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

Proceeding	91241497
Party	Plaintiff Essential Brands, Inc.
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Date	01/11/2019
Attachments	Motion to Extend Discovery Without Consent KIDDY LEARNING STA- TION.pdf(230658 bytes )

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

In the Matter of:

Application Serial No. 87636200

Mark: KIDDY LEARNING STATION

Published in the Official Gazette: May 1, 2018

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Essential Brands, Inc.	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91241497
	)	Appln. Serial No. 87636200
Kiddy Learning Center, LLC	)	
	)	
Applicant.	)	
_____	)	

**MOTION TO EXTEND**

Opposer, Essential Brands, Inc. (“Opposer”), hereby moves the Board to extend the close of discovery and all remaining deadlines and trial dates for two (2) weeks. In accordance with TBMP 509.02, Opposer respectfully requests that the requested two-week extension be set to run from the date of the Board’s decision on this Motion.

Following the breakdown of settlement negotiations that had been ongoing for months, on January 8, 2019 Opposer inquired with Applicant whether Applicant would consent to procuring a 75-day extension of the discovery deadline. The next day, Applicant declined to consent to such relief, and offered no shorter period of an extension to which it would consent.

Good cause exists to grant the requested extension because Opposer has relied in good faith on the parties’ ongoing negotiations and devoted its time and resources towards that process in the hopes that the matter would be resolved and no Discovery Requests would need to be

served. Opposer has now served its Discovery Requests on January 11, 2019, so minimal additional time is required in order for the matter to proceed with full discovery towards a resolution on the merits. In view of the forgoing, this Motion is not made for the purpose of improper delay.

**Facts and Timeline of the Parties' Settlement Discussions**

At the request of Applicant, the Parties first discussed the idea of potential settlement on a phone call on July 9, 2018. The Parties then exchanged letters about each other's respective positions on July 19, 2018 and July 25, 2018, particularly in view of a prior written Agreement between the Parties with an effective date of October 27, 2005 (the "2005 Settlement Agreement"). On August 1, 2018, the Parties participated in the mandatory Discovery Conference via phone. During the Discovery Conference, Applicant's counsel stated that the Applicant was working on a settlement proposal and that Counsel would follow-up with Opposer shortly on that.

In reliance on the expected settlement proposal, Opposer refrained from serving discovery requests on Applicant at that time. Nearly a month after Discovery opened and over a month after the Discovery Conference, Applicant finally sent Opposer its settlement proposal, on September 5, 2018. In view of the existing 2005 Settlement Agreement between the Parties, it was necessary for Opposer to give detailed consideration to Applicant's proposal. In the meantime, and while considering Applicant's settlement proposal, Opposer timely served its Initial Disclosures on September 10, 2018.<sup>1</sup>

Opposer moved the settlement discussions forward on November 6, 2018 when Opposer provided responses to the Applicant's settlement proposal, as well as further proposed terms. Opposer advised on that date that it remained open to settlement. Then, more than a month

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<sup>1</sup> Ironically, Applicant missed the Initial Disclosure deadline, and served its Initial Disclosures five days late, on September 15, 2018. Opposer lodged no objection to this unexplained delay.

passed, and Opposer had not received a reply to its settlement counterproposal. As such, Opposer followed up with Applicant's counsel on December 12, 2018. Then, after this follow-up, Applicant's Counsel advised that lead counsel on the matter had left the firm and a new attorney would be taking over the matter for Applicant.

Another five days went by until a substantive response was received from Applicant's counsel on December 17, 2018. Based on that response, it seemed that more time would be needed for the Parties to discuss potential settlement terms; and as such, on December 20, 2018, Opposer in good faith requested a 90-day suspension of the proceedings for settlement discussions. Applicant's Counsel on the same day replied that it would only agree to such a suspension if Opposer accepted Applicant's settlement terms without alteration. Applicant's Counsel advised that if Opposer does not accept the terms, it would only agree to a 30-day suspension.<sup>2</sup>

After this December 20 correspondence, the holiday season commenced with personal vacations and closures of offices (including the United States Patent and Trademark Office and Opposer's Counsel's office) through December 26 and then again for New Year's Day, January 1, 2019. The Parties then exchanged emails on January 23, 2019, regarding the status of potential settlement.

Applicant served Discovery Requests on Opposer on Saturday, January 5, 2019. On Tuesday, January 8, Opposer provided substantive responses to Applicant's Discovery Requests, and advised that it seemed that the Parties were seemingly not aligned on settlement and that the opposition proceedings should continue. As such, given the Parties' ongoing good faith attempts to settle the matter for months, Opposer requested Applicant's consent to 75-day extension of the

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<sup>2</sup> Opposer notes that a 30-day suspension would not have been effective to reset any deadlines given that the next substantive deadline—the close of Discovery—was still more than 30 days away at the time of the request for consent to suspension.

discovery period. Applicant's Counsel responded on January 9, 2019 that it would not consent to the 75-day extension, and offered no counter-proposal in that regard.

**Good Cause Basis for Extension**

As is evident from the facts and timeline set forth above, Opposer actively engaged in settlement discussions with the Applicant dating back to July 2018—just about 6 weeks after the initial Notice of Opposition was filed on May 31, 2018. The Parties engaged of several rounds of settlement discussions dating back to July 9, 2018 and extending up through January 8, 2019. Opposer has continuously acted in good faith in its discussions and, therefore, similarly in good faith relied upon Applicant's statements that Applicant remained interested in settlement of the matter. As such, Opposer refrained from burdening either party with discovery in a reliance on the engagement in good faith negotiations, as well as expected extensions and suspensions as needed, as is fairly standard for parties negotiating settlement. But now, Applicant has inexplicably taken a hardline stance, refusing to consent to an extension even as a professional courtesy.

In view of this, it is only now—as of January 8, 2019, three days before this Motion has been filed—evident to Opponent that Applicant does not in fact intend to work toward settlement of the matter; and as such, Opponent must continue to litigate the case. The requested minor extension of the discovery period will allow the thirty (30) days required under the Rules for Applicant to respond to the Opponent's Discovery Requests, which have been served today. Indeed, as there are still twenty-five (25) days left in the discovery period, even an extension of a mere five (5) days would provide sufficient time under the Rules for the Applicant to respond to Opposer's Discovery Requests. As such, it is clear that this extension is necessary and not intended for the purposes of improper delay.

Moreover, as the Applicant itself engaged in a total delay of at least two (2) months and eleven (11) days during the course of settlement discussions and the Discovery period (during

which time its prior counsel had departed, without notice to Opposer), Opposer's requested minor extension is justified and warranted.

In the event that this Motion is not granted, Applicant respectfully requests additional time to file its Answer.

Dated: January 11, 2019

Respectfully submitted,

**NIXON PEABODY LLP**

by: /Lauren J. Arnold/\_\_\_\_\_

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**CERTIFICATE OF SERVICE**

I hereby certify that on January 11, 2019 I caused to be served via electronic mail a true and correct copy of the foregoing Motion to Extend, upon the following:

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