

ESTTA Tracking number: **ESTTA607115**

Filing date: **05/29/2014**

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

Proceeding	92056635
Party	Plaintiff Richemont International S.A.
Correspondence Address	PAUL J REILLY BAKER BOTTS LLP 30 ROCKEFELLER PLAZA NEW YORK, NY 10112-0228 UNITED STATES nytmdpt@bakerbotts.com, paul.reilly@bakerbotts.com
Submission	Opposition/Response to Motion
Filer's Name	Paul J. Reilly
Filer's e-mail	nytmdpt@bakerbotts.com, paul.reilly@bakerbotts.com, julie.albert@bakerbotts.com
Signature	/Paul J. Reilly/
Date	05/29/2014
Attachments	5.29.14 Opposition.pdf(233762 bytes)

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

In the Matter of Registration No. 3,514,885
Registrant: Fin.Ing. S.r.L.
Mark: **REPORTER**
App. Serial No.: 77/235,011
Reg. Date: October 14, 2008

RICHEMONT INTERNATIONAL S.A.,	X		
	:		
	:		
Petitioner,	:		
	:		
v.	:	Cancellation No. 92056635	
	:		
FIN.ING. S.R.L.,	:		
	:		
Respondent.	:		
	:		
	:		
	X		

**RICHEMONT INTERNATIONAL S.A.’s OPPOSITION TO RESPONDENT’S
MOTION FOR AN EXTENSION OF TIME TO RESPOND TO DOCUMENT REQUESTS AND
INTERROGATORIES AND TO EXTEND SCHEDULE**

Petitioner, Richemont International S.A. (“Richemont”) opposes “Respondent’s Motion for an Extension of Time To Respond to Document Requests and Interrogatories and To Extend Schedule” (“Motion to Extend”) filed by Respondent, Fin.Ing. S.r.l. (“Respondent”) Richemont respectfully submits that Respondent has failed to establish the requisite good cause that would warrant additional time to respond to Richemont’s first set of document requests and first set of interrogatories served on April 7, 2014 and respectfully requests that the Respondent’s Motion to Extend be denied in its entirety.

STATEMENT OF FACTS

1. On January 4, 2013, Richemont filed a Petition for Cancellation of Respondent’s purported registration for REPORTER on the basis of Respondent’s abandonment, non-use and intent not to resume use of the mark in United States commerce. (See. Bd. Docket No. 1).

2. Rather than respond to the Petition for Cancellation, Respondent sought an extension of its time to respond. (See Bd. Docket No. 5). Following Richemont's response to that motion in which it agreed to extend Respondent's term to file an answer, the Board granted Respondent's motion. (See Bd. Docket Nos. 6 and 7).

3. Following some initial motion practice, Respondent answered Richemont's Second Amended Petition for Cancellation on July 31, 2013 and proceedings resumed on September 3, 2013. (see Bd. Docket Nos. 8-15)

4. Thereafter, proceedings were suspended up through February 2, 2014 so that the parties could pursue settlement discussions. (See Bd. Docket Nos. 17-22) However, efforts made to settle the dispute were unsuccessful. Proceedings resumed on February 2, 2014 in accordance with the Board's Order dated January 3, 2014. (See Bd. Docket No. 22).

5. Petitioner served its first set of document requests and first set of interrogatories on April 7, 2014 and responses were due on May 12, 2014.

6. As noted in Respondent's motion, Richemont served only 28 document requests and 19 interrogatories which are not unduly burdensome.

7. Respondent did approach Richemont's lawyers to request an extension of time to respond to Petitioner's outstanding discovery. However, there are trademark disputes between the parties that are pending around the world. Previously, Richemont's requested consent from Respondent in connection with one such matter and Fin.Ing. denied the request. Richemont advised Respondent's U.S. lawyers of this but nonetheless offered them another week to provide responses to Richemont's document requests and interrogatories. (See Exhibit A attached hereto

which is a true and correct copy of an email exchange between Paul J. Reilly, counsel to Richemont, and Brad Corsello, counsel to Respondent relating to its request for an extension.)

8. Respondent did not make any other proposal to try and resolve the discovery dispute, but rather filed the instant Motion to Extend.

9. Discovery is currently set to close on July 1, 2014.

ARGUMENT

Pursuant to *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP") §509 and Fed. R. Civ. P. 6(b), a party may file a motion for an enlargement of time prior to the expiration of a given period provided the moving party shows good cause for the requested extension. The party moving for an extension bears the burden of proof, and must "state with particularity the grounds therefor, including detailed facts constituting good cause." Luemme, Inc. v. D.B. Plus Inc., 53 U.S.P.Q.2d 1758, 1760 (TTAB 1999) (denying motion to extend discovery period premised on petitioner's extensive travel which made it difficult to participate in discovery) (citations omitted). Respondent has not properly met its burden in order to obtain an extension of time.

