

ESTTA Tracking number: **ESTTA807019**

Filing date: **03/13/2017**

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

Proceeding	91227813
Party	Defendant Wisconsin Cheese Group LLC
Correspondence Address	DONNA A TOBIN FRANKFURT KURNIT KLEIN & SELZ PC 488 MADISON AVENUE NEW YORK, NY 10022 UNITED STATES dtobin@fkks.com, pto@fkks.com
Submission	Opposition/Response to Motion
Filer's Name	Donna A. Tobin
Filer's e-mail	dtobin@fkks.com, kmaynard@fkks.com, dmohaghegh@fkks.com, pto@fkks.com
Signature	/Donna A. Tobin/
Date	03/13/2017
Attachments	Applicant_s Opposition to Opposer_s Motion to Ex- tend_1491372_1.PDF(3195663 bytes)

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

In the Matter of U.S. Appln. Ser. Nos. 86/624,908 and 86/605,022
Marks: LA MORENITA and LA MORENITA BRAND & Design

GOYA FOODS, INC.,	X	
	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91227813
	:	
WISCONSIN CHEESE GROUP LLC,	:	
	:	
Applicant.	:	
	X	

**WISCONSIN CHEESE GROUP LLC’S OPPOSITION TO GOYA FOODS INC.’S
MOTION TO EXTEND DISCOVERY, PRETRIAL DISCLOSURE AND TRIAL DATES**

Wisconsin Cheese Group LLC (“Applicant”) hereby responds to Goya Foods, Inc. (“Opposer”)’s Motion to Extend Discovery, Pretrial Disclosure and Trial Dates (the “Motion to Extend”).

Per the Trademark Trial and Appeal Board Manual of Procedure, a party moving for an extension of time must show good cause for the requested extension. TBMP § 509.01. The movant is requested to “set forth with particularity the facts said to constitute good cause,” and must demonstrate “that the requested extension of time is not necessitated by the party’s own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor.” TBMP § 509.01(a); *see also Luemme Inc. V. D.B. Plus Inc.*, 53 U.S.P.Q.2d 1758, 1760-61 (T.T.A.B. 1999). Applicant respectfully submits that, for the reasons below, Opposer has failed to set forth the particular facts warranting an extension, and such facts do not exist. Therefore, Opposer has not established good cause for extending this proceeding and its Motion to Extend should be denied in its entirety.

Background

This proceeding has been pending since May 11, 2016, when Opposer filed its notice of opposition (TTABVUE 1). Applicant filed an answer and counterclaim on June 20 (TTABVUE 5). Opposer filed a Motion to Strike Applicant's Affirmative Defenses on June 28 (TTABVUE 7). Applicant then filed an amended answer and counterclaim and its opposition to Opposer's motion to strike (TTABVUE 8, 9). Opposer filed a reply in support of its motion on July 26 (TTABVUE 10). On August 10, 2016, the Board suspended the proceeding, accepted Applicant's amended answer and counterclaim, construed Opposer's July 26 filing as a motion to strike the amended answer and counterclaim, and gave Applicant fifteen (15) days to file its opposition to that motion, which Applicant timely filed (TTABVUE 11, 12).

On August 29, in lieu of filing a reply, Opposer filed a motion requesting reconsideration of the Board's order of August 10 (TTABVUE 13). Applicant filed its opposition to Opposer's reconsideration request as well as a motion for default judgment on the counterclaim (TTABVUE 14, 15). Opposer filed its opposition to Applicant's default judgment and Applicant filed a reply on October 10, 2016 (TTABVUE 16, 17).

On January 3, 2017, the Board issued an order ruling on Opposer's motion to strike Applicant's affirmative defenses, denying Opposer's motion to request reconsideration of the August 10, 2016 order, giving no consideration to Applicant's motion for default judgment on the counterclaim, and resetting the remaining dates in the proceeding (TTABVUE 18). Thereafter, counsel for Applicant ("Applicant's Counsel") reached out to Opposer's counsel to schedule the required discovery conference, which was held on February 13, 2017.

