time to Respond to Applicant's Discovery Requests (the "Duby Decl." ¶ 2).

2. On August 10, 2009, Applicant via e-mail advised Opposer that Applicant did not agree to the Coexistence Agreement in its present form but that it will respond to Opposer with a revised Agreement. Duby Decl. ¶ 3.

3. On or about August 21, 2009, Applicant advised Opposer that Applicant has not prepared a revised Coexistence Agreement at this time. Duby Decl. ¶ 4.

4. On September 4, 2009, Applicant served Opposer, via first-class mail, Applicant's First Set of Interrogatories, First Request For Production of Documents and Things, and First Set of Requests For Admission. Pursuant to Trademark Rule 2.119, Opposer's responses to these written voluminous discovery requests are due up to and including October 9, 2009.

5. In the meantime, Opposer, however, has continued to correspond with Applicant regarding a possible settlement for this opposition proceeding. Although Applicant has indicated that it does not agree with Opposer's original draft Coexistence Agreement, the Applicant via e-mail on September 24, 2009 indicated that the Applicant is willing to negotiate the terms and conditions of a

Coexistence Agreement. Toward that end, on September 24, 2009, Opposer advised the Applicant via e-mail to feel free to forward proposed revisions to the Opposer's Coexistence Agreement and Opposer will certainly consider accommodating the same. Duby Decl. ¶¶ 5 and 6.

6. On October 2, 2009, Opposer served Applicant with Opposer's Responses to Applicant's First Set of Request for Admission. However, Opposer's responses to Applicant's First Set of Interrogatories and First Request For Production of Documents remain pending and Opposer requested to discuss via phone with Applicant these additional discovery requests. Duby Decl. ¶ 7.

7. On October 2, 2009 via e-mail, the Applicant requested that Opposer e-mail the Applicant regarding its questions or comments regarding the discovery requests. Duby Decl. ¶ 8.

8. On or about October 8, 2009 Opposer via e-mail to the Applicant reiterated that it is open to reviewing any proposed revisions that Applicant may suggest to the proposed Coexistence Agreement forwarded to the Applicant in order to determine if Opposer is in a position to accommodate the same and thereby bring this matter to an amicable close. In addition, the Opposer requested that the Applicant consent to an extension of time to respond to Applicant's discovery requests to avoid the unnecessary time and expense that would be associated with the same, in order to give the parties additional time to

negotiate and finalize a Coexistence Agreement in or order to settle this matter.<sup>1</sup>

Duby Decl. ¶ 9.

9. On or about October 8, 2009, Applicant advised Opposer via e-mail that although Applicant will not agree to an extension of time regarding the discovery responses due October 9, 2009, Applicant hopes to send Opposer a revised Coexistence Agreement early next week so that the parties may continue discussions regarding said agreement. Duby Decl. ¶ 10.

10. Based on the foregoing, Opposer respectfully requests that these proceedings be hereby suspended and the time period for Opposer to respond to Applicant's written discovery requests be extended for sixty (60) days from the date of resumption of these proceeding, if the matter is not settled; or in the alternative, if the Motion for Suspension is not granted, the time to respond to the Applicant's discovery requests be extended 60 days from the of date of the ruling is issued on the present combined Motion.

11. Opposer has shown good cause for this combined Motion given that: (a) Opposer has a good faith belief that settlement negotiations are ongoing; (b) Opposer attempted to seek consent for an extension of time to respond to Applicant discovery requests; and (c) the combined Motion for suspension and

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<sup>1</sup> This is the first time Opposer has made any such request to Applicant. Given the particulars of the settlement discussions and the TTAB's expectation of cooperation and good faith between the parties, Applicant's lack of consent to this request, questions Applicant's attempt to comply with the TTAB's expectation.

extension is not for the purposes of delay, but rather to give the parties additional time to negotiate and/or finalize an agreement between the parties.

Respectfully submitted,

Dated: October 9, 2009

By: 

James R. Duby, Jr.  
DUBY & ASSOCIATES, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823  
Phone: (517) 371-9835  
Fax : (517) 371-9840  
E-mail: Jim@Dubylaw.com

ATTORNEY FOR OPPOSER, TECHSMITH  
CORPORATION

**CERTIFICATE OF SERVICE**

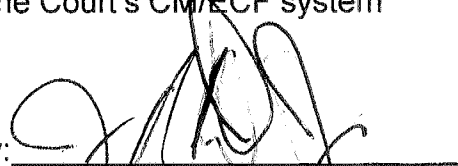
I hereby certify that on October 9, 2009, I caused to be served **OPPOSER'S COMBINED MOTION AND BRIEF FOR REQUEST FOR SUSPENSION AND EXTENSION OF TIME TO RESPOND TO APPLICANT'S WRITTEN DISCOVERY REQUESTS** the following parties at the following addresses:

