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

Proceeding	91203686
Party	Plaintiff Hollywood Casino Corporation
Correspondence Address	HARA K JACOBS BALLARD SPAHR LLP 1735 MARKET STREET, 51ST FLOOR PHILADELPHIA, PA 19103 7599 UNITED STATES jacobsh@ballardspahr.com, larsont@ballardspahr.com, sternam@ballardspahr.com, cramerp@ballardspahr.com, phila_tmddocketing@ballardspahr.com
Submission	Reply in Support of Motion
Filer's Name	Hara K. Jacobs
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Signature	/Hara K. Jacobs/
Date	03/27/2014
Attachments	Reply In Support of Motion for Extension of Deadlines and Leave to Amend.pdf(38114 bytes ) Scan-005.pdf(101394 bytes )

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

Hollywood Casinos, LLC,	:	
	:	
Opposer,	:	
	:	
v.	:	
	:	Opposition No. 91203686
	:	
Chateau Celeste, Inc.	:	
	:	
Applicant.	:	

**REPLY BRIEF IN SUPPORT OF MOTION FOR EXTENSION  
OF ALL DEADLINES AND FOR LEAVE TO AMEND**

Opposer, Hollywood Casinos, LLC (“Opposer”), respectfully submits this Reply in Support of its combined Motion for Extension of All Deadlines and for Leave to Amend.

**I. PRELIMINARY STATEMENT**

Applicant has drawn this proceeding out by repeatedly initiating settlement discussions, only to ultimately renege when those discussions concluded with a mutual agreement on settlement. Between the first initiation of settlement discussions, and the Board’s denial of Opposer’s motion to enforce the resulting settlement, Opposer was reasonably hopeful that compromise rather than litigation would resolve the dispute. It did not; and now the proceeding must resume on a path of litigation. Accordingly, Opposer has asked the Board for an extension of all deadlines by 90 days and to allow it to add a claim that the opposed mark is descriptive.

Applicant has opposed Opposer’s motion to extend discovery and to amend its Notice of Opposition contending that Applicant will suffer prejudice because it will be required, for the first time in this proceeding, to actually participate in discovery and defend its Application on the merits. Applicant’s position is groundless. First, Applicant has no basis to

object to an extension of the discovery period. Applicant refused to agree on a date for the parties to exchange discovery responses for nearly three weeks, resulting in seven emails from Opposer's counsel on this topic. (Ex. A, Jacobs-Fattahi Feb. 21 – 25 E-mail Exchange; Ex. B, Jacobs-Fattahi Mar. 6 – 11 E-mail Exchange) (redacted to omit Applicant's settlement overtures). When Applicant did finally agreed on a date (and only after attempting to use settlement to stall discovery yet again), Applicant chose a date over a month past the discovery deadline. (Ex. B, Jacobs-Fattahi Mar. 6 – 11 E-mail Exchange.) Applicant's purposeful decision to delay serving its discovery responses until well after the expiration of discovery demonstrates that its claim of prejudice is fallacious. Second, Applicant's opposition to Opposer's motion to amend is equally baseless because it rests on a premise that has been repeatedly rejected by the Board, namely, that having to litigate an additional claim is, in itself, prejudicial. The Board has repeatedly held that an amendment to add a claim is not prejudicial merely because the party must defend the claim. Because Opposer's proposed additional claim of descriptiveness is well-plead, timely and not prejudicial, Opposer's motion should be granted.

## **II. ARGUMENT**

### **A. Applicant's Own Conduct Demonstrates Why Opposer's Motion for an Extension of Time Should Be Granted**

Applicant's position that the deadlines for the proceeding should not be extended is hypocritical and unjustified. Throughout this proceeding, Opposer has patiently agreed to Applicant's many requests for extensions of time to respond to discovery for Applicant's stated purpose of exploring settlement. Now that Applicant has withdrawn from the parties' settlement, Applicant is attempting to dramatically curtail the discovery process. Applicant's gamesmanship is profoundly unfair.