On February 15, 2017, Opposer's current counsel ("Opposing Counsel") filed a Notice of Substitution of Counsel (TTABVUE 22) and contacted Applicant's Counsel via email,

requesting an extension of ninety (90) days for all deadlines in this proceeding, including the February 23, 2017 discovery conference deadline, to allow Opposing Counsel to “get up to speed on this matter and consider possible settlement options.” (**Exhibit A**).

Applicant’s Counsel responded the following day, noting that it had already conducted a discovery conference with Opposer’s counsel at the time, that the conference included a discussion of proposed modifications to a single paragraph in the standard protective order, and attaching a draft of the modified protective order for Opposing Counsel’s review (**Exhibit B**). Applicant’s Counsel also stated that, as the discovery conference had already been conducted, and as the proceeding had not yet proceeded to discovery, it saw no need for a ninety (90) day extension, though it would be cooperative and would review any settlement offers Opposing Counsel might provide.

Opposing Counsel did not reply to Applicant’s Counsel’s email. One week later, on the day before discovery was set to open, Opposer filed its instant Motion to Extend, seeking a thirty (30) day extension (**not the 90 days it sought from Applicant’s Counsel**), and asserting that an extension was warranted so that Opposing Counsel could obtain and review “necessary background information from former counsel” and “consider settlement options.”

Argument

Opposing Counsel’s assertions regarding the need for time to consider settlement options and obtain information from former counsel are insufficient to establish good cause warranting an extension.

Regarding Opposing Counsel’s assertion that it needs more time to obtain information from Opposer’s former counsel regarding the proceeding, Opposing Counsel has failed to set

forth with particularity the facts surrounding this need, including both the nature and extent of its attempt(s) to contact Opposer's former counsel, and the nature of the information it needs from former counsel. Opposer also has failed to explain why the eight days between the filing of the Notice of Substitution of Counsel and the opening of the discovery period were insufficient for Opposing Counsel to review the procedural history of this proceeding.¹

Moreover, Opposing Counsel is not wholly new counsel to Opposer, nor to the mark Opposer has asserted here. He has been the Attorney of Record for Opposer's pleaded registration in this proceeding since October 5, 2016, at which time he replaced the same former counsel he has replaced in this proceeding.² Thus, Opposing Counsel is already familiar with Opposer as a client, with Opposer's strategies with regards to its pleaded registration, and with Opposer's former counsel. Further, while Opposing Counsel claims it has yet to obtain information regarding the discovery conference held between the parties from Opposer's former counsel, Applicant's Counsel did inform Opposing Counsel of the only substantive portion of that conference, namely, the proposed changes to the standard protective order, which Applicant's Counsel provided for Opposing Counsel's review (see **Exhibit B**).

Regarding Opposing Counsel's assertion that it needs an extension in order to consider settlement options, such an assertion does not establish good cause. Settlement offers can be made, and negotiations can take place, at any time during the proceeding and the opening of the discovery period is irrelevant to Opposing Counsel's ability to consider its options as pertain to settlement and offer proposals to Applicant. Moreover, no such negotiations or offers are

¹ Applicant notes that Opposing Counsel had sufficient time to review the procedural history of this proceeding such that it knew to obtain the interlocutory attorney's permission to file the Motion to Extend, as required by the Board's Order of January 3, 2017 (TTABVUE 23).

² Indeed, Opposing Counsel appears to be the counsel of record for over 180 of Opposer's pending and registered trademarks since October of 2016, and for all but two of those trademarks, replaced the same former counsel he has replaced in this proceeding.

pending between the parties at this point in time. See *Fairline Boats PLC v. New Howmar Boats Corp.*, 59 U.S.P.Q.2d 1479, 1479 (T.T.A.B. 2000) (In response to movant’s “vague reference to the possibility of settlement of this matter,” the Board noted that such possibility is disputed, and that even “the mere existence of such negotiations or proposals” would not justify a delay in the proceeding.).

