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

Proceeding	91233968
Party	Plaintiff Esurance Insurance Services, Inc.
Correspondence Address	JAMI A GEKAS FOLEY & LARDNER LLP 321 NORTH CLARK STREET, SUITE 2800 CHICAGO, IL 60654-5313 UNITED STATES Email: jgekas@foley.com, aschumacher@foley.com, jrodriguez@foley.com, kcalifa@foley.com, nquintero@foley.com, ipdocketing@foley.com
Submission	Reply in Support of Motion
Filer's Name	Katherine Califa
Filer's email	IPDocketing@foley.com, JGekas@foley.com, KCalifa@foley.com
Signature	/Katherine Califa/
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Attachments	Reply in Support of Motion for Leave to Amend Notice of Opposition - BESURANCE CORPORATION.pdf(45231 bytes)

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

ESURANCE INSURANCE SERVICES, INC.,	:	
Opposer,	:	**Opp. No. 91233968**
v.	:	Mark: BESURANCE CORPORATION
BESURANCE CORPORATION,	:	Serial No. 87/089,957 Serial No. 87/089,945
Applicant.	:	

REPLY IN SUPPORT OF
MOTION FOR LEAVE TO AMEND CONSOLIDATED NOTICE OF OPPOSITION
AND SUSPEND PROCEEDINGS AND RESET DATES

Esurance Insurance Services, Inc. ("**Opposer**") hereby files this reply in support of its *Motion for Leave to Amend Consolidated Notice of Opposition and Suspend Proceedings and Reset Dates* ("**Motion**"). In its Motion, Opposer presented the following three requests to the Board:

i. Grant Opposer leave to amend its Consolidated Notice of Opposition ("**Pleading**") to add a new basis for opposition based on information obtained during discovery. In its Response to Opposer's Motion ("**Response**"), Applicant consented to this request.

ii. Suspend the proceedings pending resolution of the Motion. Applicant failed to respond to this request; thus, Opposer assumes Applicant does not object to the requested suspension.

iii. Issue a new Scheduling Order resetting all trial dates. This request included a request that the Board provide an additional sixty (60) days to make expert disclosures and an additional ninety (90) days to complete discovery. Applicant

consented to the Board providing an additional ninety (90) days to complete discovery and to resetting all subsequent deadlines. However, Applicant opposed Opposer's request to provide an additional sixty (60) days to make expert disclosures.

This Reply Brief is filed in support of Opposer's request that the Board provide an additional sixty (60) days to make expert disclosures. Applicant has consented (or failed to object) to all the remaining requests in Opposer's Motion.

1. Opposer's request that the Board provide an additional sixty days to make expert disclosures is reasonable, serves the interests of judicial economy, and will not prejudice Applicant.

2. Based on information obtained during discovery, Opposer seeks to add as a new ground of opposition that Applicant lacked the requisite *bona fide* intent to use the BESURANCE CORPORATION mark at the time it filed the subject applications, rendering those applications void *ab initio*. This is a potentially dispositive claim that will inform and guide both parties' litigation strategies moving forward.

3. Simply put, Applicant's answer to the new ground of opposition and additional factual discovery related thereto will inform Opposer's decision as to whether to retain an expert witness, as well as the subject matter and scope of such expert testimony.

4. To the extent Opposer can dispose of the opposed applications based solely on Applicant's lack of *bona fide* intent to use, then it will not be necessary to retain an expert witness in support of the other two claims alleged in the Pleading.

5. Likewise, to the extent Opposer can dispose of one of the opposed applications based solely on Applicant's lack of *bona fide* intent to use, then the scope of issues at trial and,

by extension, the scope of issues to be considered by an expert witness will be narrowed and focused. This conserves both parties' and the Board's limited resources. Naturally, Opposer's decision as to which expert, if any, should be retained will depend on the precise issues that remain for trial.

6. Moreover, an expert witness may be helpful to adjudicate issues related to Opposer's new claim, such as business, legal and regulatory activities required to begin to offer the services claimed in the contested applications, the typical incubation period for new businesses offering these services, what activities are considered part of the ordinary course of trade for companies that seek to offer such services, and so on. Thus, Applicant's assertion that the newly added claim will not benefit from expert testimony (Response, p. 4) is not well-founded.

7. Applicant argues that Opposer acted too late in the discovery period to justify re-opening the expert disclosure deadline. (Response p. 2-3). This is simply not the case. Opposer served its written discovery on Applicant well before the close of discovery. As a professional courtesy, Opposer granted Applicant's request for a short extension of the deadline to respond to its discovery. Accordingly, Opposer did not receive Applicant's responses to its discovery requests until December 11, 2017. Opposer acted promptly by filing the instant Motion approximately two-and-a-half weeks after learning of the additional grounds for opposition and just eleven days after the expert disclosures deadline.