Immediately after the Board's decision denying Opposer's motion to enforce the parties' settlement, Opposer renewed its request for Applicant to agree to a date to exchange responses to interrogatories and document requests. (Ex. A, Jacobs-Fattahi Feb. 21 – 25 E-mail Exchange; Ex. B, Jacobs-Fattahi Mar. 6 – 11 E-mail Exchange) (redacted to omit Applicant's settlement overtures). Applicant studiously avoided agreeing to a date for the exchange of discovery responses. Id. From February 21 through March 11, Opposer's counsel sent Applicant's counsel seven emails asking for a mutually agreeable date to exchange discovery. Id. After nearly three weeks (and after the close of the current discovery period), Applicant's counsel finally responded. (Ex. B, Fattahi Mar. 11 E-mail.) Applicant unilaterally selected a date more than a month *after* the current close of discovery. Id. Applicant's decision not to begin responding to discovery until well after the discovery deadline demonstrates that its opposition to a discovery extension is entirely hypocritical. For this reason alone, Opposer's motion for a 90-day extension of discovery should be granted.

Moreover, Opposer's claimed basis for opposing an extension of discovery is purported prejudice that does not exist and has been expressly rejected by the Board. Applicant argues that it will suffer prejudice because it will have to spend more time and resources to "face additional and broadened discovery," and it is "a smaller hotel business" and "is of much more limited financial means [than Opposer]." As a legal matter, the fact that a party has to spend time and money to answer discovery, or that one party has less means than another, is simply not recognized by the Board as prejudicial. See Reed Elsevier Properties, Inc. v. Linguistic Electronic System, 2001 WL 1298839 \*2 (TTAB 2001). As a factual matter, Applicant's argument is baseless because, thus far, Applicant has expended virtually no time or resources on discovery because of the multitude of discovery extensions that Applicant requested to

purportedly pursue settlement. Opposer's requested extension will not place any *additional* discovery burden on either party. Therefore, the Board should grant the requested extension.

**B. Opposer's Motion to Amend Should Be Granted Because the Amendment is Well-Plead, Timely and Will Not Prejudice Applicant**

The Board should grant Opposer's motion to amend because Applicant does not dispute that the amendment is well-plead and Applicant has not presented a single legitimate reason for why the amendment or its timing is unduly prejudicial to it. See TBMP § 507.02 (stating that the Board liberally grants leave to amend pleadings at any stage of the proceedings when justice so requires, unless entry of the proposed amendment would violate settled law or would be prejudicial to the adverse party).

1. Opposer's Amendment Will Not Prejudice Applicant

Applicant does not identify a single reason for why the timing of Opposer's motion would prejudice Applicant; nor could it. There is no prejudice to Applicant from the timing of the Motion to Amend because the case is still in its early stages. The parties have not participated in discovery yet. Indeed, only since Opposer filed the instant motion has Applicant even agreed to exchange discovery responses on April 8, 2014. Moreover, the evidence relevant to the claim that the mark has not acquired distinctiveness is in Applicant's control. And, because there are no pending dispositive motions, there is also no risk of needlessly prolonging the case. Nor has Applicant shown or even suggested that witnesses or evidence have become unavailable as a result of the timing.

Instead, Applicant argues that the amendment would cause prejudice because it would "introduce a wholly new allegation as a basis for the opposition." But, an amendment to add a claim is not prejudicial merely because it requires a party to defend the claim. See Johnson & Johnson v. Cenco Med./Health Supply Corp., 177 U.S.P.Q. 586 (TTAB 1973) ("With regard

to applicant's claim of prejudice by the amendment, no prejudice, except that inherent in any amendment, has been shown."'). Applicant points to no prejudice that it will suffer as a result of the amendment other than having to defend against the new claim, which is not prejudice as a matter of law. Because Opposer's Motion to Amend is undisputedly well-pled, and Applicant can offer no legitimate reason for why the amendment or its timing would be unduly prejudicial to it, the Board should grant Opposer's Motion.