Mere assertions are insufficient to establish good cause. See, e.g., *Procyon Pharm. Inc. v. Procyon Biopharma Inc.*, 61 U.S.P.Q.2d 1542, 1544-45 (T.T.A.B. 2001) (citing *HKG Industries, Inc. v. Perma-Pipe, Inc.*, 49 U.S.P.Q.2d 1156, 1158) (movant’s assertion that its principal officer was engaged in a “rearrangement” of its facilities during the relevant time period was insufficient, without further information, to establish good cause). The consideration of settlement options is also insufficient to establish good cause. *Fairline Boats PLC* at 1479. Opposer’s failure to set forth with particularity the nature of the information it still needs from Opposer’s former counsel that cannot be provided by Opposer or by Applicant’s Counsel, the nature and extent of Opposer’s attempts to obtain said information from former counsel, and an explanation of why the eight days before the opening of the discovery proceeding were insufficient for Opposing Counsel to review the procedural history of this case, constitutes a failure to establish good cause warranting an extension. Moreover, such particular facts as could establish good cause do not exist.

Conclusion

For the reasons set forth above, it is respectfully submitted that Opposer’s Motion to Extend should be denied in its entirety.

Dated: New York, New York

March 13, 2017

Respectfully submitted,

FRANKFURT KURNIT KLEIN & SELZ, PC

By: /Donna A. Tobin/

Donna A. Tobin

Kimberly M. Maynard

Dorna Mohaghegh

488 Madison Avenue, 10th Floor

New York, New York 10022

Tel: 212.705.4878

E: dtobin@fkks.com

*Attorneys for Applicant Wisconsin Cheese Group
LLC*

CERTIFICATE OF SERVICE

I hereby certify that on this 13th day of March 2017, I served the foregoing
WISCONSIN CHEESE GROUP LLC'S OPPOSITION TO GOYA FOODS INC.'S
MOTION TO EXTEND DISCOVERY, PRETRIAL DISCLOSURE AND TRIAL
DATES on Opposer Goya Foods, Inc. via e-mail to:

A. John. P. Mancini, Esq.
Mayer Brown LLP
1221 Avenue of the Americas
New York, New York 10020
jmancini@mayerbrown.com

/Kimberly M. Maynard/
Kimberly M. Maynard

EXHIBIT A

Bart, Matthew

From: Crosson, Stephanie <SCrosson@mayerbrown.com> on behalf of Mancini, A. John P. <JMancini@mayerbrown.com>
Sent: Wednesday, February 15, 2017 1:38 PM
To: Tobin, Donna; PTO
Cc: US-CLIENT-Goya-Trademark
Subject: Goya Foods, Inc. v. Wisconsin Cheese Group, LLC: TTAB Opposition No. 91227813
Attachments: Proceeding 91227813 Wisconsin Cheese Group.pdf

Ms. Tobin:

I have substituted in as counsel to Goya Foods, Inc. in connection with the above-referenced opposition proceeding, as per the attached Notice of Substitution of Counsel which was filed today. In light this substitution of counsel, please let me know if you will agree to a 90-day extension of all deadlines in this case, including the upcoming February 23, 2017 discovery conference deadline, for us to get up to speed on this matter and consider possible settlement options. Please let me know if you consent, and we can file the extension request.

Best regards,

John Mancini

A. John P. Mancini

Co-Leader, Intellectual Property Group
T 212 506 2295 F 212 849 5895

Mayer Brown LLP

1221 Avenue of the Americas
New York, New York 10020-1001
jmancini@mayerbrown.com
web: www.ipcounsel.com

This email and any files transmitted with it are intended solely for the use of the individual or entity to whom they are addressed. If you have received this email in error please notify the system manager. If you are not the named addressee you should not disseminate, distribute or copy this e-mail.

