

ESTTA Tracking number: **ESTTA1184118**

Filing date: **01/12/2022**

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

Proceeding no.	91266802
Party	Plaintiff ITS, Inc.
Correspondence address	CLINTON G. NEWTON SHOOK, HARDY & BACON L.L.P. 2555 GRAND BLVD. KANSAS CITY, MO 64108 UNITED STATES Primary email: cgntmdocket@shb.com 816-474-6550
Submission	Opposition/Response to Motion
Filer's name	Clinton G. Newton
Filer's email	cgntmdocket@shb.com
Signature	/CGN #42930/
Date	01/12/2022
Attachments	2022-01-12 - Opposer ITS Response to Sezzle Extension Motion - 4867-8737-7672.pdf(74379 bytes) 2022-01-12 - ITS Index of Evidence ISO ITS Response to Sezzle Extension Motion - 4866-7554-9705.pdf(35800 bytes) 2022-01-11 - Response to Motion to Extend - Exhibits A-J with bookmarks.pdf(794753 bytes)

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

In the matter of: Trademark Application Serial No. 88/891,706



For the Mark:

Published in the Official Gazette: September 1, 2020

ITS, Inc.,

Opposer,

v.

Opposition No. 91266802
Serial No. 88/891,706

Sezzle Inc.,

Applicant.

OPPOSER ITS'S RESPONSE TO SEZZLE'S MOTION TO EXTEND

Pursuant to the Board's December 20, 2021 Order (Doc. 11), Opposer ITS, Inc. ("ITS") submits the following response in opposition to Sezzle's motion to extend the fact discovery deadline by forty-five days (Doc. 12).

I. INTRODUCTION

Sezzle's request for a bilateral forty-five (45) day extension of the discovery deadline was necessitated solely because of its lack of diligence in producing documents, making a witness available in response to ITS's timely-served 30(b)(6) notice, and timely propounding its 30(b)(6) deposition notice. Indeed, as fully explained in ITS's motion for extension and forthcoming reply in support, good cause exists only to unilaterally extend the fact discovery deadline for the limited purpose of allowing ITS to depose Sezzle on ITS's timely-served 30(b)(6) notice. Given Sezzle's lack of diligence during this proceeding, good cause does not exist to bilaterally extend this deadline to allow Sezzle to depose ITS on its untimely-served 30(b)(6) notice. Sezzle argues that its lack of diligence was warranted, among other things, by the parties' ongoing settlement

negotiations. It is black letter law, however, that settlement negotiations do not relieve a party of its obligation to timely serve discovery. Moreover, Sezzle's argument is disingenuous as it conveniently omits that it denied several of ITS's requests to suspend this matter throughout the discovery period for settlement discussions. Sezzle's lack of diligence in this proceeding is the basis for both parties' motion to extend, but Sezzle benefits from its lack of diligence if its motion is granted. Accordingly, the Board should find that good cause does not exist to extend the fact discovery deadline for both parties and should deny Sezzle's motion for extension.

II. FACTS

ITS filed this proceeding in December 2020. Doc. 1. In May 2021, the Board granted ITS's consent motion for suspension of the deadlines in view of the parties' settlement negotiations. Doc. 8. However, in July 2021 when ITS requested Sezzle's consent to an additional suspension, Sezzle declined noting that "[t]hey would be open to offers for settlement, but [we]re inclined to move the case along." Ex. A at 1. In September 2021, Sezzle served document requests and interrogatories on ITS. Ex. B. ITS approached Sezzle again in October 2021 and requested that Sezzle consent to a suspension of the proceeding based on ITS's proposed settlement offer restricting the goods and services listed in Sezzle's pending trademark application. Ex. C at 2. Sezzle stated that "they [we]re not interested in this settlement offer as they [we]re not inclined to restrict their use" and "d[id] not wish to extend the opposition further without a settlement proposal that d[id] not restrict use of their current mark." Ex. C at 1.

In November 2021, ITS proposed a meeting between the parties to further discuss settlement options, and Sezzle formally responded to ITS's document request, interrogatories, and requests for admission. Ex. D; Ex. E. By the end of November 2021, however, the parties had still not agreed on a date for their settlement meeting; nor had Sezzle produced any documents in response to ITS's document requests, provided a formal response to ITS's 30(b)(6) deposition

notice, or provided a date when it would makes a deponent available. Ex. F at 1. Accordingly, ITS requested Sezzle’s consent to suspend the existing deadlines, including the impending Monday, December 6, 2021, close of discovery deadline, for the limited purpose of giving Sezzle additional time to produce documents (as none had been produced to date), provide a formal response to ITS’s 30(b)(6) notice, make a witness available on ITS’s notice, and to allow the parties to have their settlement meeting. Ex. G at 1.

Towards the close of business on Thursday, December 2, 2021, Sezzle refused to consent to the suspension, requesting instead that ITS consent to a sixty-day extension of the Monday, December 6, 2021, discovery deadline, in essence reopening discovery and providing Sezzle with the opportunity to propound additional written discovery despite the time for doing so having past almost a month prior. Ex. G at 1-2. ITS declined to consent. Ex. G at 1. After the close of business on Friday, December 3, 2021, Sezzle then served ITS with a thirteen-topic 30(b)(6) deposition notice for Monday, December 6, 2021, at 9:00 a.m. (Ex. H), with no intention of taking the deposition at that time, as it was the same date and time Sezzle had previously informed ITS that it was unavailable for ITS’s prior noticed 30(b)(6) deposition. Ex. F at 2. ITS immediately informed Sezzle it objected to the notice as untimely. Ex. I. Sezzle then requested that ITS agree to a forty-five day extension of the discovery deadline and highlighted that Sezzle was “certainly prepared to file a motion for an extension—one that the Board would be inclined to grant.” Ex. J.

