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

Proceeding	91206254
Party	Defendant The Civil Wars, LLC dba The Civil Wars
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Submission	Response to Board Order/Inquiry
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Signature	/s/ Tiffany A. Dunn
Date	10/16/2012
Attachments	The Civil Wars - Response to Order to Show Cause.pdf (4 pages)(30747 bytes) The Civil Wars - Declaration of Tiffany Dunn.pdf (4 pages)(27816 bytes)

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

In The Matter of Application Serial No. 85/361,068: THE CIVIL WARS

THE STATE OF OREGON ACTING BY AND
THROUGH THE STATE BOARD OF HIGHER
EDUCATION ON BEHALF OF THE
UNIVERSITY OF OREGON AND OREGON
STATE UNIVERSITY,

Opposers,

v.

THE CIVIL WARS, LLC D/B/A THE CIVIL
WARS,

Applicant.

Opposition No. 91206254

APPLICANT'S RESPONSE TO ORDER TO SHOW CAUSE
DATED SEPTEMBER 20, 2012

As provided below, Applicant has good cause for why it did not file an answer or a motion to extend before September 4, 2012, and the Board should not enter judgment by default against Applicant under Fed. R. Civ. P. 55(a).

Two opposition proceedings are pending between Applicant and Opposers over Applicant's mark, THE CIVIL WARS (the "Mark"): (1) the present opposition over International Class 25, Opposition No. 91206254, ("Trademark Opposition") and (2) the opposition over International Class 41, Opposition No. 91204467, ("Service Mark Opposition"). Although the two opposition proceedings are identical with respect to the parties and the Mark, each had different deadlines resulting from different opposition filing dates.

On May 4, 2012, Applicant filed an answer in the Service Mark Opposition. Following that time, however, the parties became fully engaged in settlement discussions, and on June 26, 2012, the Applicant and Opposers unequivocally agreed to extend all deadlines. Because the

deadlines in the Service Mark Opposition were fast approaching, the following day Opposers filed a consent motion to suspend all deadlines in the Service Mark Opposition to allow the parties to continue settlement discussions.

Settlement discussions with respect to both opposition proceedings continued and again on August 23, 2012, the parties agreed to extend the dates in the Service Mark Opposition to mirror the dates in the Trademark Opposition so that they could proceed simultaneously. The understanding was that all deadlines were on hold pending settlement discussions and that Opposers' extensions had taken care of the parties' goal. Unfortunately, nothing was ever filed to extend or suspend any dates in the Trademark Opposition, and Applicant inadvertently overlooked that the deadline for Applicant's answer in the Trademark Opposition was imminent and that it had not yet been submitted in light of the ongoing settlement discussions.

Opposer respectfully submits that good cause for missing the filing deadline for the answer in this Trademark Proceeding therefore existed because of ongoing settlement discussions and because of the inadvertent confusion between actions taken in the two proceedings to ensure consistency in the deadlines. It is clear from the parties' agreement to extend and match all deadlines to facilitate continued settlement discussions and discovery, if necessary, that neither intended nor expected Applicant to default. In fact, Counsel for Opposers has reiterated his clients' willingness to continue settlement discussions. As such, none of the parties has been prejudiced as a result of this unintended lapse. The foregoing matters are more fully set forth in the Declaration of Tiffany A. Dunn attached hereto as Exhibit "A."

Applicant further requests that the Board accept the Applicant's answer filed herewith to allow the parties to proceed with settlement discussions and/or to proceed with the Trademark Opposition in conjunction with the Service Mark Opposition.

Finally, Applicant requests that the Board consolidate the Trademark Opposition and the Service Mark Opposition. Applicant's Motion to Consolidate is filed simultaneously herewith.

Please debit our Deposit Account No. 502547 for any required filing fee and any additional necessary fees.

Please direct all correspondence to: Loeb & Loeb, LLP 1906 Acklen Avenue, Nashville, TN 37212, Attn: Tiffany A. Dunn.

Respectfully submitted,

Date: October 16, 2012

LOEB & LOEB LLP

By: /s/ Tiffany A. Dunn

Tiffany A. Dunn, Esq.

John P. Strohm, Esq.

Brittany A. Schaffer, Esq.