EXHIBIT B

Mohagheh, Dorna

From: Tobin, Donna
Sent: Thursday, February 16, 2017 3:07 PM
To: 'Mancini, A. John P.'
Cc: US-CLIENT-Goya-Trademark; Robinson, Faith C.; Mohagheh, Dorna
Subject: RE: Goya Foods, Inc. v. Wisconsin Cheese Group, LLC: TTAB Opposition No. 91227813
Attachments: Goya WCG Modified Protective Order.pdf

Dear Mr. Mancini:

Thank you for your email. Please note that a discovery conference in this matter already was conducted, on February 13, 2017. I attended the call as did Jason L. DeFrancesco of Baker and Rannells, who was representing Goya at the time. I am sure Mr. DeFrancesco can bring you up to speed on the conference.

Among the items discussed was the TTAB standard protective order. Mr. DeFrancesco had no requested changes. We proposed that the parties be required to sign the protective order and that a change be made in para. 16 requiring that the parties certify destruction of confidential information at the close of the proceeding. Mr. DeFrancesco requested that we send our proposed change to him for review. I attach a clean version of the protective order revised to reflect this change. For your convenience, the only change we made to the body of the agreement is as follows:

16) Board's Jurisdiction; Handling of Materials after Termination.

The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

The parties may agree that archival copies of evidence, memoranda, discovery deposition transcripts, testimony deposition transcripts, affidavits, declarations, and briefs may be retained solely by outside counsel, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, each party and their attorneys, as well as any other persons subject to the terms of this agreement, shall return to each party's attorneys shall certify in writing to the other party's attorneys the destruction of the following, as received from the disclosing party: (1) all materials and documents, including ESI, containing protected information, (2) all copies, summaries, and abstracts thereof, and (3) all other materials, memoranda or documents embodying data concerning said material, including all copies provided pursuant to paragraphs 4 and 5 of this Order. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned. Additionally, parties to this agreement are precluded from disclosing orally or in writing any protected information provided during the course of a Board proceeding once this Board proceeding is terminated.

If the Protective Order as revised is acceptable to your client please have it signed and sent back to us for signature.

While I certainly will be as cooperative as possible with you going forward, given that the discovery conference already has been conducted together with the fact that this matter has not yet proceeded to discovery since your client filed its Notice of Opposition nine months ago, in our view there is no need for an extension.

With regard to any possible settlement, if your client wants to provide a settlement offer I will of course present it to my client.

Best regards-

Donna

Donna Tobin | Frankfurt Kurnit Klein & Selz PC
488 Madison Avenue | New York, New York 10022
t: 212.705.4878 | f: 347.438.2141 | DTobin@fkks.com

From: Crosson, Stephanie [mailto:SCrosson@mayerbrown.com] **On Behalf Of** Mancini, A. John P.
Sent: Wednesday, February 15, 2017 1:38 PM
To: Tobin, Donna <DTobin@fkks.com>; PTO <PTO@fkks.com>
Cc: US-CLIENT-Goya-Trademark <GoyaTrademark@mayerbrown.com>
Subject: Goya Foods, Inc. v. Wisconsin Cheese Group, LLC: TTAB Opposition No. 91227813

Ms. Tobin:

I have substituted in as counsel to Goya Foods, Inc. in connection with the above-referenced opposition proceeding, as per the attached Notice of Substitution of Counsel which was filed today. In light this substitution of counsel, please let me know if you will agree to a 90-day extension of all deadlines in this case, including the upcoming February 23, 2017 discovery conference deadline, for us to get up to speed on this matter and consider possible settlement options. Please let me know if you consent, and we can file the extension request.

Best regards,

John Mancini

A. John P. Mancini
Co-Leader, Intellectual Property Group
T 212 506 2295 F 212 849 5895

Mayer Brown LLP
1221 Avenue of the Americas
New York, New York 10020-1001
jmancini@mayerbrown.com
web: www.ipcounsel.com

This email and any files transmitted with it are intended solely for the use of the individual or entity to whom they are addressed. If you have received this email in error please notify the system manager. If you are not the named addressee you should not disseminate, distribute or copy this e-mail.