III. LEGAL STANDARD

“Pursuant to Fed. R. Civ. P. 6(b)(1)(A), made applicable to Board proceedings by Trademark Rule 2.116(a), the appropriate standard for allowing an extension of a specified time period prior to the expiration of that period is ‘good cause.’” *Nomi Network, Inc. v. Nomi Beauty*, No. 91234184, 2020 WL 1809218, at *1 (T.T.A.B. Apr. 2, 2020). “The moving party . . . retains the burden of persuading the Board that it was diligent in meeting its

responsibilities and should therefore be awarded additional time.” *Nat’l Football League v. DNH Mgmt., LLC*, No. 91186569, 2008 WL 258323, at *1 (T.T.A.B. Jan. 29, 2008).

IV. ARGUMENT

Sezzle has not met its burden of establishing that it was diligent in meeting its responsibilities in this proceeding, and as such, the Board should find that good cause does not exist to extend the fact discovery deadline. Sezzle asserts that the Board should grant its request for a forty-five day extension of the fact discovery period to allow the parties to continue settlement negotiations and to allow Sezzle to conduct a 30(b)(6) deposition of ITS. Doc. 10 at 2-3. But, it is well settled that the parties’ settlement negotiations did not relieve Sezzle of its obligation to timely serve discovery. *See, e.g., Backcountry.com, LLC v. Branded, LLC*, No. 91241275, 2019 WL 4727648, at *5-6 (T.T.A.B. Sept. 25, 2019) (denying for lack of good cause opposer’s motion to extend the discovery period based on the parties’ settlement negotiations and highlighting that “[i]t is well settled that the mere existence of settlement negotiations alone does not justify a party’s inaction or delay.”); *Fairline Boats plc v. New Howmar Boats Corp.*, 2000 WL 33321169, at *1 (T.T.A.B. Dec. 12, 2000) (denying motion to extend deadlines under the good cause standard and noting that the mere existence of settlement negotiations or proposals without more do not justify petitioner’s delay); *Atlanta-Fulton Cty. Zoo Inc. v. DePalma*, No. 98919, 1998 WL 104306, at *2 (T.T.A.B. Feb. 12, 1998) (“Parties engaged in proceedings before the Board frequently discuss settlement, but the existence of such negotiations or offers, without more, does not excuse them from complying with the deadlines set by the Board or imposed by the rules.”). Nor could Sezzle have reasonably concluded that it did not need to move forward with timely serving its 30(b)(6) notice in view of ITS’s timely service of a 30(b)(6) notice two weeks earlier (on November 17th) and the parties’ most recent settlement discussions given the parties’ numerous failed attempts at settlement over the past year.

Moreover, Sezzle is critically unable to identify any exigent circumstances that prevented it from timely serving its 30(b)(6) notice (or any other untimely discovery it seeks to conduct). *See* Doc. 10 at 1-5. Sezzle argues that in October and November two of its three attorneys of record “were busy addressing a crush of litigation deadlines in other matters.” Doc. 10 at 2. But this in no way prevented Sezzle from timely serving its 30(b)(6) deposition notice. Indeed, during this same time period, Sezzle was able to serve interrogatories and document requests and provide formal objections and responses to ITS’s interrogatories, document requests, and requests for admission. Ex. E. Nor did the busy schedules of Sezzle’s attorneys in October and November prevent Sezzle from serving a 30(b)(6) notice and deposing ITS on this notice prior to October 2021 when these attorneys were presumably not busy. In fact, Sezzle started the discovery between the parties on September 17th when it served its Interrogatories and Requests for Production. Ex. B. Further, Sezzle demonstrated that it only needed a couple of hours to prepare and serve a 30(b)(6) deposition notice. When told on Friday, December 3rd at 3:44 PM that the time for giving reasonable notice for a deposition had passed (Ex. G), Sezzle’s counsel was able to draft and serve a 30(b)(6) notice less than two hours later, at 5:15 PM (Ex. H).

Here, the facts establish that Sezzle merely delayed in initiating the untimely discovery it now seeks to obtain through its motion for extension. The Board has consistently held that this is insufficient for finding good cause to extend the fact discovery deadline. *See, e.g., Nomi Network, Inc. v. Nomi Beauty*, No. 91234184, 2020 WL 1809218, at *3 (T.T.A.B. Apr. 2, 2020) (finding good cause did not exist to extend the discovery deadline and noting that “[i]f Opposer desired to take discovery depositions in this proceeding, it should have commenced the process for coordinating and scheduling such depositions prior to the waning days of the already-extended discovery period”); *Amazon Techs., Inc. v. Foxconn Interconnect Tech.*, No. 91236517, 2019 WL

259580, at *3 (T.T.A.B. Jan. 16, 2019) (denying motion to extend discovery deadline for lack of good cause where movant did “not adequately explain why it did not seek discovery earlier in the proceeding”); *Nat’l Football League*, 2008 WL 258323, at *2 (finding good cause did not exist to extend the fact discovery deadline where opposers failed to identify any exigent circumstances that prevented them from timely serving discovery and noting that “[c]learly, [] opposers’ claimed need for an extension of discovery is the product solely of opposers’ unwarranted delay in initiating discovery.”)

Sezzle relies on *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, No. 115,956, 2001 WL 609673, at *1 (T.T.A.B. May 2, 2001) and *Kelima K LLC v. Wardrobe Therapy, LLC*, No. 91217702, 2015 WL 9906652, at * 2 (T.T.A.B. Nov. 30, 2015) in support of its assertion that the press of litigation constitutes good cause for extending the discovery deadline in this case. Sezzle’s Mot. at 3. But, those cases are readily distinguishable. The movants in those cases did not move to extend the fact discovery deadline to serve discovery that they had the ability to timely serve within the original lengthy fact discovery window. Instead, the movants were seeking an extension of the trial testimony period and summary judgment response period, respectively, in light of other litigation obligations occurring during those limited time periods.

