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

Proceeding	91209386
Party	Defendant Realty ONE Group, Inc.
Correspondence Address	JONATHAN A HYMAN KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET, 14TH FLOOR IRVINE, CA 92614 UNITED STATES efiling@knobbe.com, Jonathan.Hyman@knobbe.com
Submission	Stipulated/Consent Motion to Extend
Filer's Name	Jonathan A. Hyman
Filer's e-mail	efiling@knobbe.com, Jonathan.Hyman@knobbe.com
Signature	/jhh/
Date	03/20/2015
Attachments	RELTY.009M-90dayjointextend.pdf(644853 bytes)

RELTY.009M/014N TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

JEC II LLC and THE ONE GROUP LLC, Petitioners/Opposers, v. REALTY ONE GROUP, INC., Registrant/Applicant.	Proceeding No.: 92057487 Registration No.: 3,351,334 Mark: Proceeding No.: 91209386 (consolidated with 92056849) Serial No.: 85/653,197 Mark: Registration No.: 4,261,532 Mark: REALTY ONE GROUP I hereby certify that this correspondence and all marked attachments are being electronically filed with the Trademark Trial and Appeal Board through their web site located at http://estta.uspto.gov on: 3.20.15 (Date) Jonathan A. Hyman

JOINT MOTION TO EXTEND FOR SETTLEMENT

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

Dear Sir:

Pursuant to C.F.R. § 2.117(c), and T.B.M.P. §§ 510.03(a), 605.02, JEC II LLC and THE ONE GROUP LLC and REALTY ONE GROUP, INC., by and through their attorneys, hereby request that the Trademark Trial and Appeal Board (the "Board") grant the parties a further extension in the above-referenced Consolidated Proceedings for ninety (90) days, including all applicable dates, pending the parties' settlement discussions.

The parties report to the Board that they are actively working towards settlement and have continued work towards settlement, including discussing and circulating draft settlement agreements and negotiating the terms thereof. The parties believe that progress is being made towards resolving most issues regarding settlement, and both parties expect resolution to be forthcoming. The parties recognize the Board's request for details regarding the efforts made towards settlement of the issues

involved in this proceeding including monthly breakdowns of such activities. However, the parties request the Board accept their representation herein that settlement of this proceeding under the terms currently being negotiated between the parties is arguably more complicated by the fact that Petitioners/Opposers are involved in several other proceedings involving the same asserted marks. One such proceeding is Opposition No. 91187956, which spawned civil litigation between those parties in the United States District Court for the Southern District of New York (*SH Group Global IP Holdings, L.L.C. v. JEC II, LLC, The One Group LLC, and One Marks, LLC* Civil Action No. 14-CV-7274 (DLC)). That proceeding has now resulted in a settlement between those parties. The parties to these Consolidated Proceedings have different views on the scope of the impact of that settlement on the scope of the settlement between the parties in these Consolidated Proceedings. An example of a non-substantive impact of the above settlement in the other proceeding that has delayed the efforts of the parties herein to move their settlement forward, is that the settlement between Petitioners/Opposers and SH Group Global IP Holdings, L.L.C. is confidential and the parties herein have only just worked out getting Registrant/Applicant herein a copy of that confidential settlement agreement.

In addition to the above, Registrant/Applicant's counsel had also taken two leaves due his wedding and the birth of his daughter, and there have, over the course of the Consolidated Proceedings, been delays due to the natural ebb and flow of holidays, client travel schedules, and turnover/onboarding of new personal at the respective companies involved in the Consolidated Proceedings. Nevertheless, the parties will attempt to comply with the Board's onerous request:

Month	Settlement Activities
October 2013	• Discussions and emails between outside counsel for the parties regarding broad framework for settlement • Parties conduct discovery conference
November 2013	• Internal discussions at parties with counsel regarding broad framework for settlement
December 2013	• Internal discussions at parties with counsel regarding broad framework for settlement
January 2014	• Continuing discussions and emails between outside counsel for the parties regarding broad framework for settlement • Continuing internal discussions at parties with counsel regarding settlement terms • Registrant/Applicant's counsel's wedding
February 2014	• Continuing internal discussions at parties with counsel regarding settlement terms and potential initial settlement deal points • Discussions between outside counsel for the parties

	regarding initial settlement deal points
March 2014	• Internal discussions at parties with counsel regarding deal points • Exchange of deal points between the parties[1]
April 2014	• Discussions between outside counsel over the structure of the agreement • Internal discussions at parties with counsel regarding structure of the agreement
May 2014	• Emails between outside counsel over the structure of the agreement • Internal discussions at parties with counsel regarding structure of the agreement
June 2014	• Emails between outside counsel over the structure of the agreement
July – September 2014	• Per the above, Registrant/Applicant submitted its first written proposal (deal points) of settlement in March. Petitioners/Opposers countered with their own written counterproposal a few weeks later in April. After the various email exchanges between counsel in May, at the beginning of June, Registrant/Applicant submitted its detailed analysis and comments directed to Petitioners/Opposers counter. Unfortunately, Petitioners/Opposers had, unbeknownst to Registrant/Applicant, become a publicly traded company in and around May. As part of this impactful change, Petitioners/Opposers hired, for the first time in their history, in-house, general counsel who was now supposed to take over the primary role of intermediary with all outside counsel on all matters concerning the companies, including trademark matters and proceedings, and these Consolidated Proceedings. All of these tasks, and the complexity of the trademark portfolio and proceedings involving that portfolio, caused Petitioners/Opposers, through this new GC, to fail to communicate with counsel herein for about a 3 month period from July – September of 2014.
October 2014	• Acceptance of overall structure of agreement • Exchange of deal points between the parties • Internal discussions at parties with counsel regarding deal points • Discussions between outside counsel regarding deal

