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

Proceeding	91232025
Party	Plaintiff Positec Group Limited
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Submission	Stipulated/Consent Motion to Extend
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Date	10/31/2019
Attachments	RenewedConsentMotionGoodCause-91232025-103119.pdf(53749 bytes)

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

In The Matter Of Pending Application Serial No. 87/003868

POSITEC GROUP LIMITED)	
)	
Opposer)	Opposition No. 91232025
)	
v.)	Mark: CHARGEWORX
)	
FOTO ELECTRIC SUPPLY CO., INC.)	
)	
Applicant)	

FILED VIA ESTTA

Trademark Trial and Appeal Board
P.O. Box 1451
Arlington, Virginia 22313-1451

RENEWED CONSENT MOTION TO EXTEND DEADLINES FOR “GOOD CAUSE”

Positec Group Limited (“Positec”), and Foto Electric Supply Co., Inc. (“FESCO”), by their respective undersigned counsel, jointly move the Board, for good cause shown, to extend the deadline for the close of discovery by 90 days, or until February 1, 2020, and for all subsequent dates to be reset accordingly. (There is no motion currently pending and no other motion is being filed concurrent with this consent motion.) Notably, these are the same dates requested in the parties’ consent motion for an extension of the deadlines filed June 3, 2019, but denied without prejudice as noted below. As good cause for this renewed motion, the parties now submit the following background information and a progress report pursuant to the Board’s June 11, 2019 Order.¹ As explained below, good cause is shown because the parties have been

¹ The undersigned counsel are mindful of the new rules effective August 3, 2019 (84 Fed. Reg. 31498), applicable to foreign-domiciled parties to Trademark Trial and Appeal Board proceedings, but the ESTTA consent motion forms do not appear to provide a ready means for

actively engaged in efforts to settle the matter through a draft settlement document the terms of which have undergone significant negotiations during the past several months.

1. Procedural Background

Previously, the parties filed a Consent Motion to Extend on June 3, 2019, to extend the existing deadlines for 90 days, on the grounds that “Parties are engaged in settlement discussions and require additional time to negotiate a settlement on a global basis. Both parties remain committed to settling this matter.” However, the Board denied the consented motion, without prejudice, on the grounds that the motion did not include a detailed report on the progress of the parties’ settlement, as referenced in the Board’s March 14, 2018 Order. Counsel for the parties apologize for this oversight, and insofar as the motion was denied without prejudice, now provide a progress report as a showing of good cause for the requested extension.

2. Good Cause for the Renewed Consent Motion

The Board’s Order noted that the showing of good cause for a further extension would be satisfied by a detailed status report regarding the progress of the parties’ settlement negotiations. The parties have been expending their efforts toward settlement seeking to address a wide variety of issues. Accordingly, neither party has propounded any discovery, preferring to focus their efforts and resources toward settlement.

During the course of settlement discussions, the parties have sought to take account of changed circumstances regarding particular applications filed by the parties for their respective marks. In June 2019, in an effort to facilitate settlement, Positec’s counsel prepared a reorganized draft to make the terms easier to follow and compare, and also sought to include

compliance. The certifications and information required by the Final Rule are provided to the Board in this filing so that they can be made as of record in this case.

additional matters outside of the United States which became known to the parties' counsel, in an effort to encompass all presently known matters worldwide. The draft was provided to Positec's internal counsel for review, and owing to international travel obligations, feedback and authorization to present a revised draft to FESCO's counsel was delayed until mid-August 2019. The draft was sent to FESCO's counsel for review immediately thereafter on August 12, 2019, with comments to aid in explaining the provisions. On August 19, 2019, FESCO's counsel communicated some questions in an effort to obtain clarification regarding one of the provisions. On August 27, 2019, after receiving client feedback, Positec's counsel provided the requested clarification, and invited FESCO to make known any other issues in the draft that were desirable to be addressed.