Sezzle further asserts that ITS will suffer no prejudice “in any way” if the Board grants Sezzle’s motion to extend the fact discovery deadline. Doc. 4. But contrary to Sezzle’s assertion, ITS will suffer prejudice. If the Board grants Sezzle a free pass here, ITS will have to expend significant resources that it would not otherwise have to expend, and Sezzle will get an additional opportunity to strengthen its defense of this case. And, in any event, “[t]he existence or degree of prejudice to the party opposing modification . . . is irrelevant to the moving party’s exercise of

diligence and does not show good cause.” *Shemendera v. First Niagara Bank N.A.*, 288 F.R.D. 251, 253 (W.D.N.Y. 2012); *see also In re EpiPen (Epinephrine Injection, USP) Mktg., Sales Pracs. & Antitrust Litig.*, No. 17-MD-2785-DDC-TJJ, 2020 WL 1942188, at *3 (D. Kan. Apr. 22, 2020) (“The absence of prejudice to the opposing party does not constitute an affirmative showing of ‘good cause’ to alter the schedule ordered by the court.”); *Tesone v. Empire Mktg. Strategies*, No. 17-CV-02101-MEH, 2019 WL 8223285, at *2 (D. Colo. Jan. 17, 2019), *aff’d*, 942 F.3d 979 (10th Cir. 2019) (“prejudice to the defendant is irrelevant to a ‘good cause’ analysis”); 3 Moore’s Federal Practice § 16.14[1][b] (Matthew Bender 3d ed. 2018) (“The existence or degree of prejudice . . . is irrelevant to the moving party’s exercise of diligence and does not show good cause”).

V. CONCLUSION

Applicant, Sezzle, has moved for a forty-five (45) day extension of the discovery deadline solely so it can conduct discovery it did not timely propound or complete during the almost five month discovery period from when the proceedings resumed on July 10th to the close of discovery on December 6th. While Sezzle couches its request as “a bilateral extension of time” and a “bilateral extension of fact discovery” (Doc. 10 at 1), ITS does not need additional time for discovery, except to rightfully depose Sezzle’s timely noticed 30(b)(6) witness(es) once Sezzle produces such witness(es). With the exception of deposing Sezzle’s 30(b)(6) witness(es) it has yet to produce, ITS completed its discovery during the discovery period, including requesting, responding to, and supplementing discovery. Sezzle cannot say the same. The request made by Sezzle is solely for its benefit and necessitated solely because of its lack of diligence. While ITS did offer a suspension to Sezzle near the close of discovery, the additional time was offered solely so Sezzle could comply with its outstanding discovery obligations, as it had not produced any documents or witnesses for a timely noticed 30(b)(6) deposition. ITS was simply offering Sezzle additional time to do so. Lastly, Sezzle, on multiple occasions denied consent to extend the

discovery period further through suspensions because they were “inclined to move the case along” (Ex. A) and “d[id] not wish to extend the opposition further” (Ex. C). After realizing on the last day of discovery they had not done all they needed to do, they filed the present motion solely for their benefit.

For the foregoing reasons, Sezzle has failed to provide any reason why it could not have timely served its 30(b)(6) notice (or any other untimely discovery it intends on serving in this matter if the 45-day extension is granted). Accordingly, it has failed to establish good cause warranting any extension of the discovery deadline in this case, such that the Board should deny its motion.

DATED: January 12, 2022

/Clinton G. Newton/
Clinton G. Newton (PTO #42930 / MO #46054)
Christine A. Guastello (PTO #58716 / MO #56917)
Reid L. Williams (MO #70458)
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ATTORNEYS FOR OPPOSER ITS, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document and exhibits have been filed through the TTAB's online filing system (ESTTA) and served by forwarding said copy and exhibits on January 12, 2022, via email to the following email address of record:

ipgroup@larkinhoffman.com

with a courtesy copy to the following attorneys:

TODD R. FRONEK
tfronek@larkinhoffman.com

JOHN A. KVINGE
jkvinge@larkinhoffman.com

CHRISTOPHER A. YOUNG
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/Clinton G. Newton/

Clinton G. Newton

ATTORNEY FOR OPPOSER ITS, INC.

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

In the matter of: Trademark Application Serial No. 88/891,706



For the Mark:

Published in the Official Gazette: September 1, 2020

ITS, Inc.,

Opposer,

v.

Opposition No. 91266802
Serial No. 88/891,706

Sezzle Inc.,

Applicant.

**OPPOSER ITS'S INDEX OF EVIDENCE IN SUPPORT OF
ITS RESPONSE TO SEZZLE'S MOTION TO EXTEND**

Opposer, ITS, Inc. ("ITS"), by and through its attorneys of record, hereby submit the following evidentiary materials in support of its Response to Sezzle's Motion to Extend:

1. Exhibit A: True and correct copy of an email exchange between Clinton Newton and Todd Fronek, dated July 8-9, 2021.
2. Exhibit B: True and correct copy of an email from Alice Anderson to Clinton Newton, dated September 17, 2021.
3. Exhibit C: True and correct copy of an email exchange between Clinton Newton and Todd Fronek, dated October 18-20, 2021.
4. Exhibit D: True and correct copy of an email from Clinton Newton to Todd Fronek, dated November 10, 2021.
5. Exhibit E: True and correct copy of an email from Alice Anderson to Clinton Newton, dated November 22, 2021.

6. Exhibit F: True and correct copy of an email from Clinton Newton to Todd Fronck, dated November 29, 2021.
7. Exhibit G: True and correct copy of an email from Clinton Newton to Todd Fronck, dated December 3, 2021.
8. Exhibit H: True and correct copy of an email from John Kvinge to Clinton Newton, dated December 3, 2021.
9. Exhibit I: True and correct copy of an email from Clinton Newton to John Kvinge, dated December 3, 2021.
10. Exhibit J: True and correct copy of an email from Todd Fronck to Clinton Newton, dated December 3, 2021.