Robert L. Powley  
James M. Gibson  
POWLEY & GIBSON P.C.  
304 Hudson Street, 2<sup>nd</sup> Floor  
New York, NY 10013  
Telephone: (212) 226-5054  
Facsimile: (212) 226-5085

By:

- U.S. Postal Service, ordinary first class mail
- U.S. Postal Service, certified or registered mail,
- Return receipt requested
- Hand delivery
- Facsimile
- Electronic service via the Court's CM/ECF system
- Other (specify) E-mail

By:



James R. Duby, Jr.  
DUBY & ASSOCIATES, PLC  
3511 Coolidge Road, Suite 200  
East Lansing, MI 48823

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

In the matter of  
Trademark Application Serial No. 77/505306  
Mark: SNAG-IT

_____	)	
TechSmith Corporation,	)	
Opposer,	)	
vs.	)	Opposition No.
	)	91189287
Timothy Whitehurst,	)	
Applicant.	)	
_____	)	

TTAB BOX NO FEE  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**DECLARATION OF JAMES R. DUBY, JR. IN SUPPORT OF  
OPPOSER'S COMBINED MOTION FOR SUSPENSION AND  
EXTENSION OF TIME TO RESPOND TO APPLICANT'S WRITTEN  
DISCOVERY REQUESTS**

I, James R. Duby, Jr., declare as follows:

1. I am counsel for the Opposer in this matter, TechSmith Corporation ("TechSmith").
2. On July 15, 2009, after a conversation with Applicant's counsel Jason Kasner regarding a possible settlement for this opposition proceeding, I prepared and forwarded to Mr. Kasner and his legal assistant Michelle K. Riley, a draft Coexistence Agreement.
3. On August 10, 2009, I received from Michelle K. Riley an e-mail indicating "Our client has asked that we communicate to you that the



agreement, in its present form, cannot be signed by him. Mr. Whitehurst has indicated that he will respond to TechSmith with a revised agreement but will not be able to do so until After August 14, 2009.”

4. In response to my August 17, 2009 e-mail, on August 21, 2009, I received an e-mail from Michelle K. Riley indicating that “Our client has asked us to communicate that he does not have a revised Coexistence Agreement at this time.”

5. On September 24, 2009, although I had not received a proposed revised Coexistence Agreement as of yet, I forwarded an e-mail to Michelle K. Riley with copy to Robert L. Powley and James A. Gibson indicating to feel free to forward us proposed revisions to the Coexistence Agreement and we will certainly consider accommodating the same.

6. On September 24, 2009, I received an e-mail from the Michelle K. Riley indicating although the Applicant does not agree with the original draft Coexistence Agreement, “...our client is willing to negotiate the terms and conditions.”

7. On October 2, 2009, I served Applicant with Opposer's Responses to Applicant's First Set of Request for Admission. However, Opposer's responses to Applicant's First Set of Interrogatories and First Request For Production of Documents remain pending and I forwarded to the Michelle K. Riley with copy to Robert L. Powley, James M. Gibson and Jason Kasner an e-mail requesting to discuss via phone the Applicant's additional discovery requests.

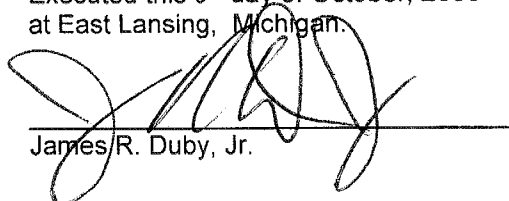
8. On October 2, 2009, I received an e-mail from the Michelle K. Riley indicating "With respect to discussion you wish to have regarding Mr. Whitehurst's additional discovery requests, please send us an email containing your questions and/or comments."

9. On October 8, 2009, I e-mailed Margarita Wallach and Michelle K. Riley to reiterate that the TechSmith is open to reviewing any proposed revisions that the their client may suggest to the proposed Coexistence Agreement forwarded to them in order to determine if TechSmith is in a position to accommodate the same and thereby bring this matter to an amicable close. In addition, I requested their consent to an extension of time to respond to Applicant's discovery requests to avoid the unnecessary time and expense that would be associated with the same, in order to give the parties additional time to negotiate and finalize a Coexistence Agreement to be entered into between the parties.

10. On October 8, 2009, I received an e-mail from Michelle K. Riley indicating "...our client will not agree to an extension of time regarding the discovery responses due October 9, 2009. However, we hope to send you a revised coexistence agreement early next week so that the parties may continue discussions regarding said agreement."

I declare under penalty of perjury and under the laws of the United States that the foregoing is true and correct.

Executed this 9<sup>th</sup> day of October, 2009  
at East Lansing, Michigan.



James R. Duby, Jr.