

ESTTA Tracking number: **ESTTA938670**

Filing date: **12/01/2018**

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

Proceeding	91225703
Party	Plaintiff Urgent Care MSO, LLC
Correspondence Address	JULIA K SUTHERLAND SEYFARTH SHAW LLP 131 SOUTH DEARBORN ST, STE 2400 CHICAGO, IL 60603 UNITED STATES jsutherland@seyfarth.com, kwilton@seyfarth.com, lgregory@seyfarth.com, chiipdocket@seyfarth.com, laxttabdocket@seyfarth.com, tmatlanta@seyfarth.com, ipdocketatlanta@seyfarth.com, ttabdocket@seyfarth.com 312-460-5000
Submission	Motion to Suspend for Settlement Discussions
Filer's Name	Kenneth L. Wilton
Filer's email	kwilton@seyfarth.com, ttabdocket@seyfarth.com
Signature	/Kenneth L. Wilton/
Date	12/01/2018
Attachments	2018-11-30 -41 - Opposer - Consent Motion to Suspend.pdf(28174 bytes)

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

In the Matter of Application Serial No. 86/595,594
Published in the Official Gazette of September 8, 2015

URGENT CARE MSO, LLC,

Opposer,

v.

MESSAGE ENVY FRANCHISING, LLC,

Applicant.

Opposition No. 91225703

**JOINT REPORT ON SETTLEMENT STATUS AND
MOTION TO SUSPEND PROCEEDINGS WITH CONSENT**

Pursuant to the Board's Order of July 16, 2018, Opposer Urgent Care MSO, LLC ("Opposer") and Applicant Massage Envy Franchising, LLC ("Applicant") hereby submit this Joint Report on Settlement Status and Motion to Suspend Proceedings with Consent, showing the Board as follows:

1. The parties have been engaged in settlement negotiations since Opposer initiated this proceeding on January 6, 2016. [1 TTABVUE.] The Board granted four requests for extension of time to answer in order to allow the parties to continue their negotiations. [5 TTABVUE; 7 TTABVUE; 9 TTABVUE; 11 TTABVUE.] Unfortunately, the parties were unable to resolve their issues after those initial rounds of negotiation, so Applicant filed its Answer on October 12, 2016. [12 TTABVUE.]

2. Since that time, the parties have exchanged several drafts of a written agreement memorializing proposed settlement terms. The Board has supported the parties' efforts by granting a number of additional requests for extension of deadlines and suspension for continued

settlement negotiation. [14 TTABVUE; 16 TTABVUE; 19 TTABVUE; 21 TTABVUE; 23 TTABVUE; 25 TTABVUE; 27 TTABVUE; 29 TTABVUE; 31 TTABVUE; 33 TTABVUE; 36 TTABVUE; 38 TTABVUE; 40 TTABVUE.]

3. The parties are wary of abusing the privilege of extensions and suspensions and have attempted to settle their dispute without having to make any further requests to the Board. Unfortunately, it appears the parties will need some additional time in which to attempt to reach final settlement terms. Therefore, in support of this Motion to Suspend Proceedings with Consent, as requested by the Board in its July 16, 2018 Order [38 TTABVUE], the parties hereby provide a detailed report to establish good cause for a further suspension.

4. The parties submitted their most recent motion for suspension on September 2, 2018. [39 TTABVUE.] The Board granted the motion on September 19, 2018. [40 TTABVUE]

5. On September 7, 2018, Opposer's counsel provided comments on the latest draft agreement to Applicant's counsel via email.

6. On September 25, 2018, Applicant's counsel provided comments to Opposer's counsel on the latest draft agreement via email.

7. On October 3, 2018, Applicant's counsel suggested a meeting between Opposer's CEO and Applicant's CEO in order to further discuss settlement.

8. The parties subsequently scheduled a telephone conference between the parties' CEOs for November 19, 2018.

9. On November 18, 2018, Applicant's counsel sent Opposer and Opposer's counsel an email stating that an issue had arose and Applicant's CEO had to reschedule the November 19, 2018 telephone conference.

10. In light of the Thanksgiving holiday and travel schedules, the parties agreed to re-schedule the telephone conference for December 11, 2018.