[1] At this point the parties had a difference of opinion as to the overall construct of the settlement with one party preferring the settlement be framed as one type of agreement while the other preferring another type of agreement. Due to confidentiality provisions within the agreement, we cannot disclose the details of this disagreement. However, as the Board will see, it took some time and a lot of back and forth negotiations to reach agreement on the overall structure.

	points • Negotiation of certain deal points continues • Principal deal points reached • Registrant/Applicant's counsel's daughter born
November 2014	• First draft of agreement circulated by Petitioners/Opposers • Registrant/Applicant's counsel on leave
December 2014	• Internal review of first draft of agreement by Registrant/Applicant • Holiday season
January 2015	• Holiday season • Internal review of first draft of agreement by Registrant/Applicant continues
February 2015	• First time Registrant/Applicant becomes aware of Petitioners/Opposers settlement in the SH Group proceeding. • Outside counsel broadly discuss SH Group settlement • Registrant/Applicant sends its proposed revisions to draft agreement
March 2015	• Petitioners/Opposers respond to revisions from Registrant/Applicant with further revisions

The parties respectfully represent herein to the Board their firm belief that they will reach agreement and that these Consolidated Proceedings will be resolved without burdening the Board on substantive matters. However, without the additional extension being requested by this Joint Motion, the parties will need to turn their attention from the progress they are at last making on their draft agreement, to instead focus on conducting discovery. The parties hope the Board will agree that such would be counterproductive to advancing the parties' settlement negotiations.

The parties' counsel have been in communication with each other regarding settlement since the last extension request and, as noted in the above chart, have circulated a revised draft of the agreement and are continuing to negotiate specific deal points. Additional time is needed for counsel to confer with their clients and complete the agreement. The last communication between the parties on the settlement agreement was the transmission of Petitioners/Opposers' revisions on March 13, 2015.

The parties are still negotiating the scope and extent of the exact services upon which the parties may use their respective marks moving forward, again, this has been impacted by the settlement between Petitioners/Opposes and SH Group Global IP Holdings, L.L.C. The parties are also dealing with issues relating to the scope and extent to which the parties may develop new marks and the restrictions on such marks. Again, this is an issue beyond the scope of the proceeding and

involves future rights and is not easily negotiated or conceded, but the parties believe they are making good progress. The parties are also still negotiating issues relating to jurisdiction, choice of law, the forum for resolving any future disputes, and the scope of termination of the agreement.

This request is made to allow the parties additional time to finalize settlement so that this matter may be removed from the Board's docket, and is not intended for further delay or to waste the Board's time. The timetable needed to conclude this matter should be less than the ninety (90) days being requested herein, so that this is hoped by the parties to be their last such extension request.

In light of all of the above, as well as the significant fact that the parties are jointly making this request, the parties respectfully believe good cause has been shown for the extension of the Consolidated Proceedings, and request that the following new schedule of dates be So Ordered by the Board:

Expert Disclosures Due	May 23, 2015
Discovery Closes	June 23, 2015
Plaintiff's Pretrial Disclosures	August 4, 2015
Plaintiff's 30-day Trial Period Ends	September 15, 2015
Defendant's Pretrial Disclosures	September 29, 2015
Defendant's 30-day Trial Period Ends	November 10, 2015
Plaintiff's Rebuttal Disclosures	November 24, 2015
Plaintiff's 15-day Rebuttal Period Ends	December 23, 2015

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

By: _____
Susan M. Natland
Jonathan A. Hyman
2040 Main St., 14th Floor
Irvine, CA 92614
Attorneys for Registrant/Applicant,
REALTY ONE GROUP, INC.
Dated: March 20, 2015

PERGAMENT GILMAN & CEPEDA LLP

By: /Michael R. Gilman/
Michael Gilman
163 Madison Ave., Suite 110
Morristown, NJ 07960
Attorney for Petitioners/Opposes, JEC II LLC and THE ONE GROUP LLC
Dated: March 20, 2015

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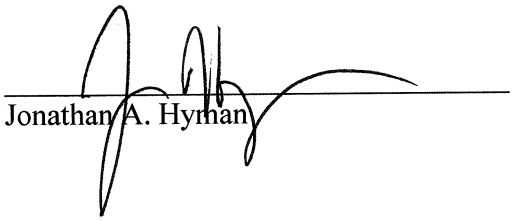
CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **JOINT MOTION TO EXTEND FOR SETTLEMENT** upon Petitioners/Opposes' counsel by sending one copy thereof via email per the parties' agreement on March 20, 2015, addressed as follows:

Michael Gilman, Esq.
PERGAMENT GILMAN & CEPEDA LLP
mgilman@pgclawgroup.com



Jonathan A. Hyman

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