DATED: January 12, 2022

/Clinton G. Newton/
Clinton G. Newton (PTO #42930 / MO #46054)
Christine A. Guastello (PTO #58716 / MO #56917)
Reid L. Williams (MO #70458)
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cgntmdocket@shb.com
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ATTORNEYS FOR OPPOSER ITS, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document and exhibits have been filed through the TTAB's online filing system (ESTTA) and served by forwarding said copy and exhibits on January 12, 2022, via email to the following email address of record:

ipgroup@larkinhoffman.com

with a courtesy copy to the following attorneys:

TODD R. FRONEK
tfronek@larkinhoffman.com

JOHN A. KVINGE
jkvinge@larkinhoffman.com

CHRISTOPHER A. YOUNG
cyoung@larkinhoffman.com

/Clinton G. Newton/

Clinton G. Newton

ATTORNEY FOR OPPOSER ITS, INC.

Exhibit A

Newton, Clint (SHB)

From: Newton, Clint (SHB) <CNEWTON@shb.com>
Sent: Friday, July 9, 2021 9:51 AM
To: Fronek, Todd R.
Cc: IPGroup; CGNTMDocket; Kvinge, John A.; Young, Christopher A.
Subject: RE: ITS, Inc. v. Sezzle, Inc.; TTAB Opposition No. 91266802 - SHB File No. 41057.349358

Todd,

Thanks for getting back with me. Not a problem. We'll move forward. I'll send you our Initial Disclosures shortly.

Thanks.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Fronek, Todd R. <tfronek@larkinhoffman.com>
Sent: Friday, July 9, 2021 8:16 AM
To: Newton, Clint (SHB) <CNEWTON@shb.com>
Cc: IPGroup <ipgroup@larkinhoffman.com>; CGNTMDocket <CGNTMDocket@shb.com>; Kvinge, John A. <jkvinge@larkinhoffman.com>; Young, Christopher A. <cyoung@larkinhoffman.com>
Subject: Re: ITS, Inc. v. Sezzle, Inc.; TTAB Opposition No. 91266802 - SHB File No. 41057.349358

EXTERNAL

Hi Clint,

At this point, my client is not willing to consent to a 30-day extension. They would be open to offers for settlement, but are inclined to move the case along.

We will provide our initial disclosures today. Please let me know if you have any questions.

Kind Regards,

Todd

Sent from my Verizon, Samsung Galaxy smartphone
Get [Outlook for Android](#)

From: Newton, Clint (SHB) <CNEWTON@shb.com>
Sent: Thursday, July 8, 2021 4:28:50 PM
To: Fronek, Todd R. <tfronek@larkinhoffman.com>
Cc: IPGroup <ipgroup@larkinhoffman.com>; CGNTMDocket <CGNTMDocket@shb.com>
Subject: RE: ITS, Inc. v. Sezzle, Inc.; TTAB Opposition No. 91266802 - SHB File No. 41057.349358

This Message Is External to Larkin Hoffman.

Todd,

Good to speak with you just now. I look forward to your reply on the 30-day Suspension.

Thanks.

Clint.



Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

Exhibit B

Newton, Clint (SHB)

From: Anderson, Alice M. <aanderson@larkinhoffman.com>
Sent: Friday, September 17, 2021 1:16 PM
To: CNEWTON@shb.com; cgntmdocket@shb.com
Cc: Fronek, Todd R.; Young, Christopher A.; Kvinge, John A.
Subject: ITS v. Sezzle; Applicant's Discovery Requests
Attachments: First Set of Document Requests to ITS 09-17-2021.pdf; First Set of Interrogatories to ITS 09-17-2021.pdf; First Set of Document Requests to ITS 09-17-2021.doc; First Set of Interrogatories to ITS 09-17-2021.doc

EXTERNAL

Dear Counsel:

Enclosed and served upon you please find:

1. Applicant's First Set of Interrogatories; and
2. Applicant's First Request For Production of Documents and Things.

Sincerely,

Alice M. Anderson
Legal Administrative Assistant
to Thomas Oppold,
Craig Lervick, Todd Fronek, and
Christopher Young
direct | 952-896-3393
fax | 952-896-3333

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**Larkin
Hoffman**

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Exhibit C

Newton, Clint (SHB)

From: Newton, Clint (SHB) <CNEWTON@shb.com>
Sent: Wednesday, October 20, 2021 10:21 AM
To: Fronek, Todd R.
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

Todd,

Thanks for your e-mail below. I just left you a voicemail, as I have a clarification question. Please give me a call when you get a minute. You can call my work cell, which is (816) 352-2646.

Thanks.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Fronek, Todd R. <tfronek@larkinhoffman.com>
Sent: Wednesday, October 20, 2021 9:56 AM
To: Newton, Clint (SHB) <CNEWTON@shb.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

EXTERNAL

FOR SETTLEMENT PURPOSES ONLY – SUBJECT TO F.R.E. 408

Hi Clint,

I heard from my client and they are not interested in this settlement offer as they are not inclined to restrict their use. As to the extension, my client does not wish to extend the opposition further without a settlement proposal that does not restrict use of their current mark.

Please let me know if your client wishes to propose an alternative settlement offer.

Kind Regards,
Todd

From: Newton, Clint (SHB) <CNEWTON@shb.com>
Sent: Tuesday, October 19, 2021 3:44 PM
To: Fronek, Todd R. <tfronek@larkinhoffman.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

This Message Is External to Larkin Hoffman.

Todd,

Just following up on my e-mail below.

Thanks and I look forward to your reply.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Newton, Clint (SHB)

Sent: Monday, October 18, 2021 2:59 PM

To: 'Fronek, Todd R.' <tfronek@larkinhoffman.com>

Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

Importance: High

FOR SETTLEMENT PURPOSES ONLY – SUBJECT TO F.R.E. 408

Todd,

Now that you have our settlement proposal below and our discovery responses, I think it makes sense to suspend the matter for settlement discussions, at least for 30 days. Please let me know if you client consents to the same and I'll get it filed.