11. The parties are still at an impasse regarding four terms of the settlement agreement. Counsel are hopeful that the parties will reach a final decision, one way or the other, during the requested suspension period.

12. Under the current schedule set forth by the Board, discovery is set to close on December 2, 2018. [39 TTABVUE.]

13. Counsel for Applicant has expressly provided consent to the suspension requested herein.

14. Assuming the call between the parties' principals goes forward as scheduled, the parties are hopeful that they can complete their negotiations within 60 days. For the foregoing reasons, and in view of the progress the parties have made toward settlement since their last motion for suspension, Opposer and Applicant respectfully and jointly submit that good cause exists to suspend this proceeding for another 60 days, with a schedule as set on the following page and the proceedings to resume on January 30, 2019:

/Remainder of page intentionally left blank/

	Current Schedule	Proposed Schedule
Time to Answer	10/12/2016 (CLOSED)	10/12/2016 (CLOSED)
Deadline for Discovery Conference	11/11/2016 (CLOSED)	11/11/2016 (CLOSED)
Discovery Opens	10/11/2016 (CLOSED)	10/11/2016 (CLOSED)
Initial Disclosures Due	04/10/2017 (CLOSED)	04/10/2017 (CLOSED)
Expert Disclosures Due	11/02/2018 (CLOSED)	11/02/2018 (CLOSED)
Discovery Closes	12/02/2018	02/01/2019
Plaintiff's Pretrial Disclosures Due	01/16/2019	03/18/2019
Plaintiff's 30-day Trial Period Ends	03/02/2019	05/02/2019
Defendant's Pretrial Disclosures Due	03/17/2019	05/17/2019
Defendant's 30-day Trial Period Ends	05/01/2019	07/01/2019
Plaintiff's Rebuttal Disclosures Due	05/16/2019	07/16/2019
Plaintiff's 15-day Rebuttal Period Ends	06/15/2019	08/15/2019
Plaintiff's Opening Brief Due	08/14/2019	10/14/2019
Defendant's Brief Due	09/13/2019	11/13/2019
Plaintiff's Reply Brief Due	09/28/2019	11/28/2019
Request for Oral Hearing (optional) Due	10/08/2019	12/08/2019

/Remainder of page intentionally left blank/

Dated: November 30, 2018

Respectfully submitted by:

SEYFARTH SHAW LLP

/s/ Kenneth L. Wilton

Kenneth L. Wilton
kwilton@seyfarth.com
2029 Century Park East, Suite 3500
Los Angeles, California 90067
Telephone: (310) 277-7200

Julia K. Sutherland
jsutherland@seyfarth.com
233 South Wacker Drive, Suite 8000
Chicago, Illinois 60606
Telephone: (312) 460-5577

Lauren M. Gregory
lgregory@seyfarth.com
1075 Peachtree St. NE, Suite 2500
Atlanta, GA 30309-3958
Telephone: (404) 885-1500

Attorneys for Opposer
URGENT CARE MSO, LLC

Expressly consented to by:

DLA PIPER LLP (US)

/s/ Michael A. Geller

Mark I. Feldman
mark.feldman@dlapiper.com
Michael Geller
michael.geller@dlapiper.com
444 West Lake Street, Suite 900
Chicago, IL 60606-0089
Telephone: (312) 368-4000

Attorneys for Applicant
MESSAGE ENVY FRANCHISING, LLC

CERTIFICATE OF SERVICE

I hereby certify that on November 30, 2018, I served the foregoing JOINT REPORT ON SETTLEMENT STATUS AND MOTION TO SUSPEND PROCEEDINGS WITH CONSENT by e-mailing a copy thereof to Applicant's counsel of record:

Mark I. Feldman
mark.feldman@dlapiper.com
DLA Piper LLP US
444 West Lake Street, Suite 900
Chicago, Illinois 60606-0089

with copies to michael.geller@dlapiper.com, ch.tm@dlapiper.com, and tamar.duvdevani@dlapiper.com.

/s/ Kenneth L. Wilton
Kenneth L. Wilton

Attorney for Opposer
URGENT CARE MSO, LLC