In Chesebrough-Pond's Inc. v. Faberge, Inc., 618 F.2d 776, 205 U.S.P.Q. 888 (CCPA 1980), Chesebrough-Pond's requested additional time to file an opposition to Faberge's motion for summary judgment because it had just brought suit against Faberge in the Central District of California on issues said to be dispositive of the opposition. Filed concurrently with that request for additional time was a motion to suspend the Board proceedings pending the outcome of the civil action. The Court of Customs and Patent Appeals, the predecessor to the Court of Appeals for the Federal Circuit, denied Chesebrough's request for additional time and

stated: “[w]e see no good reason why the brief was not submitted on time. The record is devoid of any excuse by way of extenuating circumstances proffered by counsel for Chesebrough; there appear to be none.” Id. at 780.

The basis for Respondent’s requested extension is less compelling than that of Chesebrough above, and certainly lacks a recitation of particular facts supporting a need for additional time. Here, Fin.Ing. is being represented by not only counsel in the United States but counsel in Italy which has had Richemont’s document requests and interrogatories since, on information and belief, approximately April 7, 2014. Fin.Ing’s U.S. lawyers specialize in intellectual property matters and have apparently been representing Fin.Ing. or its predecessors for several years now. However, Respondent does not detail why it requires more time to respond to Richemont’s document requests or interrogatories or what efforts have been made to gather responsive documents or information, much less why it requires an additional 30 days or why another week was insufficient.

Insofar as settlement is concerned, there have at this point been no meaningful discussions between the parties. Even to the extent Respondent has made a settlement proposal, that does not obviate its obligation to provide responses to Richemont’s outstanding discovery requests. See Nat’l Football League v. DNH Mgmt. LLC, 85 U.S.P.Q.2d 1852, 1854-55 (TTAB 2008) (finding that an unsupported claim that parties were engaged in settlement discussions did not provide good cause for extension of the discovery period).

Without question, the content of Respondent’s Motion to Extend lacks detailed evidence or factual information necessary to establish good cause warranting the additional time sought.

Further, in view of Respondent's delay in responding to the outstanding discovery without just cause, Richemont should be entitled to a unilateral extension of the discovery period so that it may pursue follow up discovery, take depositions and prepare for trial. See TBMP § 403.04; Miss America Pageant v. Petite Prods, Inc., 17 U.S.P.Q.2d 1067, 1070 (TTAB 1990) ("[T]he Board will, upon motion, reopen or extend discovery solely for the benefit of a party whose opponent, by wrongfully refusing to answer, or delaying its responses to, discovery, has unfairly deprived the propounding party of the right to take follow-up discovery"). Further, Richemont requests that the new term for it to take discovery be set to run from the date of the Board's decision on this pending motion. See TBMP § 509.02.

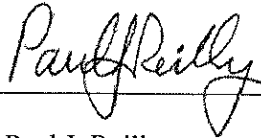
CONCLUSION

In view of the foregoing, Richemont respectfully requests that the Board (i) deny Respondent's Motion to Extend in its entirety and order Respondent to promptly respond to Richemont's outstanding document requests and interrogatories, (ii) unilaterally extend discovery for 30 days in favor of Richemont only following the Board's decision on this motion, and (iii) extend all remaining dates, including trial dates, accordingly.

Respectfully submitted,

BAKER BOTTS LLP

Dated: May 29, 2014

By: 

Paul J. Reilly
Lauren B. Emerson
30 Rockefeller Plaza
New York, NY 10112-0228
(212) 408-2634

Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on this 29th day of May, 2014 a copy of the foregoing,
RESPONDENT'S MOTION FOR AN EXTENSION OF TIME TO RESPOND TO
DOCUMENT REQUESTS AND INTERROGATORIES AND TO EXTEND SCHEDULE, was
served on Respondent's United States counsel of record via first class mail, to the following address:

Angelo Notaro, Esq.
John Zaccaria, Esq.
Notaro Michalos & Zaccaria P.C.
100 Dutch Hill Road, Ste. 240
Orangeburg, New York 10962

Dated: May 29, 2014

By: _____


Julie Beth Albert

Exhibit A

Albert, Julie Beth

From: Reilly, Paul J.
Sent: Thursday, May 08, 2014 1:15 PM
To: 'bcorsello@notaromichalos.com'
Cc: 'jzaccaria@notaromichalos.com'; 'nmpc@notaromichalos.com'; Emerson, Lauren;
Albert, Julie Beth
Subject: Re: J154-047 - Richemont v. Fin. Ing.