8. Applicant argues that Opposer's request to reopen and extend the expert disclosure deadline should be governed by the excusable neglect standard. (Response p. 3). Even under this standard, Opposer's request should be granted. At its core, the "excusable neglect" standard is an equitable one. *Pioneer Investment Services Co. v. Brunswick Associates*

L.P., 507 U.S. 380 (1993). The relevant factors are: (1) the danger of prejudice to Applicant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the Opposer, and (4) whether the Opposer acted in good faith. *See Id.* at 395. Balancing the interests of the parties and the Board, the equitable answer here is to grant an additional sixty days for the parties to make expert disclosures.

9. Applicant would suffer no prejudice from this short extension of the expert disclosure deadline. Applicant's allegation that it would suffer prejudice because of the relative size of the companies and its presumption that Opposer is "better suited to absorb expert-related costs and can leverage such costs against the Applicant" (Response p. 5) fails. Under the applicable standard, "prejudice" refers to the nonmovant's ability to litigate the case due to, for example, the loss or unavailability of evidence or witnesses which otherwise would have been available to the nonmovant. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1587 (TTAB 1997). Applicant has asserted no such loss of the ability to litigate the case. Indeed, Opposer has requested that the expert disclosure deadline be extended for *both* parties, providing Applicant with an equal opportunity to identify relevant expert witnesses and litigate its case.

10. The length of the delay in this case is exceedingly short – a mere eleven days after the expert disclosure deadline. There will be no adverse impact on the judicial proceedings or the Board's docket if the Board resets the expert disclosures deadline, in addition to resetting all the other discovery and trial deadlines to which Applicant has consented. The Federal Rules of Civil Procedure require that a party make expert disclosures at least 90 days before the date set for trial or for the case to be ready for trial. Fed. R. Civ. P. 26(a)(2)(D)(i). The new deadline requested by Opposer complies with this requirement.

11. The reason for the delay is that in the interest of judicial economy, and due to the related and interdependent nature of the requests, Opposer combined its request for the Board to issue a new scheduling order resetting all applicable dates with its motion for leave to amend its Pleading to add lack of *bona fide* intent to use as an additional basis for opposition. It would be premature to make expert disclosures at this stage with so much of the case in flux. Applicant's answer and factual discovery related to the new *bona fide* use claim may (i) dispose of the case entirely, in which case expert testimony may not be required, (ii) narrow the scope of issues at trial and therefore, inform the selection of an appropriate expert witness, and/or (iii) raise new questions which may benefit from expert testimony. Thus, Opposer's request for an additional sixty days to make expert disclosures is closely and inextricably intertwined with its request for leave to amend Opposer's Pleading to add a new basis for opposition. This combined Motion was filed approximately two-and-a-half weeks after learning of the additional claim. Thus, any delay on Opposer's part was minimal.

12. At all times Opposer acted in good faith. Applicant has not alleged otherwise.

13. Balancing the factors, it would be equitable for the Board to grant both parties an additional sixty (60) days to make expert disclosures.

Thus, Opposer reiterates its request that upon the issuance of the Board's decision on its Motion, that the Board issue a new scheduling order, resetting all dates, as follows:

a. Opposer asks for an additional sixty (60) days from the date of the Board's Order to make its expert disclosures;

b. Opposer asks for an additional ninety (90) days from the date of the Board's Order to complete discovery;

c. Opposer asks that all additional dates be reset accordingly.

CONCLUSION

For the reasons set forth above, Opposer respectfully requests that the Board suspend the cancellation proceed until the Board issues a decision on Opposer's request for leave to amend, grant Opposer leave to amend its Consolidated Notice of Opposition, and issue a new scheduling order, resetting the remaining dates in the proceeding and including an additional 60 days for expert disclosures and an additional 90 days for discovery.

Respectfully submitted,

FOLEY & LARDNER LLP

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Jami A. Gekas
Katherine P. Califa
321 North Clark Street
Suite 2800
Chicago, Illinois 60654
312-832-5191
jgekas@foley.com
KCalifa@foley.com
ipdocketing@foley.com
Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on February 7, 2018, a copy of the foregoing REPLY IN SUPPORT OF MOTION FOR LEAVE TO AMEND CONSOLIDATED NOTICE OF OPPOSITION AND SUSPEND PROCEEDINGS AND RESET DATES was served via email upon counsel for Applicant, as follows:

Benjamin Ashurov
KB Ash Law Group PC
7011 Koll Center Pkwy Suite 160
Pleasanton, CA 94566
bashurov@kb-ash.com
pto@kb-ash.com

_/Katherine P. Califa/_____
FOLEY & LARDNER LLP