2. Opposer's Motion to Amend is Timely

Applicant contends that Opposer's Motion to Amend, filed during the discovery period and before Applicant has responded to any discovery requests, should be denied on the sole ground that it is allegedly untimely. Applicant is incorrect on both the law and facts. The timing of a motion to amend is not an independent basis for denying the motion. TBMP § 507.02(a); Commodore Electronics Limited v. CBM Kabushiki Kaisha, 26 U.S.P.Q.2d 1503, 1505 (TTAB 1993). A motion to amend will only be denied if the timing results in undue prejudice to the Applicant. Id. As discussed supra, Applicant will not be prejudiced by Opposer's motion to amend and, indeed, Applicant has not articulated any such prejudice.

Moreover, Opposer's motion is timely because it was filed immediately after efforts to effectuate the parties' settlement were exhausted. The Board encourages settlement discussions. TBMP § 510.03(a); Reed Elsevier, 2001 WL 1298839 at \*2. Aggressively pursuing litigation and settlement at the same time is often counter-productive. Settlement is about accepting compromise as an alternative to the expense and uncertainty of litigation. Requesting an amendment (or otherwise pursuing a party's claims) during settlement negotiations could derail progress by requiring the parties to refocus their efforts and resources on litigation instead of compromise. This is precisely why the Board allows for the suspension of a proceeding for the purpose of settlement. TBMP § 510.03(a). Accordingly, delay will not

preclude an amendment where the delay was the result of viable, good-faith settlement discussions, and the proceeding remained at an early stage. See, e.g., Jimmy Buffett v. Chi – Chi’s, Inc., 226 USPQ 428, 431 (TTAB 1985); Reed Elsevier, 2001 WL 1298839 (TTAB 2001).

Here, settlement discussions (and a resulting dispute over whether a settlement had, in fact, occurred) accounts for timing of Opposer’s motion to amend. The parties were engaged in settlement discussions from the start of the proceeding. Since then, the proceeding has been extended and suspended ten times—each time at Applicant’s request, and each time for the purpose of exploring or formalizing settlement. Despite the prolonged nature of the settlement discussions, they were not only viable, but ultimately successful from Opposer’s perspective. Though the Board denied Opposer’s Motion to Enforce the Settlement Agreement, Opposer reasonably believed the proceeding was settled. Indeed, had the Board granted the Motion to Enforce the Settlement Agreement, there would be no need to amend the Notice of Opposition. Opposer requested the amendment within days of the Board’s decision that denied Opposer’s motion to enforce the parties’ settlement.

There is also no evidence (or even a suggestion) of any dilatory motive by Opposer in requesting the amendment after the parties’ settlement discussions and resulting settlement dispute concluded. Indeed, it was Applicant who initiated and re-initiated the parties’ settlement discussions throughout the proceeding (including after the Board’s most recent decision), and who requested the multiple extensions of time to do so. Accordingly, Applicant’s suggestion that Opposer’s amendment is untimely is entirely without merit.

### **CONCLUSION**

For the foregoing reasons, and those in its Motion for Extension of All Deadlines and for Leave to Amend, Opposer respectfully requests that the Board extend all deadlines by

ninety (90) days from the date of the Board's Order, and grant leave to Opposer to file Opposer's Proposed First Amended Notice of Opposition, attached to its Motion as Exhibit A. Opposer further restates its request that Board suspend the Proceeding pending the disposition of the instant Motion.

Dated: March 27, 2014

Respectfully submitted,

By: /Hara K. Jacobs/  
Hara K. Jacobs  
Troy E. Larson  
BALLARD SPAHR LLP  
1735 Market Street, 51st Floor  
Philadelphia, Pennsylvania 19103-7599  
(215) 665-8500

ATTORNEYS FOR OPPOSER



**CERTIFICATE OF SERVICE**

I, Troy E. Larson, hereby certify that on today's date, I caused a copy of the foregoing  
REPLY BRIEF IN SUPPORT OF MOTION FOR EXTENSION OF ALL DEADLINES AND  
FOR LEAVE TO AMEND to be served by e-mail, pursuant to prior agreement between counsel  
for the parties, on Applicant's counsel as set forth below:

KAMRAN FATTAHI, ESQ.  
LAW OFFICES OF KAMRAN FATTAHI  
15303 VENTURA BLVD SUITE 900  
SHERMAN OAKS, CA 91403  
[Kamran@FattahiLaw.com](mailto:Kamran@FattahiLaw.com)

