ESTTA Tracking number: **ESTTA1385322**
Filing date: **09/23/2024**

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

Proceeding no.	91281471
Party	Plaintiff Wonderful Citrus LLC
Correspondence address	DANIELLE M. CRIONA THE WONDERFUL COMPANY LLC 11444 WEST OLYMPIC BLVD., 7TH FLOOR LOS ANGELES, CA 90064 UNITED STATES Primary email: danielle.criona@wonderful.com Secondary email(s): brigid.mahoney@wonderful.com, ipdocket-ing@wonderful.com 310-966-8771
Submission	Other Motions/Submissions
Filer's name	Michael M. Vasseghi
Filer's email	michael.vasseghi@roll.com, ipdocking@roll.com
Signature	/ Michael M. Vasseghi /
Date	09/23/2024
Attachments	Flavorful - Response to OSC.pdf(137590 bytes) Flavorful - Criona Decl in support of Response to OSC.pdf(94744 bytes)

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

WONDERFUL CITRUS LLC, Opposer, v. FLAVORFUL BRANDS, LLC, Applicant.	Opposition No. 91281471 Application Serial No. 97/047,364

OPPOSER'S RESPONSE TO BOARD'S ORDER TO SHOW CAUSE AND MOTION TO RE-OPEN DISCOVERY AND BRIEFING

I. INTRODUCTION

On August 27, 2024, the Board entered an Order to Show Cause why judgment should not be entered against Opposer given that it had not filed a brief in the case. During the latter part of 2023, the parties in this case were engaged in active settlement negotiations. As of August 1, 2023, the parties had essentially agreed to a written settlement proposition, expect for two minor provisions: the sell off date for Applicant's products bearing the applied for mark, and whether Opposer would object to another mark for which Applicant may seek registration for in the future. Opposer's counsel communicated the terms of the agreement last (on August 1, 2023) and was awaiting a response from Applicant's counsel. With the understanding, that these two outstanding issues were minor, and essentially ministerial in nature, and that parties had effectively settled the case, Opposer removed the Board's future deadlines from counsel's calendar. However, Applicant's counsel never responded, and this matter inadvertently fell off Opposer's counsel's radar.

After receiving the Order to Show Cause, Opposer's counsel reached out to Applicant's counsel. The latter stated that they would have to consult with their client. As of the filing of this response, Applicant's counsel has not provided any further response.

Opposer never had any intention of abandoning the proceeding. On the contrary, its intent was to finalize the agreement, and in exchange, dismiss the opposition proceeding. For the reasons below, Opposer requests that no judgment be entered. Further, as explained below, because Opposer's counsel engaged in excusable neglect, it seeks to reopen the time to engage in discovery and submit brief on the merits. Should the Board not grant this motion, and allows Applicant's applied-for mark to register, Opposer will be left with no choice but to initiate a cancellation proceeding against the issued mark prolonging litigation between the parties and using up even further judicial resources of the Board.

II. ARGUMENT

A. Opposer has Not Lost Interest In This Proceeding

"It is the policy of the Board not to enter judgment against a plaintiff for failure to file a main brief where the plaintiff, in its response to the show cause order, indicates that it has not lost interest in the case." *Conopco, Inc. v. Transom Symphony Opco, LLC*, 2022 WL 874335, at *2 (TTAB 2022) citing *Vital Pharms. Inc. v. Kronholm*, 99 USPQ2d 1708, 1710 (TTAB 2011). Here, Opposer has not lost interest in the case. Therefore the Board should discharge its order to show cause order. *See Conoco v. Transom, *2* (Inasmuch as it is clear that Opposer has not lost interest in this case, the show cause order under Trademark Rule 2.128(a)(3) is discharged and judgment will not be entered against Opposer based on a loss of interest in this case.)

B. Motion to Re-Open Discovery and Briefing Schedule

"Opposer must show excusable neglect to reopen the discovery period and its trial period, as requested." *Gaylord Ent. Co. v. Calvin Gilmore Prods. Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000). *See also* Fed. R. Civ. P. 6(b)(1)(B); TBMP §§ 509.01(b)(1) and 536. In analyzing whether a party has shown excusable neglect, within the context of all relevant circumstances, we consider: [1] the danger of prejudice to the [nonmovant], [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 movant, and [4] whether the movant acted in good faith. *Pioneer Inv. Servs. Co. v. Brunswick Assocs. L.P.*, 507 U.S. 380, 395 (1993).