Thanks.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Newton, Clint (SHB)

Sent: Monday, October 18, 2021 12:08 AM

To: 'Fronek, Todd R.' <tfronek@larkinhoffman.com>

Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

Importance: High

FOR SETTLEMENT PURPOSES ONLY – SUBJECT TO F.R.E. 408

Todd,

Thanks for your patience. I have now received authorization to send you a settlement proposal.

First, however, I believe I should take a minute to frame the dispute from our side. As you are likely aware, my client currently has two pending trademark applications for its S Logo mark below left. Those applications are an effort to update their trademark portfolio to cover all of the goods and services they have added and are currently offering since the last application filing on their S Logo over 35 years ago, in 1985. A number of the goods and services listed in our pending applications are highly related, if not identical, to the goods and services listed in your client's application on their S Logo below right. Without clarification of the goods and services, the similarities between the respective goods and services are highly related, and in some cases even legally identical. This is a factor that would weigh in favor of a likelihood of confusion. Further, without any channels of trade limitations, your client's identical and highly related goods and services are presumed to travel in the same channels of trade and to the same customers as my client's goods and services. This represents two other factors in the likelihood of confusion analysis that both favor a finding of a likelihood of confusion.



vs.



Without amendment, the similarities in the goods and services, the channels of trade, and an overlapping customer base all favor a likelihood of confusion and do not require the two marks to be as similar as they would otherwise have to be for an ultimate determination of likelihood of confusion to be found. While we believe the marks are sufficiently similar to support a likelihood of confusion even without all the other factors so heavily in favor of a likelihood of confusion, their similarities are more than enough to support an overall determination of likelihood of confusion even in the unlikely event the Board were to find the similarity of the marks factor neutral.

Accordingly, we propose three terms that would form the basis of an ultimate settlement that would resolve the present Opposition and permit your client to continue to use their S Logo. The first is an amendment to their Identification of Goods and Services. Attached please find the proposed amendments. As you can see, the amendments focus the broad descriptors in your client's current application to their core business and offering, namely, buy now pay later transactions for online retail merchant services. The parties are not competitors in that space and that is your client's core business. My client has no objection to your client's use or registration of their S Logo in that space and with those goods and services.

The second term would be the manner in which your client uses its mark. Specifically, when used alone, your client's S Logo, with a similar squished S with three parallel and touching line segments, is sufficiently similar to my client's logo as to confuse customers and users as to the source of the good or service. That confusion, however, is lessened when your client's mark is used in connection with their SEZZLE name, in the manner below. Accordingly, we would need your client to agree that they must use their SEZZLE house mark with their S Logo in the manner below when it is consumer facing at checkout.



Lastly, your client would need to agree to limit the use of their S Logo to the revised goods and services.

Please pass this proposal along to your client and discuss with them. If your client is in agreement with the above key points, please let me know and we will prepare a Settlement Agreement incorporating the same for your review. While the above represents the framework of a potential settlement between the parties, it is not a complete offer of all material terms such that acceptance would bind the parties. Instead, the above terms are merely provided as part of good faith settlement discussions and no agreement will be formed until the parties enter into and sign a negotiated written settlement agreement.

Please let me know if you have any questions. Thanks and I look forward to your reply. Our responses to your initial discovery requests will follow separately later today.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

Exhibit D

Newton, Clint (SHB)

From: Newton, Clint (SHB) <CNEWTON@shb.com>
Sent: Wednesday, November 10, 2021 10:00 PM
To: Fronek, Todd R.
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

Todd,

I hope all is well. I am just following up on our call from October 20th. Were you able to speak with your client about a meeting between the parties, so that my client may express their areas of concern and the parties can discuss settlement options? Was that of interest to your client?

Thanks and I look forward to your reply.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Newton, Clint (SHB)
Sent: Wednesday, October 20, 2021 10:21 AM
To: Fronek, Todd R. <tfronek@larkinhoffman.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

Todd,

Thanks for your e-mail below. I just left you a voicemail, as I have a clarification question. Please give me a call when you get a minute. You can call my work cell, which is (816) 352-2646.

Thanks.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Fronek, Todd R. <tfronek@larkinhoffman.com>
Sent: Wednesday, October 20, 2021 9:56 AM
To: Newton, Clint (SHB) <CNEWTON@shb.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

EXTERNAL

FOR SETTLEMENT PURPOSES ONLY – SUBJECT TO F.R.E. 408

Hi Clint,

Exhibit E

Newton, Clint (SHB)

From: Anderson, Alice M. <aanderson@larkinhoffman.com>
Sent: Monday, November 22, 2021 5:39 PM
To: CNEWTON@shb.com; cgntmdocket@shb.com
Cc: Young, Christopher A.; Kvinge, John A.; Fronek, Todd R.
Subject: ITS v. Sezzle; Applicant's Responses to Discovery Requests
Attachments: Sezzle - ITS - Answers to First Set of Interrogatories 11-22-2021.pdf; Sezzle - ITS - Responses to First Set of Requests for Admission 11-22-2021.pdf; Sezzle - ITS - Responses to First Set of Requests for Production of Documents and Things 11-22-2021.pdf

EXTERNAL

Dear Counsel:

Enclosed and served upon you please find:

1. Applicant's Answers to Opposer's First Set of Interrogatories;
2. Applicant's Responses to Opposer's First Request For Production of Documents and Things; and
3. Applicant's Responses to Opposer's Request for Admissions.

As soon as we have received the signature page back from our client, we will forward it to your attention.

Sincerely,

Alice M. Anderson

Paralegal

for Thomas Oppold,
Craig Lervick,
Todd Fronek, and
David McKinley
direct | 952-896-3393
fax | 952-896-3333

8300 Norman Center Drive
Suite 1000
Minneapolis, MN 55437-1060

www.larkinhoffman.com

**Larkin
Hoffman**

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Exhibit F

Newton, Clint (SHB)

From: Newton, Clint (SHB)
Sent: Monday, November 29, 2021 12:28 PM
To: 'Fronek, Todd R.'
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

Todd,

I hope all is well and that you had a good Thanksgiving break.

