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

Proceeding	91233968
Party	Defendant Besurance Corporation
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Attachments	20180118 App Response to Opp Motion w Ex.pdf(328702 bytes )

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

*In the matter of:*

Application Serial No. 87/089,945  
International Class: 036  
Mark: BESURANCE CORPORATION  
Published in the Official Gazette on December 13, 2016

Application Serial No. 87/089,957  
International Class: 042  
Mark: BESURANCE CORPORATION  
Published in the Official Gazette on December 13, 2016

**Esurance Insurance Services, Inc.**

**Opposer,**

v.

**Besurance Corporation,**

**Applicant.**

**Opposition No. 91233968**

Applicant's Response Consenting in Part and Opposing in Part Opposer's Motion for Leave to Amend Pleadings and Extend Dates filed on December 29, 2017 (Dkt # 9)

Applicant Besurance Corporation, ("**Applicant**") hereby through counsel submits its response to the Motion for Leave to Amend Pleadings and Extend Dates (the "**Motion**") filed by opposer Esurance Insurance Services, Inc. ("**Opposer**") on December 29, 2017. Applicant's response is based on the following Memorandum of Points and Authorities and the attached declaration of Benjamin Ashurov ("Ashurov Decl.").

**MEMORANDUM OF POINTS AND AUTHORITIES**

The Motion makes three distinct requests:

- (1) Granting to Opposer leave to amend its complaint to add a single claim alleging that Applicant had and has no *bona fide* intention to use the trademarks-in-suit;
- (2) Extending the discovery deadline and subsequent deadline by ninety (90) days; and
- (3) Reopening and extending for sixty (60) days the expert disclosure period.

Applicant hereby consents to Opposer's requests for leave to amend its complaint and to extend by ninety (90) days the discovery deadline and subsequent deadlines. However, for the following reasons, Applicant opposes Opposer's request to reopen and extend by (60) days the expert disclosure period and urges the Board to deny the request.

**Opposer's Moving Papers Offer No Support for Its Request to Reopen the Expert Disclosure Period**

Whereas Opposer's moving papers offer some support for Opposer's request for leave to amend<sup>1</sup>, the moving papers make no attempt to support the request to reopen and extend by sixty (60) days the expert disclosure period. Moreover, Opposer offers no logical nexus connecting its request to reopen the expert disclosure period to its request for leave to amend to add a claim of lack of *bona fide* intent to use. This lack of support alone justifies denying Opposer's request to reopen and extend the expert disclosure period.

**Opposer Chose to Act Late Into the Discovery Period**

Pursuant to the Board's institutional order<sup>2</sup>, discovery in this action opened on June 21, 2017 and was set to close on December 18, 2017. The expert disclosure deadline was set for November 18, 2017.

On June 27, 2017 the parties stipulated to suspend the proceeding for a period of thirty (30) days to allow for settlement discussions. The suspension extended the discovery deadline to January 17, 2018 and the expert disclosure deadline to December 18, 2017<sup>3</sup>.

Notwithstanding these looming deadlines, Opposer waited until October 30, 2017 to serve its First Set of Interrogatories and First Set of Document Requests. See Ashurov Decl., ¶ 2. On December 11, 2017 Applicant served its responses to Opposer's First Set of

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<sup>1</sup> Namely, the discovery of new information.

<sup>2</sup> Dkt # 2

<sup>3</sup> See Dkt # 3

Interrogatories and First Set of Document Requests<sup>4</sup>. *Id.* ¶ 3. On December 29, 2017, eleven days past the expert disclosure deadline, Opposer filed its Motion.

**Opposer’s Request to Reopen and Extend the Expert Disclosure Period Fails to Meet the Excusable Neglect Standard**

Opposer’s request to reopen and extend the expert disclosure period is subject to the *excusable neglect* standard because the Motion (filed on December 29, 2017) was filed after the expiration of the December 18, 2017 expert disclosure deadline. See FRCP 6(b) governing extension requests in TTAB proceedings, which provides as follows:

(1) **In General.** When an act may or must be done within a specified time, the court may, for good cause, extend the time:

(A) with or without motion or notice if the court acts, or if a request is made, before the original time or its extension expires; or

(B) on motion made **after the time has expired** if the party failed to act because of excusable neglect. (Emphasis added).

Despite the applicability of this stringent standard in this instance, Opposer’s moving papers make no attempt to prove excusable neglect.