With regard to the danger of prejudice to Applicant, the mere passage of time is generally not considered prejudicial, absent the presence of other facts, such as the loss of potential witnesses…. *See Pumpkin, Ltd. v. Seed Corps*, 43 USPQ.2d at 1582, 1587 (TTAB 1997). Here, all the same witnesses that were previously available will still be available for a new discovery and briefing schedule.

The length of the delay while not insubstantial, would still be shorter than if the Board were to enter judgment against Opposer, and force Opposer to initiate cancellation proceedings against the mark at issue. In that instance, the parties will be engaged in litigation for a longer period of time. Furthermore, the "triggering event" that led to this motion was the August 27th Order to Show Cause. Once that Order issued, Opposer reached out to Applicant to attempt to finalize the almost complete settlement agreement.

The reason for the delay was Opposer's counsel's incorrect assumption that "the deal was done" and the proceeding was effectively over. On August 1, 2023, Opposer's counsel sent the final revisions of the settlement agreement to Applicant's counsel. (Declaration of Danielle Criona, ¶ 2). That version of the settlement agreement only had two minor provisions left for Applicant to weigh in on: the sell off date for Applicant's products bearing the applied for mark, and whether Opposer would object to another mark that Applicant may seek registration for in the future. *Id*. Opposer's counsel communicated last (on August 1, 2023) and was awaiting a response from Applicant's counsel. Criona Decl. ¶ 2. Opposer's counsel understood that these two outstanding issues were minor, and essentially ministerial in nature, and that parties had effectively settled the case. Criona Decl. ¶ 2. With that mindset, Opposer's counsel made the mistake of removing the deadlines for the case from its docketing system. Criona Decl. ¶ 2. That was an error. It should not have done so until the agreement was signed and the proceedings were officially terminated.

Opposer was so certain that it had an agreement place and that Applicant would, in good faith, get back to it with the final details needed to complete the agreement and it would be done, that Opposer did not oppose Applicant's alternative mark, which still used Opposer's trademark ULTIMATE in it, both in the United States and in Canada per the agreement. Criona Decl. ¶ 3.

This mark is THE ULTIMATE ONION DELICIOUS RAW OR COOKED & Design and Opposer could have opposed this mark in August 2023 and in Canada in April 2024, however both times it chose not to in reliance of the parties' agreement. Criona Decl. ¶ 3.

This mistake was based on its understanding that the terms of the agreement were essentially agreed to by both parties. Opposer's counsel relied on Applicant's response to its last email on August 1, 2023 regarding the settlement agreement as the reminder to act. Yet since Applicant for some inexplicable reason, never responded, Opposer's counsel failed to follow up on this matter, and the proceeding fell off its radar. Criona Decl. ¶ 4.

"The purpose of requiring that 'neglect' be 'excusable' is to 'deter ... parties from freely ignoring court-ordered deadlines in hopes of winning a permissive reprieve....'" *Pioneer Inv. Services supra*. at 394. Here Opposer did not ignore any of the Board's orders. It had no incentive to do so, knowing that ignoring deadlines would only hurt their client. Rather it did not comply with these deadlines because it made the mistake of removing those deadlines from its calendaring system. Criona Decl. ¶ 4.

In "determining what sorts of neglect will be considered 'excusable,' we conclude that the determination is at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission." *Id*. at 395. Here, the parties had essentially reached an agreement that both were happy with. If this Board were to deny this motion, it would provide Applicant with no incentive to finalize that agreement and the parties will be left to relitigate this matter once again in the form of a cancellation proceeding. That is not an equitable result for either party and simply provides more work for this Board. Finally, Opposer never acted in bad faith. As soon as it learned of its error it reached out to Applicant to try and complete the settlement agreement.

If the Board is not inclined to re-open both discovery and the briefing schedule, *in the alternative*, Opposer requests that the Board reopen at least the trial periods, allowing both parties to submit evidence in support of their respective positions without the benefit of being able to conduct discovery.

III. CONCLUSION

For the foregoing reasons, Opposer requests that 1) the order to show cause be set aside, and 2) the time for discovery and briefing be re-opened based upon Opposer's counsel's showing of excusable neglect.