I am just following up on my e-mail below.

- 1) Have you heard back from your client regarding alternate dates for the **meeting**?
- 2) Have you heard anything back about a **suspension** to give us more flexibility in getting it scheduled?
- 3) Can you please provide me with alternate dates for the **30(b)(6) deposition**?
- 4) When can we expect **documents** to be produced?

Also, today was the day I originally requested answers to the following additional questions:

- 5) Will you have any objections to the 30(b)(6) topics?
- 6) Who are you designating for each 30(b)(6) topic?

Thanks and I look forward to your reply.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Newton, Clint (SHB)
Sent: Tuesday, November 23, 2021 10:53 PM
To: 'Fronek, Todd R.' <tfronek@larkinhoffman.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

Todd,

Thanks for sending word to your client about alternate dates for the meeting between the parties and the possibility of a suspension while we discuss settlement.

As for the 30(b)(6) deposition, please provide me with some proposed alternate dates. Will it be later the same week? As you likely know, the 6th was the last day of discovery, but the parties can take a deposition outside the discovery period by agreement.

Also, I am still going through your discovery responses, but I noticed you produced no documents. When can we expect the responsive documents to be produced? We will need the documents produced at least a week before the rescheduled deposition.

Thanks.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Fronek, Todd R. <tfronek@larkinhoffman.com>
Sent: Tuesday, November 23, 2021 4:40 PM
To: Newton, Clint (SHB) <CNEWTON@shb.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

EXTERNAL

Thanks Clint. I've sent word to my client about alternative dates and the suspension.

I do know there is a conflict on December 6, so we'll have to put that day aside and look for alternatives.

Regards,
Todd

From: Newton, Clint (SHB) <CNEWTON@shb.com>
Sent: Monday, November 22, 2021 10:41 PM
To: Fronek, Todd R. <tfronek@larkinhoffman.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

This Message Is External to Larkin Hoffman.

Todd,

I guess I jinxed us. I just heard from my client that one of the key participants from our side has been called away and has to travel overseas on the 2nd and will now not be able to make the call. They have proposed the following alternate dates and times:

December 9th from 8:00-9:00am;
December 10th from 8:00-9:00am; or
December 13th from 11:00am-12:00pm, all times Central.

Would you please check with your client and see if any of them work?

Also, since we are discussing settlement, it might be beneficial to suspend the matter for 30-days. So, please check with your client on that as well.

If they do not want a suspension, please confirm the 30(b)(6) deposition on December 6th is acceptable.

Thanks and sorry for the change.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Newton, Clint (SHB)
Sent: Friday, November 19, 2021 6:06 PM
To: 'Fronek, Todd R.' <tfronek@larkinhoffman.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

Todd,

Excellent. Too easy. I'll send a meeting invite shortly. Please forward to your people.

Have a good weekend.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Fronek, Todd R. <tfronek@larkinhoffman.com>

Sent: Friday, November 19, 2021 5:59 PM

To: Newton, Clint (SHB) <CNEWTON@shb.com>

Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

EXTERNAL

Hi Clint,

The first choice of December 2 at 1 PM works for my client. Please confirm that still works for you and your client. If so, feel free to send a calendar invite with relevant meeting information. I have a Zoom account that we can utilize if needed.

Have a wonderful weekend.

Kind Regards,
Todd

From: Newton, Clint (SHB) <CNEWTON@shb.com>

Sent: Thursday, November 18, 2021 10:48 PM

To: Fronek, Todd R. <tfronek@larkinhoffman.com>

Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

Importance: High

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Todd,

I have heard back from my client. They would like to have three people from their business side that would lead the discussion and at least one in-house attorney. Still waiting to hear about the GC. So, similar people from your client would be fine. I plan to attend.

As for dates, having Thanksgiving next week doesn't help. How about:

First choice: December 2nd from 1:00-2:00pm Central; or
Second choice: December 9th from 8:00-9:00am Central?

Please check with your people and let me know. Thanks.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Newton, Clint (SHB)
Sent: Wednesday, November 17, 2021 2:25 PM
To: 'Fronek, Todd R.' <tfronek@larkinhoffman.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

Todd,

Thanks for your e-mail below. I just saw this. I will reach out to my client and get some times proposed. I'll also discuss attendees with my contact. I would guess she would want to attend, and perhaps the GC, but will confirm.

Thanks.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Fronek, Todd R. <tfronek@larkinhoffman.com>
Sent: Wednesday, November 17, 2021 1:08 PM
To: Newton, Clint (SHB) <CNEWTON@shb.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

SHOOK
HARDY & BACON

EXTERNAL

Hi Clint,

I heard from my client and they are willing to have a discussion. Would your client be willing to propose some times?

The general counsel would like to be present, but she did not provide further specifics as to attendees. If you would like to propose different options for other attendees, I can relay that information.

Let me know.

Regards,
Todd

From: Newton, Clint (SHB) <CNEWTON@shb.com>
Sent: Thursday, November 11, 2021 4:27 PM
To: Fronek, Todd R. <tfronek@larkinhoffman.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

This Message Is External to Larkin Hoffman.

Todd,

Thanks for the reply and update. I'll stay tuned.

Clint.

From: Fronek, Todd R. <tfronek@larkinhoffman.com>

Sent: Thursday, November 11, 2021 2:38 PM

To: Newton, Clint (SHB) <CNEWTON@shb.com>

Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

EXTERNAL

Hi Clint,

I sent an email to my client with the request, but have not yet heard one way or the other. I have followed up and will let you know if I hear anything further.

Regards,
Todd

From: Newton, Clint (SHB) <CNEWTON@shb.com>

Sent: Wednesday, November 10, 2021 10:00 PM

To: Fronek, Todd R. <tfronek@larkinhoffman.com>

Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

This Message Is External to Larkin Hoffman.

