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Filing date: **01/10/2018**

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

|                        |   |
|------------------------|---|
| Proceeding             | 91231958  |
| Party                  | Defendant<br>Amorepacific Corporation   |
| Correspondence Address | ANN K FORD<br>DLA PIPER LLP (US)<br>500 8TH STREET NW<br>WASHINGTON, DC 20004<br>UNITED STATES<br>Email: dctrademarks@dlapiper.com, ann.ford@dlapiper.com,<br>john.nading@dlapiper.com, eunice.chung@dlapiper.com, al-<br>berto.zacapa@dlapiper.com |
| Submission             | Reply in Support of Motion  |
| Filer's Name           | Ann K. Ford   |
| Filer's email          | ann.ford@dlapiper.com, john.nading@dlapiper.com, ash-<br>ley.joyce@dlapiper.com   |
| Signature              | /Ann K. Ford/   |
| Date                   | 01/10/2018  |
| Attachments            | Reply ISO Motion to Extend.pdf(807550 bytes )   |

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

In the matter of Trademark  
Application Serial No. 86873750  
Mark: PRIMERA  
Filed: January 13, 2016  
Published for Opposition: July 5, 2016

In the matter of Trademark  
Registration No. 3632484  
Mark: PRIMAVERA  
Filed: February 7, 2008  
Registered: June 2, 2009

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|---------------------------|---|----------------------------------|
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| PRIMAVERA LIFE GMBH,      | ) |                                  |
|                           | ) |                                  |
| Opposer/Registrant,       | ) |                                  |
|                           | ) |                                  |
| v.                        | ) | Consolidated Proceedings         |
|                           | ) | Opposition No. 91231958 (Parent) |
| AMOREPACIFIC CORPORATION, | ) | Cancellation No. 92065305        |
|                           | ) |                                  |
| Applicant/Petitioner.     | ) |                                  |
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**APPLICANT/PETITIONER AMOREPACIFIC CORPORATION’S REPLY IN  
SUPPORT OF MOTION TO REOPEN EXPERT DISCLOSURES AND FOR A NINETY-  
DAY EXTENSION OF TIME TO SERVE EXPERT DISCLOSURES  
AND TO RESET ALL SUBSEQUENT DATES**

Applicant/Petitioner Amorepacific Corporation (“Applicant/Petitioner” or “Amorepacific”) files this Reply in Support of Motion to Reopen Expert Disclosures and For a Ninety-Day Extension of Time to Serve Expert Disclosures and To Reset All Subsequent Dates (“Motion” or “Motion to Extend”) (13 TTABVUE). For all of the reasons set forth herein and in its Motion, Amorepacific respectfully requests that the U.S. Trademark Trial and Appeal Board (“Board”) reopen Expert Disclosures and re-set pending case deadlines by ninety days.

Opposer/Registrant Primavera Life GmbH’s (“Opposer/Registrant” or “PLG”) Opposition to the Motion (“Response”) (14 TTABVUE), is confusing at best, as PLG is taking

inconsistent positions regarding case extensions or suspensions. Indeed, the day after filing the Response, PLG's counsel Patrick Concannon demanded that Amorepacific withdraw its Motion in exchange for a thirty-day suspension of the Consolidated Proceedings. (*See* Decl. of Ashley Joyce at ¶ 4, Exh. A (partial email thread between Mr. Concannon and Amorepacific's counsel Ann Ford.)) The flaw in PLG's proposal is that, but for Amorepacific's timely filing of its Motion, the discovery deadline would have otherwise closed on December 4, 2017.

PLG's feigned indignant opposition to an extension of case deadlines now is much ado about nothing. PLG had previously agreed to two thirty-day case suspensions for settlement purposes (9 & 11 TTABVUE), rather than a slightly longer sixty or ninety-day increment which would have been reasonable given the parties' ongoing settlement discussions to try to reach a global resolution. Rather than work cooperatively with Amorepacific in endeavoring to try to reach a resolution expeditiously and conserve resources during negotiations, PLG during the end of year holidays inexplicably refused to consent to a further extension or suspension of case deadlines. Indeed, PLG's counsel did not even extend the courtesy of a response either way to Amorepacific's request for consent to the relief sought in its Motion. (*See* Response at Exh. C.)

Contrary to PLG's unfounded criticism, Amorepacific has not delayed the Consolidated Proceedings.<sup>1</sup> At the time the undersigned counsel for DLA Piper appeared as counsel of record for Amorepacific in the Consolidated Proceedings (on September 14, 2017) (7 & 8 TTABVUE), no extension or suspension of case deadlines had been requested and/or granted. Amorepacific's new counsel requested an extension or suspension in light of the settlement negotiations ongoing

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<sup>1</sup> PLG's reference to a prior proceeding and attachment of a Board decision has no relevance to this Motion to Extend. PLG neglects to note that Amorepacific is the owner of several registrations for PRIMERA and PRIMERA stylized marks.

and in order to transition the file from former counsel. In fact, shortly prior to the undersigned counsel's appearance, PLG had recently served six sets of discovery requests in the Consolidated Proceedings. PLG then consented to two thirty-day case suspensions, which the Board duly granted, including extending the deadlines for Expert Disclosures. (9 & 11 TTABVUE.) At no time prior to its Opposition did PLG ever raise any issue about the extension of expert disclosures, including after the initial case suspension request was granted on September 21, 2017.