Dated: March 27, 2014

/Troy E. Larson/  
\_\_\_\_\_  
Troy E. Larson

# EXHIBIT A

**Larson, Troy (Phila)**

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**From:** Kamran Fattahi <Kamran@FattahiLaw.com>  
**Sent:** Tuesday, February 25, 2014 2:36 PM  
**To:** Jacobs, Hara K. (Phila)  
**Cc:** Larson, Troy (Phila)  
**Subject:** RE: HOLLYWOOD HOTEL - Outstanding Discovery

Hara,

I am still trying to speak with my client, and will get back to you as soon as I can.

Regards,  
Kamran  
Law Offices of Kamran Fattahi  
Tel: 818-205-0140

**From:** Jacobs, Hara K. (Phila) [mailto:JacobsH@ballardspahr.com]  
**Sent:** Monday, February 24, 2014 8:21 PM  
**To:** 'Kamran Fattahi'  
**Cc:** Larson, Troy (Phila)  
**Subject:** RE: HOLLYWOOD HOTEL - Outstanding Discovery

Kamran,

I did not hear from you today. We intend to file our motion to amend tomorrow and need to know whether you will agree to an extension of the discovery period. Additionally, the parties need to agree on the time frame for exchanging their discovery responses.

I look forward to hearing from you.

Regards,

Hara

---

**Hara K. Jacobs**  
Ballard Spahr LLP  
1735 Market Street  
51st Floor  
Philadelphia, PA 19103-7599  
Direct: 215.864.8209  
Fax: 215.864.8999  
[jacobsh@ballardspahr.com](mailto:jacobsh@ballardspahr.com) | [www.ballardspahr.com](http://www.ballardspahr.com)

**From:** Kamran Fattahi [mailto:Kamran@FattahiLaw.com]  
**Sent:** Friday, February 21, 2014 5:02 PM  
**To:** Jacobs, Hara K. (Phila)  
**Cc:** Larson, Troy (Phila)  
**Subject:** RE: HOLLYWOOD HOTEL - Outstanding Discovery

Hara,

I am unable to reach my client at this time, and will try to do so on Monday. I will get back to you as soon as possible.

Regards,  
Kamran  
Law Offices of Kamran Fattahi  
Tel: 818-205-0140

**From:** Jacobs, Hara K. (Phila) [<mailto:JacobsH@ballardspahr.com>]  
**Sent:** Friday, February 21, 2014 12:33 PM  
**To:** 'Kamran Fattahi'  
**Cc:** Larson, Troy (Phila)  
**Subject:** RE: HOLLYWOOD HOTEL - Outstanding Discovery

Two weeks from today?

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**Hara K. Jacobs**  
Ballard Spahr LLP  
1735 Market Street  
51st Floor  
Philadelphia, PA 19103-7599  
Direct: 215.864.8209  
Fax: 215.864.8999  
[jacobsh@ballardspahr.com](mailto:jacobsh@ballardspahr.com) | [www.ballardspahr.com](http://www.ballardspahr.com)

**From:** Kamran Fattahi [<mailto:Kamran@FattahiLaw.com>]  
**Sent:** Friday, February 21, 2014 3:14 PM  
**To:** Jacobs, Hara K. (Phila)  
**Cc:** Larson, Troy (Phila)  
**Subject:** RE: HOLLYWOOD HOTEL - Outstanding Discovery

Hara,

I believe that both parties' discovery responses were originally due by the same date, including each time we agreed on extensions of the discovery responses. Please let me know if you have any suggestions regarding a due date for both sides' outstanding discovery responses.

Regards,  
Kamran Fattahi  
Law Offices of Kamran Fattahi  
Tel: 818-205-0140

**From:** Jacobs, Hara K. (Phila) [<mailto:JacobsH@ballardspahr.com>]  
**Sent:** Friday, February 21, 2014 11:36 AM  
**To:** Kamran Fattahi ([Kamran@FattahiLaw.com](mailto:Kamran@FattahiLaw.com))  
**Cc:** Larson, Troy (Phila)  
**Subject:** HOLLYWOOD HOTEL - Outstanding Discovery

Kamran,

We received the Board's order today and note that the suspension of the proceeding has been lifted. Kindly advise us when we can expect to receive your client's outstanding discovery responses.