DATED: September 23, 2024 Wonderful Citrus LLC

By: /s/ MICHAEL M. VASSEGHI

MICHAEL M. VASSEGHI
ROLL LAW GROUP PC
11444 West Olympic Boulevard
Los Angeles, California 90064-1557
Telephone: (310) 966-8400
Facsimile: (310) 966-8810
michael.vasseghi@roll.com
ipdocketing@roll.com
Attorneys for Opposer

CERTIFICATE OF SERVICE

I, Susan Bryant, hereby certify that a copy of this OPPOSER'S RESPONSE TO BOARD'S ORDER TO SHOW CAUSE AND MOTION TO RE-OPEN DISCOVERY AND BRIEFING has been served upon attorney for Applicant:

MARGARET NIVER MCGANN
PARSONS BEHLE & LATIMER
201 SOUTH MAIN STREET, SUITE 1800
SALT LAKE CITY, UT 84111
trademarks@parsonsbehle.com
Phone: 801-532-1234

by email on this 23rd day of September, 2024.

/s/ SUSAN BRYANT

SUSAN BRYANT
ROLL LAW GROUP PC
11444 West Olympic Boulevard
Los Angeles, California 90064-1557
Telephone: (310) 966-8400
Facsimile: (310) 966-8810

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

WONDERFUL CITRUS LLC,, Opposer, v. FLAVORFUL BRANDS, LLC, Applicant.	Opposition No. 91281471 Application Serial No. 97/047,364

DECLARATION OF DANIELLE M. CRIONA IN SUPPORT OF OPPOSER'S RESPONSE TO AUGUST 27TH ORDER TO SHOW CAUSE AND MOTON TO RE-OPEN DISCOVERY AND BRIEFING

I, Danielle Criona, declare as follows:

1. I am Assistant General Counsel – IP and in-house counsel for Opposer. I have personal knowledge of the facts set forth herein and, if called upon to testify, could and would competently testify thereto. I submit this declaration in support of the Board's Order to Show Cause and Motion to Re-open Discovery and Briefing.

2. Throughout most of 2022 and 2023, , the parties were engaged in settlement discussions. This matter was more complicated than most as it involved actual use in the marketplace, not just a trademark application. On August 1, 2023, I sent the final revisions of the settlement agreement to Applicant's counsel. That version of the settlement agreement only had two minor provisions left for Applicant to weigh in on: the sell off date for Applicant's products bearing the applied for mark, and whether Opposer would object to another mark that Applicant may seek registration for in the future. My understanding was that these two outstanding issues were minor, and essentially ministerial in nature, and that parties had effectively settled the case. With that mindset, I made the mistake of removing the deadlines for the case from its docketing system.

3. I was so certain that we had an agreement in place and that Applicant would, in good faith, get back to me with the final details needed to complete the agreement and it would be done, that our client, the Opposer, did not oppose Applicant's alternative mark, which still used Opposer's trademark ULTIMATE in it, both in the United States and in Canada per the agreement. This mark is THE ULTIMATE ONION DELICIOUS RAW OR COOKED & Design and Opposer could have opposed this mark in August 2023 in the USA and in Canada in April 2024, however both times it chose not to in reliance of the parties' agreement.

4. I relied on Applicant's response to my August 1, 2023 email regarding the settlement agreement as the reminder to act. Yet since Applicant for some inexplicable reason, never responded, I failed to follow up on this matter, and the proceeding fell off my radar and I erroneously removed the deadlines for the proceedings from our calendaring system.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct and that this declaration was executed in Los Angeles, California on September 23, 2024.

/s/ Danielle M. Criona
Danielle M. Criona

CERTIFICATE OF SERVICE

I, Susan Bryant, hereby certify that a copy of this DECLARATION OF DANIELLE M. CRIONA IN SUPPORT OF OPPOSER'S RESPONSE TO AUGUST 27TH ORDER TO SHOW CAUSE AND MOTON TO RE-OPEN DISCOVERY AND BRIEFING has been served upon attorney for Applicant:

MARGARET NIVER MCGANN
PARSONS BEHLE & LATIMER
201 SOUTH MAIN STREET, SUITE 1800
SALT LAKE CITY, UT 84111
trademarks@parsonsbehle.com
Phone: 801-532-1234

by email on this 23, day of September, 2024.

/s/ SUSAN BRYANT

SUSAN BRYANT
ROLL LAW GROUP PC
11444 West Olympic Boulevard
Los Angeles, California 90064-1557
Telephone: (310) 966-8400
Facsimile: (310) 966-8810