On that point, too, PLG fails to recognize that the Board generally will reset the deadline for expert disclosures in tandem with the close of discovery if the close of discovery is reset far enough in the future to accommodate the thirty days between the expert disclosure deadline and the close of discovery, even though expert deadline had already expired at the time Amorepacific filed its Motion. T.B.M.P. § 403.04. PLG's position is also unclear regarding expert disclosures as PLG sent a placeholder letter to Amorepacific on October 3, 2017 which, contrary to disclosing an expert, instead purported to reserve its rights to name an expert. (*See* Response at Exh. A.)

Amorepacific set out in its Motion the good faith efforts made by the parties in the ongoing settlement negotiations and the good cause for the relief requested in the Motion, and contrary to PLG's aspersions, the Motion neither alleges untrue facts nor does it make any negative assertions. The parties exchanged discovery requests in early September 2017 in the Consolidated Proceedings, served discovery responses the first week of January 2018, and negotiations are ongoing. Thus, the parties need more time for discovery if settlement is not attained.

For all of the reasons set forth herein and in Amorepacific's Motion to Extend, Amorepacific respectfully requests that the Board grant the Motion to Extend, and that further

appropriate action be taken in this Consolidated Proceedings, including a reopening of Expert Disclosures, and the granting of a ninety-day extension of time for serving Expert Disclosures and for all subsequent dates.

Dated: January 10, 2018

Respectfully submitted,

By: /s/ Ann K. Ford  
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*Attorneys for Petitioner/Applicant  
Amorepacific Corporation*

**CERTIFICATE OF SERVICE**

This is to certify that a copy of the foregoing **APPLICANT/PETITIONER AMOREPACIFIC CORPORATION'S REPLY IN SUPPORT OF MOTION TO REOPEN EXPERT DISCLOSURES AND FOR A NINETY-DAY EXTENSION OF TIME TO SERVE EXPERT DISCLOSURES AND TO RESET ALL SUBSEQUENT DATES** was served via EMAIL to counsel of record:

Patrick J. Concannon  
NUTTER MCCLENNEN & FISH LLP  
Seaport West, 155 Seaport Boulevard  
Boston, Massachusetts 02210-2604  
pconcannon@nutter.com  
docket@nutter.com

this 10th day of January, 2018.

/s/ Ann K. Ford  
\_\_\_\_\_  
Ann K. Ford  
*Attorney for Petitioner/Applicant*

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

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|                           | ) |                                  |
| Applicant/Petitioner.     | ) |                                  |
|                           | ) |                                  |
|                           | ) |                                  |

**DECLARATION OF ASHLEY H. JOYCE IN SUPPORT OF APPLICANT/PETITIONER  
AMOREPACIFIC CORPORATION'S REPLY IN SUPPORT OF MOTION TO REOPEN  
EXPERT DISCLOSURES AND FOR A NINETY-DAY EXTENSION OF TIME TO  
SERVE EXPERT DISCLOSURES AND TO RESET ALL SUBSEQUENT DATES**

I, Ashley H. Joyce, declare:

1. I am an associate with the law firm of DLA Piper LLP (US), counsel for Amorepacific Corporation ("Amorepacific"), the Petitioner/Applicant in this Consolidated Proceeding.
2. I have personal knowledge of the facts stated herein, and I could and would competently testify to such facts if called upon to do so.
3. I am over the age of 18 and under no disability.

4. **Exhibit A** attached hereto is a true and correct copy of an email sent by Patrick Concannon, counsel for Primavera Life GmbH, to Ann Ford, counsel for Amorepacific, on December 22, 2017.

I declare under penalty of perjury of the laws of the United States of America that the foregoing is true and correct, and that I executed this declaration on January 10, 2018, at Washington, District of Columbia.

  
Ashley H. Joyce



# **Exhibit A**

## Joyce, Ashley

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**From:** Patrick Concannon <PConcannon@nutter.com>  
**Sent:** Friday, December 22, 2017 10:44 AM  
**To:** Ford, Ann K.  
**Cc:** Docket; Fühmeyer, Burkhard; Klein, Fabian; Nading, John; Joyce, Ashley; Chung, Eunice; Zacapa, Alberto; Amorepacific Team; h.lauf@taylorwessing.com  
**Subject:** RE: US TTAB Consolidated Proceeding No. 91231958 (parent) - Motion for 90-day Extension of Time - Primavera Life GmbH v. Amorepacific Corporation

Ann:

I am informed that the decision maker at Amorepacific is not expected back in the office until roughly January 7, 2018. Negotiations can continue then.

If Amorepacific withdraws its motion today, Primavera Life would agree to extend the discovery response deadline and suspend the proceedings each by 30 days. Primavera Life does not consent to the reopening of the expert disclosures period.

I am also informed that the attorneys in European also are facing significant deadlines with the European courts, which are not extendable during the holiday season.

Regards, and Happy Holidays,  
Pat



**Patrick Concannon**  
Nutter McClennen & Fish LLP  
Direct / 617-439-2177

# Redacted