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Filing date: **10/23/2009**

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

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|---------------------------|--|
| Proceeding | 91189287 |
| Party | Defendant Whitehurst, Timothy |
| Correspondence Address | Robert L. Powley Powley & Gibson, P.C. 304 Hudson St., 2nd fl. New York, NY 10013 UNITED STATES Trademarks@powleygibson.com |
| Submission | Opposition/Response to Motion |
| Filer's Name | James M. Gibson |
| Filer's e-mail | trademarks@powleygibson.com |
| Signature | /JMG/ |
| Date | 10/23/2009 |
| Attachments | Applicant's reply 10.23.09.pdf (12 pages)(514132 bytes) |

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

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| TechSmith Corporation, | : | | |
| | : | | |
| Opposer, | : | Opposition No: | 91189287 |
| | : | Serial No.: | 77/505306 |
| v. | : | Mark: | SNAG-IT |
| | : | International Class: | 28 |
| Timothy Whitehurst, | : | Published: | November 18, 2008 |
| | : | | |
| Applicant. | : | | |
| -----X | : | | |

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

**APPLICANT’S REPLY IN OPPOSITION TO 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 CFR § 2.127 and 37 CFR § 2.120(a), Timothy Whitehurst (“Applicant”), by his attorneys, Powley & Gibson, P.C., hereby responds to TechSmith Corporation’s (“Opposer”) Combined Motion and Brief for Request for Suspension and Extension of Time to Respond to Applicant’s Written Discovery Requests. Applicant respectfully requests that the Trademark Trial and Appeal Board (“TTAB”) deny Opposer’s Request for Suspension and Extension of Time and order Opposer to immediately respond to Applicant’s discovery requests. Applicant also respectfully requests that all of Applicant’s deadlines as currently set in the trial schedule issued on March 16, 2009 be reset accordingly upon the TTAB’s resolution of this motion.

Opposer commenced the above-captioned Opposition on March 18, 2009. Although Applicant served discovery requests on Opposer on September 4, 2009, Opposer has not yet

served any discovery requests on Applicant. Additionally, Opposer waited until the last day to respond to Applicant's discovery requests and then, without responding, filed its Motion and Brief for Request for Suspension and Extension of Time to Respond to Applicant's Written Discovery Requests.

In fact, Opposer's Request for Suspension is moot, as Applicant requests the TTAB not suspend this proceeding. Contrary to Opposer's insinuations in its moving papers that the parties are actively engaging in settlement discussions, Applicant has repeatedly informed Opposer that Applicant was not willing to consider Opposer's proposed terms of settlement. Opposer's moving papers deliberately mislead the TTAB in an attempt to suggest settlement discussions are ongoing and that an extension of time is warranted, when in fact, suspension was never discussed between the parties and Applicant never intended to have the proceedings suspended.

Finally, Opposer's Motion for Additional Time to Respond to Applicant's Discovery should be denied as it was Opposer's own lack of diligence and unreasonable delay in taking the proper actions during the time previously allotted therefor which resulted in Opposer's need to file this Motion.

PROCEDURAL BACKGROUND

On May 22, 2009, the parties held a discovery conference and discussed the possibility of entering into a co-existence agreement. See attached Declaration of Michelle Riley ("Riley Decl." ¶2). On July 15, 2009, Opposer sent Applicant a proposed co-existence agreement. This agreement was unacceptable to Applicant, and Applicant informed Opposer on August 21, 2009 that the proposed agreement was unacceptable. Riley Decl. ¶3. Therefore, Opposer knew at least as early as August 21, 2009 that there were potential problems with settlement. Riley Decl. ¶4. Applicant communicated to Opposer on several occasions that Opposer's proposed agreement

was not acceptable to Applicant. Riley Decl. ¶5. On September 4, 2009, Applicant served Applicant's First Set of Requests for Admissions, Applicant's First Request for Production of Documents and Things, and Applicant's First Set of Interrogatories on Opposer. Riley Decl. ¶6. Opposer did not respond to Applicant's Document Requests or Interrogatories. Riley Decl. ¶7. On October 8, 2009, the day before which Opposer's responses to Applicant's discovery requests were due, Opposer sought Applicant's consent to a 60-day extension of time within which to respond to Applicant's written discovery requests. Riley Decl. ¶8. Applicant informed Opposer that it would not consent to an extension, and Applicant has informed Opposer in writing that it is not interested in pursuing settlement, at least at this time. Riley Decl. ¶8, and see email of October 19, 2009, attached hereto as Exhibit A.

ARGUMENT

I. Suspension is Moot

At this point in time, Applicant has informed Opposer that it is not interested in settlement with Opposer. There are no settlement discussions occurring between the parties at this time. In which case, Suspension for this reason is moot. See Exhibit A.