Todd,

I hope all is well. I am just following up on our call from October 20th. Were you able to speak with your client about a meeting between the parties, so that my client may express their areas of concern and the parties can discuss settlement options? Was that of interest to your client?

Thanks and I look forward to your reply.

Clint.

From: Newton, Clint (SHB)

Sent: Wednesday, October 20, 2021 10:21 AM

To: Fronek, Todd R. <tfronek@larkinhoffman.com>

Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

Todd,

Thanks for your e-mail below. I just left you a voicemail, as I have a clarification question. Please give me a call when you get a minute. You can call my work cell, which is (816) 352-2646.

Thanks.

Clint.

Exhibit G

Newton, Clint (SHB)

From: Newton, Clint (SHB)
Sent: Friday, December 3, 2021 3:44 PM
To: 'Fronek, Todd R.'
Cc: Guastello, Chrissie (SHB); Hardy, Dana E. (SHB); Weber, Teddi K. (SHB)
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358
Attachments: Joint Motion for 45-Day Suspension.docx
Importance: High

Todd,

Thanks for your e-mail below and for agreeing to the date for the parties to meet. As requested, I just sent you a meeting invite. Please forward along to the individuals from your client that will be attending.

As for your requested extension of all deadlines, we cannot agree to the same. We offered a suspension of the existing dates to allow the parties to talk settlement and to give you additional time to produce documents and a 30(b)(6) witness (or witnesses). As you are aware, a suspension does not extend any deadlines or periods, but simply pauses all deadlines, leaving the parties in their current positions. What you requested was an extension of the deadlines. This would, in essence, reopen discovery and permit you to prepare and serve additional discovery requests over the next month, something you currently cannot do as the deadline to serve discovery has already passed. Similarly, it would reopen the time for you to notice and serve depositions, another deadline that has passed. The rules require that any depositions be noticed in sufficient time that they could reasonably be taken before the close of discovery. I think you can agree that noticing a depo for the first time on the Friday before discovery closes on Monday, when you have already told us you are not available to take our deposition on Monday, is not a reasonable time. So, for at least those reasons, we cannot agree to your request for a 60-day extension of all deadlines.

We are, however, still willing to suspend the matter a reasonable time to allow the parties to discuss settlement and to give you additional time to comply with our timely served production requests and produce someone for our timely noticed depo. To that end, attached please find a draft JOINT MOTION FOR 45-DAY SUSPENSION OF DEADLINES. Please review and let me know **yet today** if you do or do not consent to the filing of the same.

Thanks and I look forward to your reply.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Fronek, Todd R. <tfronek@larkinhoffman.com>
Sent: Thursday, December 2, 2021 3:44 PM
To: Newton, Clint (SHB) <CNEWTON@shb.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

EXTERNAL

Hi Clint,

My client is available on December 13 from 11am-12pm Central. Please send a calendar invite for this time as done previously and I will forward along.

Given the upcoming meeting and the holidays thereafter, we would propose a 60-day extension of time for all remaining deadlines, including the discovery deadline. This extension would give us an opportunity to meet on the 13th to discuss resolution, and if that is not successful, give both parties an opportunity to complete discovery, including 30(b)(6) depositions, at mutually convenient times.

Our document production is being finalized and we should have it to you in the next handful of business days. Thanks for your patience on the production.

Please do not hesitate to contact me if I can be of any further assistance.

Regards,
Todd

From: Newton, Clint (SHB) <CNEWTON@shb.com>
Sent: Wednesday, December 1, 2021 2:48 PM
To: Fronek, Todd R. <tfronek@larkinhoffman.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358
Importance: High

This Message Is External to Larkin Hoffman.

Todd,

I just left you a voicemail. Can you please provide answers today to the questions below?

Thanks.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Newton, Clint (SHB)
Sent: Monday, November 29, 2021 12:28 PM
To: 'Fronek, Todd R.' <tfronek@larkinhoffman.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

Todd,

I hope all is well and that you had a good Thanksgiving break.

I am just following up on my e-mail below.

- 1) Have you heard back from your client regarding alternate dates for the **meeting**?
- 2) Have you heard anything back about a **suspension** to give us more flexibility in getting it scheduled?
- 3) Can you please provide me with alternate dates for the **30(b)(6) deposition**?
- 4) When can we expect **documents** to be produced?

Also, today was the day I originally requested answers to the following additional questions:

- 5) Will you have any objections to the 30(b)(6) topics?
- 6) Who are you designating for each 30(b)(6) topic?

Exhibit H

Newton, Clint (SHB)

From: Kvinge, John A. <jkvinge@larkinhoffman.com>
Sent: Friday, December 3, 2021 5:15 PM
To: Newton, Clint (SHB)
Cc: Guastello, Chrissie (SHB); Hardy, Dana E. (SHB); Weber, Teddi K. (SHB); CGNTMDocket; Anderson, Alice M.; Voeller, Sarah G.; Fronek, Todd R.; Young, Christopher A.
Subject: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802: Notice of Deposition
Attachments: 30(b)(6) Depo Notice to ITS.pdf

EXTERNAL

Counsel:

Enclosed and served upon you please find Applicant's Notice of Rule 30(b)(6) Deposition of ITS, Inc. We are willing to work with you to find a mutually acceptable date for the deposition.

Sincerely,

John A. Kvinge
Shareholder

direct | 952-896-1554
fax | 952-842-1740

8300 Norman Center Drive
Suite 1000
Minneapolis, MN 55437-1060

www.larkinhoffman.com

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Hoffman**

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Exhibit I

Newton, Clint (SHB)

From: Newton, Clint (SHB)
Sent: Friday, December 3, 2021 5:27 PM
To: 'Kvinge, John A.'
Cc: Guastello, Chrissie (SHB); Hardy, Dana E. (SHB); Weber, Teddi K. (SHB); CGNTMDocket; Anderson, Alice M.; Voeller, Sarah G.; Fronek, Todd R.; Young, Christopher A.
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802: Notice of Deposition

John,

Received. Please note that we intend to object to this deposition notice as untimely.