Instead, Opposer’s request to reopen and extend the expert disclosure period appears to be grounded in the same arguments as Opposer’s request for leave to amend, namely, the discovery of new information in Applicant’s responses to Opposer’s written discovery requests served on October 30, 2017). See Motion, p.5 (“For these same reasons . . . Opposer respectfully makes a further request that the Board issue a new scheduling order . . .”). This fails to meet the “excusable neglect” standard considering that Opposer would have discovered this allegedly new information earlier if Opposer acted earlier in the

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<sup>4</sup> It is in these responses that Opposer claims to have discovered new information which caused Opposer to file its Motion.

discovery period.

The Board routinely denies discovery extension requests under the “*good cause*” standard<sup>5</sup> when the extension is necessitated by the moving party’s own delay in conducting discovery. See *National Football League v. DNH Management LLC*, 85 USPQ2d 1852 (TTAB 2008) (mere delay in initiating discovery does not constitute good cause for an extension of the discovery period).

For extension requests subject to the much more stringent standard of “excusable neglect”, a party’s own delay should be similarly fatal. To the extent Opposer’s request to reopen and extend the expert disclosure period is based on allegedly new information discovered in Applicant’s responses to Opposer’s written discovery requests served on October 30, 2017, the request should be denied considering that Opposer waited more than four months to serve its written discovery. Moreover, having received Applicant’s responses on December 11, 2017, Opposer had sufficient time to file its request to extend the expert disclosure period prior to the December 18 deadline.

Furthermore, Opposer’s moving papers fail to explain why an amendment adding a claim alleging Applicant’s lack of *bona fide* intent to use the trademarks-in-suit requires any expert testimony at all. A claim alleging Applicant’s lack of *bona fide* intent focuses entirely on Applicant’s intentions and conduct, and thus expert testimony would offer no help.

**The Applicant Would Be Prejudiced by a Reopening of the Expert Disclosure Period**

The prejudicial impact to the Applicant that would result from a reopening of the expert disclosure period further instructs that Opposer’s request to re-open and extend the expert disclosure period should be denied. Whereas Opposer is a large multinational corporation which Opposer alleges is “famous”, Applicant is a fairly new start up with limited

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<sup>5</sup> A much less stringent standard which applies to requests made prior to the expiration of the time to act.

resources. See Ashurov Decl., ¶ 4. Thus, Opposer is better suited to absorb expert-related costs and can leverage such costs against the Applicant. Granting to Opposer a second opportunity to leverage against Applicant expert-related costs will negatively impact Applicant's ability to mount a defense should this case proceed to trial. Moreover, if Applicant is forced to spend resources to rebut any of Opposer's experts, Applicant would need to sacrifice the ability to use those valuable and limited resources elsewhere in order to grow its business.

For the foregoing reasons, (due to Applicant's consent) the Board should grant the Opposer's request for leave to amend and for an extension of the discovery deadline and all *subsequent deadlines* by a period of ninety (90) days, but should deny Opposer's request to reopen and extend the expert disclosure deadline by a period of sixty (60) days. To the extent the Board feels compelled to reopen the expert disclosure period, it should limit any such reopening solely as it applies to Opposer's new claim alleging lack of *bona fide* intent by Applicant.

Dated: January 18, 2018

Respectfully Submitted,

By:           /Benjamin Ashurov/            
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### **DECLARATION OF BENJAMIN ASHUROV**

I, Benjamin Ashurov, am over the age of 18 and I declare as follows:

1. I am employed by KB Ash Law Group PC, legal counsel to Besurance Corporation ("Applicant") in this action.
2. I received opposer's First Set of Interrogatories and First Set of Document Requests on October 30, 2017.
3. On December 11, 2017 I served on opposer Applicant's responses to opposer's First Set of Interrogatories and First Set of Document Requests.
4. Applicant is a recently organized start up with limited resources which it needs to grow its business.

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge.



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Benjamin Ashurov

Date: January 18, 2018

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **Applicant's Response Consenting in Part and Opposing in Part Opposer's Motion for Leave to Amend Pleadings and Extend Dates filed on December 29, 2017** has been served on opposing counsel by forwarding said copy on January 18, 2018 via email to:

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Signature: /Benjamin Ashurov/  
Benjamin Ashurov

Dated: January 18, 2018