II. Opposer Has the Burden of Establishing "Good Cause"

In order to succeed with its Motion for Request for Suspension and Extension of Time to Respond to Applicant's Written Discovery Requests, Opposer must meet its burden of establishing "good cause." Opposer has failed demonstrate "good cause" for an extension of time to respond to Applicant's discovery requests. "A Motion to Extend Time must set forth with particularity the facts said to constitute good cause for the requested extension; mere conclusory allegations lacking in factual detail are not sufficient." (Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 509.01. See, e.g., *Fairline Boats plc v. New Howmar Boats*

Corp., 59 USPQ2d 1479, 1480 (TTAB 2000) (motion to extend the testimony period denied where party failed to provide detailed information regarding apparent difficulty in identifying and scheduling its witnesses for testimony and here sparse motion, containing vague reference to possibility of settlement, demonstrated no expectation that proceedings would not move forward during any such negotiations); *Instruments SA Inc. v. ASI Instruments Inc.*, 53 USPQ2d 1925, 1927 (TTAB 1999) (cursory or conclusory allegations that were denied unequivocally by the nonmovant and were not otherwise supported by the record did not constitute a showing of good cause); *Luemme, Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758 (TTAB 1999) (sparse motion to extend the discovery period contained insufficient facts on which to find good cause).

Opposer knew at least as early as August 21, 2009 that there were potential problems with settlement. Riley Decl. ¶4. Applicant communicated to Opposer on several occasions that Opposer's proposed agreement was not acceptable to Applicant. Riley Decl. ¶5. Yet Opposer's Motion proffers little more than Opposer's belief that settlement negotiations were ongoing as its reason for requesting an extension. The TTAB has ruled that the claim of settlement negotiations, rebutted by the other party, is not sufficient to grant an extension of time. See *Instruments SA Inc. v. ASI Instruments, Inc.*, supra (motion to extend the close of the discovery period and to reset trial dates because of plaintiff's claim of ongoing bilateral settlement negotiations was rebutted by defendant, and no other reason for plaintiff's failure to proceed with discovery was shown); *Luemme, Inc. v. D.B. Plus Inc.*, supra (motion to extend the discovery period denied because plaintiff failed to set forth detailed facts concerning the circumstances -- plaintiff's allegedly busy travel schedule -- which necessitated the extension, and record showed that need for extension in fact resulted from plaintiff's delay and lack of diligence during previously-set discovery period). Because of Opposer's failure to show good cause for

requesting its Motion for Request for Suspension and Extension of Time to Respond to Applicant's Written Discovery Requests, Opposer's Motion should be denied.

III. Opposer Waited Until the Last Day to File the Motion

Opposer's Motion for Request for Suspension and Extension of Time to Respond to Applicant's Written Discovery Requests should be denied because it is well-settled that "proceedings are not suspended automatically when parties are discussing settlement and a party which fails to timely move for extension or suspension of dates on the basis of settlement does so at its own risk." *Old Nutfield Brewing Company, Inc.* 65 USPQ2d 1701 (TTAB 2002). Applicant served Applicant's First Set of Requests for Admissions, Applicant's First Request for Production of Documents and Things, and Applicant's First Set of Interrogatories on Opposer on September 4, 2009. Riley Decl. ¶6. Opposer waited until October 8, 2009, the day before responses were due to Applicant, to request consent from Applicant for an extension of time by which to file its discovery responses. Riley Decl. ¶8. When consent was not granted, Opposer filed its Request for Suspension and Extension of Time. Opposer offers no viable reason for its failure to respond to Applicant's discovery requests before the October 9, 2009 deadline. Under these circumstances, Opposer's Motion for Request for Suspension and Extension of Time to Respond to Applicant's Written Discovery Requests should be denied, and Opposer should be ordered to immediately provide proper responses to Applicant's discovery requests and produce all non-privileged responsive documents as soon as possible.

IV. Opposer Fails to Offer Any Support for Its Request for a Sixty-day Extension of Time

Opposer's Motion for Request for Suspension and Extension of Time to Respond Applicant's Written Discovery Requests asks for a sixty-day suspension of proceedings or a sixty-day extension of time to respond to Applicant's discovery requests, yet nowhere in its

Motion does Opposer proffer any reason for requesting twice the amount of time allowed to respond to discovery requests pursuant to the Federal Rules of Civil Procedure. Opposer's tactic in asking for so much time is obviously an attempt to delay the proceedings.

V. It Was Never Applicant's Intent to Suspend or Extend Opposer's Time to Respond Based on Limited Settlement Negotiations

Throughout the discovery period, Opposer was made aware, through repeated correspondence with Applicant, that Applicant would not sign the proposed co-existence agreement drafted by Opposer due to its one-sided nature in favor of Opposer. Riley Decl. ¶5. Never once was the subject of extensions or suspensions discussed between the parties before October 8, 2009, and Applicant never intended to consent to either.