Thanks and have a good weekend.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Kvinge, John A. <jkvinge@larkinhoffman.com>
Sent: Friday, December 3, 2021 5:15 PM
To: Newton, Clint (SHB) <CNEWTON@shb.com>
Cc: Guastello, Chrissie (SHB) <CGUASTELLO@shb.com>; Hardy, Dana E. (SHB) <DEHARDY@shb.com>; Weber, Teddi K. (SHB) <tweber@shb.com>; CGNTMDocket <CGNTMDocket@shb.com>; Anderson, Alice M. <aanderson@larkinhoffman.com>; Voeller, Sarah G. <svoeller@larkinhoffman.com>; Fronek, Todd R. <tfronek@larkinhoffman.com>; Young, Christopher A. <cyoung@larkinhoffman.com>
Subject: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802: Notice of Deposition

EXTERNAL

Counsel:

Enclosed and served upon you please find Applicant's Notice of Rule 30(b)(6) Deposition of ITS, Inc. We are willing to work with you to find a mutually acceptable date for the deposition.

Sincerely,

John A. Kvinge
Shareholder

direct | 952-896-1554
fax | 952-842-1740

8300 Norman Center Drive
Suite 1000
Minneapolis, MN 55437-1060

www.larkinhoffman.com

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Hoffman**

Exhibit J

Newton, Clint (SHB)

From: Fronek, Todd R. <tfronek@larkinhoffman.com>
Sent: Friday, December 3, 2021 5:30 PM
To: Newton, Clint (SHB)
Cc: Guastello, Chrissie (SHB); Hardy, Dana E. (SHB); Weber, Teddi K. (SHB); Kvinge, John A.; Young, Christopher A.; Voeller, Sarah G.
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

EXTERNAL

Hi Clint,

Thanks for the email and we look forward to discussion on the 13th. We are hopeful progress can be made.

Regarding the Joint Motion, we do not consent to filing and hope you will reconsider your position to extend all deadlines. As you know, we already had to reschedule the discussion scheduled for the 2nd and we have not yet requested an extension during the opposition. It is our preference to not have to get the Board involved in extending the deadlines, but we are certainly prepared to file a motion for an extension—one that the Board would be inclined to grant. If you would rather only extend the deadlines 45 days, we would consent to that extension.

Please let me know if you have any questions.

Regards,
Todd

From: Newton, Clint (SHB) <CNEWTON@shb.com>
Sent: Friday, December 3, 2021 3:44 PM
To: Fronek, Todd R. <tfronek@larkinhoffman.com>
Cc: Guastello, Chrissie (SHB) <CGUASTELLO@shb.com>; Hardy, Dana E. (SHB) <DEHARDY@shb.com>; Weber, Teddi K. (SHB) <tweber@shb.com>
Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358
Importance: High

This Message Is External to Larkin Hoffman.

Todd,

Thanks for your e-mail below and for agreeing to the date for the parties to meet. As requested, I just sent you a meeting invite. Please forward along to the individuals from your client that will be attending.

As for your requested extension of all deadlines, we cannot agree to the same. We offered a suspension of the existing dates to allow the parties to talk settlement and to give you additional time to produce documents and a 30(b)(6) witness (or witnesses). As you are aware, a suspension does not extend any deadlines or periods, but simply pauses all deadlines, leaving the parties in their current positions. What you requested was an extension of the deadlines. This would, in essence, reopen discovery and permit you to prepare and serve additional discovery requests over the next month, something you currently cannot do as the deadline to serve discovery has already passed. Similarly, it would reopen the time for you to notice and serve depositions, another deadline that has passed. The rules require that any depositions be noticed in sufficient time that they could reasonably be taken before the close of discovery. I think you can agree that noticing a depo for the first time on the Friday before discovery closes on Monday, when you have already told

us you are not available to take our deposition on Monday, is not a reasonable time. So, for at least those reasons, we cannot agree to your request for a 60-day extension of all deadlines.

We are, however, still willing to suspend the matter a reasonable time to allow the parties to discuss settlement and to give you additional time to comply with our timely served production requests and produce someone for our timely noticed depo. To that end, attached please find a draft JOINT MOTION FOR 45-DAY SUSPENSION OF DEADLINES. Please review and let me know **yet today** if you do or do not consent to the filing of the same.

Thanks and I look forward to your reply.

Clint.

Clinton (Clint) G. Newton | *Partner – Intellectual Property Section*
Shook, Hardy & Bacon L.L.P. | 2555 Grand Blvd., Kansas City, MO 64108 | 816.559.2155 | cnewton@shb.com

From: Fronek, Todd R. <tfronek@larkinhoffman.com>

Sent: Thursday, December 2, 2021 3:44 PM

To: Newton, Clint (SHB) <CNEWTON@shb.com>

Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

EXTERNAL

Hi Clint,

My client is available on December 13 from 11am-12pm Central. Please send a calendar invite for this time as done previously and I will forward along.

Given the upcoming meeting and the holidays thereafter, we would propose a 60-day extension of time for all remaining deadlines, including the discovery deadline. This extension would give us an opportunity to meet on the 13th to discuss resolution, and if that is not successful, give both parties an opportunity to complete discovery, including 30(b)(6) depositions, at mutually convenient times.

Our document production is being finalized and we should have it to you in the next handful of business days. Thanks for your patience on the production.

Please do not hesitate to contact me if I can be of any further assistance.

Regards,
Todd

From: Newton, Clint (SHB) <CNEWTON@shb.com>

Sent: Wednesday, December 1, 2021 2:48 PM

To: Fronek, Todd R. <tfronek@larkinhoffman.com>

Subject: RE: ITS, Inc. vs. Sezzle Inc - S Logo - Opposition No. 91266802 - Settlement Discussion - SHB File No. 41057.349358

Importance: High

This Message Is External to Larkin Hoffman.

Todd,

I just left you a voicemail. Can you please provide answers today to the questions below?