Separately, the close of discovery is presently set for March 6. Kindly confirm whether you will consent to a 90 day extension of the discovery period. If you will not consent, we will promptly seek an extension of the discovery period along with our forthcoming motion to amend the notice of opposition to add the ground that the mark HOLLYWOOD HOTEL is merely descriptive of your client's hotel services.

I look forward to hearing from you.

Regards,

Hara

---

**Hara K. Jacobs**

Ballard Spahr LLP  
1735 Market Street  
51st Floor  
Philadelphia, PA 19103-7599  
Direct: 215.864.8209  
Fax: 215.864.8999  
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# EXHIBIT B

## Larson, Troy (Phila)

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**From:** Jacobs, Hara K. (Phila)  
**Sent:** Tuesday, March 11, 2014 7:11 PM  
**To:** 'Kamran Fattahi'  
**Cc:** Larson, Troy (Phila)  
**Subject:** RE: Hollywood Casinos v. Chateau Celeste

Kamran,

We agree to exchange discovery 4 weeks from today. Thank you.

Regards,

Hara

---

**Hara K. Jacobs**  
Ballard Spahr LLP  
1735 Market Street  
51st Floor  
Philadelphia, PA 19103-7599  
Direct: 215.864.8209  
Fax: 215.864.8999  
[jacobsh@ballardspahr.com](mailto:jacobsh@ballardspahr.com) | [www.ballardspahr.com](http://www.ballardspahr.com)

**From:** Kamran Fattahi [mailto:[Kamran@FattahiLaw.com](mailto:Kamran@FattahiLaw.com)]  
**Sent:** Tuesday, March 11, 2014 7:08 PM  
**To:** Jacobs, Hara K. (Phila)  
**Cc:** Larson, Troy (Phila)  
**Subject:** RE: Hollywood Casinos v. Chateau Celeste (Settlement Communication)

Hara,

s

1.

As for discovery, let's agree on a mutual exchange of the outstanding discovery responses in four (4) weeks from today. Please confirm.

Regards,  
Kamran  
Law Offices of Kamran Fattahi

Tel: 818-205-0140

**From:** Jacobs, Hara K. (Phila) [<mailto:JacobsH@ballardspahr.com>]  
**Sent:** Tuesday, March 11, 2014 3:36 PM  
**To:** 'Kamran Fattahi'  
**Cc:** Larson, Troy (Phila)  
**Subject:** RE: Hollywood Casinos v. Chateau Celeste (Settlement Communication)

Kamran,

I have advised you of our client's position for well over a year, and maybe longer.

We are where we are, which is litigating a TTAB proceeding. I once again request that you provide us with dates for the exchange of discovery.

Regards,

Hara

---

**Hara K. Jacobs**  
Ballard Spahr LLP  
1735 Market Street  
51st Floor  
Philadelphia, PA 19103-7599  
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Fax: 215.864.8999  
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**From:** Kamran Fattahi [<mailto:Kamran@FattahiLaw.com>]  
**Sent:** Tuesday, March 11, 2014 6:28 PM  
**To:** Jacobs, Hara K. (Phila)  
**Cc:** Larson, Troy (Phila)  
**Subject:** RE: Hollywood Casinos v. Chateau Celeste (Settlement Communication)

Hara,

Regards,  
Kamran  
Law Offices of Kamran Fattahi  
Tel: 818-205-0140



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

From: Jacobs, Hara K. (Phila) [mailto:JacobsH@ballardspahr.com]  
Sent: Tuesday, March 11, 2014 12:48 PM  
To: Kamran Fattahi  
Cc: Larson, Troy (Phila)  
Subject: RE: Hollywood Casinos v. Chateau Celeste (Settlement Communication)

Kamran,

Getting back to you on the settlement offer.