Dear Brad:

Given Fin.Ing.'s prior refusal to grant Richemont consent to suspend action or cooperate with Richemont in certain matters outside the United States, Richemont will not grant the extension requested by Fin.Ing. in this instance.

However, as a professional courtesy from one lawyer to another, I will consent to a one week (7 days) extension from the due date for Fin.Ing. to serve its written responses and production of documents and things.

I must point out that absent service of full and complete responses, including production of documents, to our discovery requests, Richemont will move to compel.

Regards,

Paul

Paul J. Reilly
Baker Botts LLP
214.953.6849

From: Reilly, Paul J.
Sent: Wednesday, May 07, 2014 08:57 AM Central Standard Time
To: 'Brad Corsello' <bcorsello@notaromichalos.com>
Cc: John Zaccaria <jzaccaria@notaromichalos.com>; Notaro, Michalos & Zaccaria P.C. <nmpc@notaromichalos.com>;
Notaro, Michalos & Zaccaria P.C. <nmpc@notaromichalos.com>
Subject: RE: J154-047 - Richemont v. Fin. Ing.

Dear Brad:

I have your email and will follow up with you as soon as possible.

Regards,

P. Reilly

Paul J. Reilly
Baker Botts L.L.P.
2001 Ross Avenue
Dallas, Texas 75201
Tel: 214.953.6849

Exhibit A

From: Brad Corsello [<mailto:bcorsello@notaromichalos.com>]
Sent: Wednesday, May 07, 2014 8:44 AM
To: Reilly, Paul J.
Cc: John Zaccaria; Notaro, Michalos & Zaccaria P.C.; Notaro, Michalos & Zaccaria P.C.
Subject: RE: J154-047 - Rlichemont v. Fin. Ing.

Paul,

Just a follow-up email to ask again for the courtesy of a 30 day extension of time.

Brad Corsello
E: bcorsello@notaromichalos.com

Notaro, Michalos & Zaccaria PC
1270 Broadway, Suite 807, New York, NY 10001 | T:(212) 278-8600 | F:(212) 278-8687
100 Dutch Hill Road, Orangeburg, NY 10962 | T:(845) 359-7700 | F:(845) 359-7798
www.notaromichalos.com

CONFIDENTIALITY NOTICE: This email and its attachments are covered by the Electronic Communications Privacy Act, 18 U.S.C. §§ 2510-2521, and may contain confidential information, be an attorney-client communication and/or contain attorney work product that is privileged and confidential. If you are not an intended recipient, any use, review, dissemination, distribution or copying of information in this email or any attachment is strictly prohibited. If you have received this e-mail in error, please notify us immediately by return e-mail and delete all copies of this e-mail and any attachments from your system.

From: Brad Corsello
Sent: Tuesday, May 06, 2014 9:52 AM
To: 'Paul.Reilly@bakerbotts.com'
Cc: 'ljzaccaria@notaromichalos.com'; Notaro, Michalos & Zaccaria P.C.
Subject: RE: J154-047 - Rlichemont v. Fin. Ing.

Paul,

I am writing on behalf of Fin. Ing. to ask for the courtesy of a 30 day extension of time to respond to Rlichemont's discovery requests now due May 12. The client needs more time to collect information in response to the requests. We would file a motion on consent to extend the discovery and trial dates each by 30 days.

With respect to the new cancellation filed by Rlichemont, we have not yet been instructed by Fin. Ing.

Brad Corsello
E: bcorsello@notaromichalos.com

Notaro, Michalos & Zaccaria PC
1270 Broadway, Suite 807, New York, NY 10001 | T:(212) 278-8600 | F:(212) 278-8687
100 Dutch Hill Road, Orangeburg, NY 10962 | T:(845) 359-7700 | F:(845) 359-7798
www.notaromichalos.com

CONFIDENTIALITY NOTICE: This email and its attachments are covered by the Electronic Communications Privacy Act, 18 U.S.C. §§ 2510-2521, and may contain confidential information, be an attorney-client communication and/or contain attorney work product that is privileged and confidential. If you are not an intended recipient, any use, review, dissemination, distribution or copying of information in this email or any attachment is strictly prohibited. If you have received this e-mail in error, please notify us immediately by return e-mail and delete all copies of this e-mail and any attachments from your system.