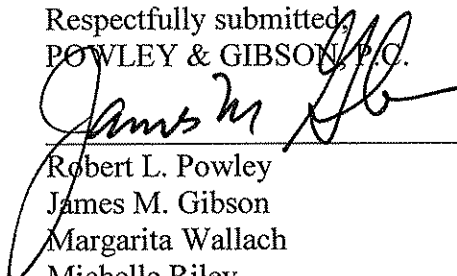
CONCLUSION

Based on the foregoing, Applicant respectfully requests that the TTAB deny Opposer's Motion for Request for Suspension and Extension of Time to Respond to Applicant's Written Discovery Requests and order Opposer to immediately provide proper responses to Applicant's discovery requests and produce all non-privileged responsive documents as soon as possible. Applicant also respectfully requests that all of Applicant's deadlines as currently set in the trial schedule issued on March 16, 2009 be reset accordingly upon the TTAB's resolution of this motion.

Dated: October 23, 2009
New York, New York

Respectfully submitted,
POWLEY & GIBSON, P.C.

By:



Robert L. Powley
James M. Gibson
Margarita Wallach
Michelle Riley

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(212) 226-5054 (phone)
(212) 226-5085 (fax)

Attorneys for Applicant Timothy Whitehurst

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of Applicant's Reply In Opposition To Opposer's Combined Motion And Brief For Request For Suspension And Extension Of Time To Respond To Applicant's Written Discovery Requests was served by first-class mail, postage prepaid, on October 28, 2009, upon the following:

James R. Duby, Jr.
Duby & Associates, PLC
3511 Coolidge Road, Suite 200
East Lansing, MI 48823
(517) 371-9835

ATTORNEY FOR OPPOSER

The undersigned also certifies that Applicant's Reply In Opposition To Opposer's Combined Motion And Brief For Request For Suspension And Extension Of Time To Respond To Applicant's Written Discovery Requests is being transmitted to the United States Patent and Trademark Office Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated above.



Irma Crespo

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

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**DECLARATION OF MICHELLE K. RILEY IN SUPPORT OF APPLICANT'S
REPLY IN OPPOSITION TO OPPOSER'S COMBINED MOTION AND
BRIEF FOR REQUEST FOR SUSPENSION AND EXTENSION OF TIME
TO RESPOND TO APPLICANT'S WRITTEN DISCOVERY REQUESTS**

Michelle K. Riley declares the following to be true under the penalties of perjury:

1. I have first-hand knowledge of the facts herein and submit this declaration in support of Applicant's Reply In Opposition To Opposer's Combined Motion And Brief For Request For Suspension And Extension Of Time To Respond To Applicant's Written Discovery Requests.
2. On May 22, 2009, Jason Kasner, James Duby and I held a discovery conference by telephone and discussed the possibility of the Applicant and Opposer entering into a co-existence agreement.

3. On July 15, 2009, Opposer sent Applicant a proposed co-existence agreement. This agreement was unacceptable to Applicant, and Applicant informed Opposer on August 21, 2009 that the proposed agreement was unacceptable.
4. Opposer knew at least as early as August 21, 2009 that there were potential problems with settlement.
5. Applicant's attorneys communicated to Opposer on several occasions that Opposer's proposed agreement was not acceptable to Applicant.
6. On September 4, 2009, Applicant served Applicant's First Set of Requests for Admissions, Applicant's First Request for Production of Documents and Things, and Applicant's First Set of Interrogatories on Opposer.
7. To date, Opposer has not responded to Applicant's Document Requests or Interrogatories.
8. On October 8, 2009, the day before which Opposer's responses to Applicant's discovery requests were due, Opposer sought Applicant's consent to a 60-day extension of time within which to respond to Applicant's written discovery requests. Applicant's attorneys informed Opposer that Applicant would not consent to an extension.

Dated: October 23, 2009
New York, New York

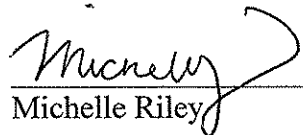

Michelle Riley

EXHIBIT A

Michelle K. Riley

From: Michelle K. Riley
Sent: Monday, October 19, 2009 9:40 AM
To: 'James R. Duby, Jr.'
Cc: Robert L. Powley; James M. Gibson
Subject: TechSmith Corporation's Opposition No. 91189287 to the trademark SNAG-IT (Our Ref: 394.1)

Dear Mr. Duby:

We write in reference to TechSmith Corporation's Opposition No. 91189287 to the trademark SNAG-IT. We received copies of the motion papers you filed with the Trademark Trial and Appeal Board on October 13, 2009, and in our opinion, you have misrepresented the communications between our firm and yourself in your filing. Accordingly, we are in the process of preparing a response thereto.

Additionally, our client is no longer willing to participate in any further settlement negotiations, and will not be sending a proposed coexistence agreement to TechSmith.

Regards,

Michelle Riley

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Powley & Gibson, P.C., 304 Hudson Street, 2nd Floor, New York, New York 10013.