Regards,

Hara

---

Hara K. Jacobs  
Ballard Spahr LLP  
1735 Market Street  
51st Floor  
Philadelphia, PA 19103-7599  
Direct: 215.864.8209  
Fax: 215.864.8999  
jacobsh@ballardspahr.com | www.ballardspahr.com

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

From: Jacobs, Hara K. (Phila)  
Sent: Thursday, March 06, 2014 11:51 PM  
To: Kamran Fattahi  
Cc: Larson, Troy (Phila)  
Subject: Re: Hollywood Casinos v. Chateau Celeste (Settlement Communication)

We are still waiting for an agreement from you on a date to exchange discovery responses. Please advise.

We will not extend deadlines for the purpose of settlement negotiations given the history in this matter.

Hara Jacobs  
Ballard Spahr LLP

Sent from my iPhone

> On Mar 6, 2014, at 8:50 PM, "Kamran Fattahi" <Kamran@FattahiLaw.com> wrote:

>

> No. They are unrelated issues. Let me know.

>

> Regards,

> Kamran

>

> -----Original Message-----

> From: Jacobs, Hara K. (Phila) [mailto:JacobsH@ballardspahr.com]  
> Sent: Thursday, March 06, 2014 5:48 PM  
> To: Kamran Fattahi  
> Cc: Larson, Troy (Phila)  
> Subject: Re: Hollywood Casinos v. Chateau Celeste (Settlement Communication)  
>  
> Will you agree to extend discovery?  
>  
> Hara Jacobs  
> Ballard Spahr LLP  
>  
> Sent from my iPhone  
>  
> On Mar 6, 2014, at 8:33 PM, "Kamran Fattahi"  
> <Kamran@FattahiLaw.com<mailto:Kamran@FattahiLaw.com>> wrote:  
>  
> Hara,  
>  
> Given that I have a deadline of next Wednesday for responding to the Motion  
> for Leave that you recently filed, should I plan on meeting that deadline or  
> would a continuation of my response/opposition deadline be in order?  
>  
> Regards,  
> Kamran  
> Law Offices of Kamran Fattahi  
> Tel: 818-205-0140  
>  
> From: Jacobs, Hara K. (Phila) [mailto:JacobsH@ballardspahr.com]  
> Sent: Thursday, March 06, 2014 5:27 PM  
> To: 'Kamran Fattahi'  
> Cc: Larson, Troy (Phila)  
> Subject: RE: Hollywood Casinos v. Chateau Celeste (Settlement Communication)  
>  
> Kamran,  
>  
> I will discuss your offer with my client, however, you will not hear back  
> from us by Monday.  
>  
> Regards,  
>  
> Hara  
>  
>  
>  
> \_\_\_\_\_  
> Hara K. Jacobs  
> Ballard Spahr LLP  
> 1735 Market Street  
> 51st Floor  
> Philadelphia, PA 19103-7599  
> Direct: 215.864.8209  
> Fax: 215.864.8999  
> jacobsh@ballardspahr.com<mailto:jacobsh@ballardspahr.com> |  
> www.ballardspahr.com<http://www.ballardspahr.com>  
>  
>  
> From: Kamran Fattahi [mailto:Kamran@FattahiLaw.com]  
> Sent: Thursday, March 06, 2014 8:19 PM

> To: Jacobs, Hara K. (Phila)  
> Cc: Larson, Troy (Phila)  
> Subject: Hollywood Casinos v. Chateau Celeste (Settlement Communication)  
>  
> For Settlement Purposes - FRE Rule 408  
>  
> Dear Hara,  
>  
> Please see attached a draft Settlement Agreement (marked as "Draft 1-March  
> 6, 2014") containing a settlement proposal from my client. This document is  
>  
>  
> you regarding your client's position and interest in such a proposed  
> settlement (hopefully by Monday).  
>  
> Just to avoid any misunderstanding or confusion, my client's understanding  
> is that there will not be a final and enforceable settlement unless there is  
> a finalized written settlement agreement signed by all parties.  
>  
> Regards,  
> Kamran  
> Law Offices of Kamran Fattahi  
> Tel: 818-205-0140  
>