Positec's counsel inquired of the status of the draft with FESCO's counsel on October 1, 2019, and FESCO's counsel responded promptly, indicating that he would follow up with FESCO, which was considering the redraft. On October 2, 2019, FESCO's counsel noted some concerns regarding the redraft, and requested that Positec consider them. That same day, Positec's counsel requested further detail regarding those concerns, and suggested that FESCO provide suggested revisions to clarify and address them. Later that day, FESCO's counsel responded that he would prepare a revised draft for consideration, but it would require client approval, which could take some time.

On October 29, 2019, FESCO's counsel followed up with appreciation for Positec's patience as FESCO considered the matter further, but proposed a more simplified approach to resolve the matter, preferring that approach to the detailed redraft under consideration. Positec's counsel immediately noted the impending close of the discovery period (neither party having propounded discovery), and FESCO's counsel agreed to extend the discovery period and

remaining deadlines via a renewed consent motion to the Board, which Positec’s counsel agreed to draft. Positec’s counsel agreed that after the filing of the consent motion, it would turn to consideration of FESCO’s alternative proposal. Positec requested and received clarifications of that proposal from FESCO’s counsel on October 29, 2019, also noting the need to provide certifications to the Board under the new rules in effect applicable to foreign-based entities. (Those certifications are provided with this renewed consent motion).

The proposed reset dates are set forth below.

3. Proposed Reset Dates

The proposed reset dates set forth below were generated through the ESTTA system:

	Current Schedule	Proposed Schedule
Discovery Closes	11/03/2019	02/01/2020
Plaintiff's Pretrial Disclosures Due	12/18/2019	03/17/2020
Plaintiff's 30-day Trial Period Ends	02/01/2020	05/01/2020
Defendant's Pretrial Disclosures Due	02/16/2020	05/16/2020
Defendant's 30-day Trial Period Ends	04/01/2020	06/30/2020
Plaintiff's Rebuttal Disclosures Due	04/16/2020	07/15/2020
Plaintiff's 15-day Rebuttal Period Ends	05/16/2020	08/14/2020
Plaintiff's Opening Brief Due	07/15/2020	10/13/2020
Defendant's Brief Due	08/14/2020	11/12/2020
Plaintiff's Reply Brief Due	08/29/2020	11/27/2020
Request for Oral Hearing (optional) Due	09/08/2020	12/07/2020

4. Conclusion

The parties respectfully request that the Board grant the consented motion, in light of the aforementioned showing of good cause.

Respectfully submitted,

/Scot A. Duvall/

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Dated: October 31, 2019

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CERTIFICATIONS PURSUANT TO 37 C.F.R. §§ 2.11 & 2.17(b)(3)

The undersigned hereby certifies that he is an active member in good standing of the bar of the highest court of a state in the United States (including the District of Columbia or any Commonwealth or territory of the U.S.), specifically, the Commonwealth of Kentucky (Kentucky Bar Association No. 83544, admission date October 12, 1990); and that he is qualified under 37 C.F.R. § 11.14(a) to represent others before the Office and the Trademark Trial and Appeal Board in trademark matters and proceedings.

/Scot A. Duvall/

Scot A. Duvall
Kentucky Bar Association member and
Attorney of record for Opposer,
Positec Group Limited

The undersigned hereby certifies that he is an active member in good standing of the bar of the highest court of a state in the United States (including the District of Columbia or any Commonwealth or territory of the U.S.), specifically, the State of Georgia (Georgia Bar Association No. 140819, year of admission 2004); and that he is qualified under 37 C.F.R. § 11.14(a) to represent others before the Office and the Trademark Trial and Appeal Board in trademark matters and proceedings.

/F. Richard Rimer, Jr./

F. Richard Rimer, Jr.
Georgia Bar Association member and
Attorney of record for Applicant,
Foto Electric Supply Co., Inc.

CERTIFICATE OF SERVICE

I hereby certify that on this 31st day of October 2019, I filed the foregoing RENEWED CONSENT MOTION TO EXTEND DEADLINES FOR GOOD CAUSE via the ESTTA system and served a copy of the foregoing upon the following counsel of record for Applicant by electronic mail:

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