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Attorneys for Applicant

CERTIFICATE OF SERVICE

I, Tiffany A. Dunn, hereby certify that a copy of the foregoing **APPLICANT'S RESPONSE TO ORDER TO SHOW CAUSE DATED SEPTEMBER 20, 2012**, has been served upon:

Kevin M. Hayes, Esq.
Klarquist Sparkman, LLP
One World Trade Ctr, Suite 1600
121 SW Salmon St.
Portland, OR 97204
ptotmdocket@klarquist.com
kevin.hayes@klarquist.com
Phone: 503-595-5300

via e-mail and first class mail, postage prepaid, on this 16th day of October 2012.

/s/ Tiffany A. Dunn

EXHIBIT A

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

In The Matter of Application Serial No. 85/361,068: THE CIVIL WARS

THE STATE OF OREGON ACTING BY AND
THROUGH THE STATE BOARD OF HIGHER
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Opposers,

v.

THE CIVIL WARS, LLC D/B/A THE CIVIL
WARS,

Applicant.

Opposition No. 91206254

DECLARATION OF TIFFANY A. DUNN

I, TIFFANY A. DUNN, declare as follows:

1. I am an attorney with the law firm Loeb & Loeb, LLP (“Loeb & Loeb”), counsel for applicant The Civil Wars, LLC d/b/a The Civil Wars, (“Applicant”) in this matter. I respectfully submit this declaration in support of Loeb & Loeb’s Response to Order to Show Cause (“Motion”).

2. On March 21, 2012, Opposers instituted an opposition action against Applicant’s registration of the mark, THE CIVIL WARS (the “Mark”) in International Class 41, which is Opposition No. 91204467, (“Service Mark Opposition”). Applicant filed its Answer to the Opposition on May 4, 2012. Thereafter, Opposers and Applicant became fully engaged in settlement discussions.

3. Because the deadlines in the Service Mark Opposition were fast approaching, on June 26, 2012, the Applicant and Opposers unequivocally agreed to extend all deadlines. The following day Opposers filed a consent motion to suspend all deadlines in the Service Mark Opposition to allow the parties to continue settlement discussions.

4. On July 9, 2012, Opposers instituted a second opposition action against Applicant's registration of the Mark in International Class 25, which is Opposition No. 91206254, ("Trademark Opposition"). Because the Trademark Opposition commenced months after the Service Mark Opposition, each opposition proceeding had different deadlines.

5. On August 23, 2012, the parties agreed to extend the dates in the Service Mark Opposition to mirror the dates in the Trademark Opposition so that they could proceed simultaneously. The understanding was that all deadlines were on hold pending ongoing settlement discussions and that Opposers' extensions had taken care of the parties' goal. Opposers, again, submitted this request to the Board.

6. We were hopeful the parties could reach a settlement before it was necessary to file any further pleadings, given that the parties have remained open to and engaged in settlement discussions for many months. Because of the potential for settlement and the agreement with Opposers to extend all deadlines, we inadvertently overlooked that the deadline for Applicant's answer in the Trademark Opposition was imminent and that we had not yet submitted an answer or filed a motion to extend or suspend the specific dates in the Trademark Opposition specifically. Further contributing to our confusion and mistake in neglecting to timely file an Answer or other motion in the Trademark Opposition was the fact that Opposers filed all previous motions to suspend and to extend in the Service Mark Opposition. We incorrectly

understood the extension to be for the opposition proceeding in which we had not yet filed an answer—i.e. the present Trademark Opposition.

7. Counsel for Opposers has reiterated his clients' willingness to continue settlement discussions. However, we believed the Answer filed herewith the requested consolidation of the two opposition proceedings will help all parties avoid confusion in the future as to the deadlines for the respective marks in moving forward.

I declare under penalty of perjury that the above is true and accurate to the best of my knowledge.

Dated: October 16, 2012

By: /s/ Tiffany A. Dunn
Tiffany A. Dunn, Esq.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Declaration of Tiffany A. Dunn was served by U.S. Mail and email on this the 16th day of October, 2012, on:

Kevin M. Hayes, Esq.
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Phone: 503-595-5300

/s/ Tiffany A. Dunn
Tiffany A. Dunn