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Filing date: **10/18/2014**

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

Proceeding	92057058
Party	Defendant Island Food & Fun, Inc.
Correspondence Address	ELIZABETH T RUSSELL LAW OFFICE 6907 UNIVERSITY AVE # 227 MIDDLETON, WI 53562-2767 UNITED STATES beth@erklaw.com
Submission	Motion to Reopen
Filer's Name	Elizabeth T Russell
Filer's e-mail	beth@erklaw.com, brussell@supranet.net
Signature	/elizabeth russell/
Date	10/18/2014
Attachments	10182014 motion no confid exhibits.pdf(788655 bytes )

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

Fifty-Six Hope Road Music Limited,  Petitioner,  v.  Island Food & Fun, Inc.,  Registrant.	Cancellation No.: 92057058  Registration No.: 3225517
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Commissioner for Trademarks  
ATTN: Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**REGISTRANT’S MOTION TO REOPEN**

Pursuant to Fed. R. Civ. P. 6(b)(1)(B), Rule 2.116(a) of the Trademark Rules of Practice, and section 509.01(b) of the Trademark Trial and Appeal Board Manual of Procedure (TBMP), Registrant respectfully moves to reopen and reset its response and objection deadlines for Petitioner’s First Set of Requests For Admission; Petitioner’s First Set of Requests for Production; and Petitioner’s First Set of Interrogatories (the “Discovery Requests”).

This Motion is supported by: the declaration of Elizabeth T Russell; supporting Exhibits; and Registrant’s Memorandum in Support of this Motion to Reopen. Based upon these materials and applicable law, Registrant respectfully submits that an equitable balancing of the factors for

excusable neglect should resolve in Registrant's favor, and that the instant motion should be granted.

Specifically:

1. Resetting Registrant's objection and response deadlines poses no danger of prejudice to Petitioner. This is especially so, in light of Petitioner's nearly eight year delay in commencing the instant cancellation proceeding.
2. Registrant is making this motion immediately upon expiration of the October 17, 2014 deadline Petitioner established.
3. The reasons for delay are Registrant's reliance on Petitioner's actions, inactions and the parties' course of dealing.
4. Registrant has at all times acted in good faith.
5. Permitting Registrant to register objections to the Discovery Requests serves the interest of efficiency, now that the Board's decision on Registrant's motion for summary judgment has narrowed the proceeding's remaining issues of fact.

Accordingly, Registrant respectfully requests that the Board grant Registrant's Motion to Reopen, and reset Registrant's deadlines for responding and objecting to the Discovery Requests, to at least thirty (30) days following the Board's decision on this motion.

Respectfully submitted,

/elizabeth t russell/

Attorney for Island Food & Fun, Inc.

Dated: October 18, 2014

The above is my electronic signature, personally entered by me in accordance with the requirements of 37 C.F.R. §2.193(c)

Elizabeth T Russell  
6907 University Ave., #227  
Middleton, WI 53562  
Telephone: 608-826-5007

## **CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing REGISTRANT'S MOTION TO REOPEN was served on Petitioner by mailing a copy by First Class Mail, postage prepaid, to Petitioner's counsel at the following address on this 18th day of October, 2014:

Jill M. Pietrini and Paul Bost  
SHEPPARD MULLEN RICHTER & HAMPTON LLP  
1901 Avenue of the Stars, Suite 1600  
Los Angeles, CA 90067-6017

/elizabeth t russell/

The above is my electronic signature, personally entered by me in accordance with the requirements of 37 C.F.R. §2.193(c)

Elizabeth T Russell  
6907 University Ave., #227  
Middleton, WI 53562  
Telephone: 608-826-5007

Attorney Docket No.: 90656-001

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

Fifty-Six Hope Road Music Limited,  Petitioner,  v.  Island Food & Fun, Inc.,  Registrant.	Cancellation No.: 92057058  Registration No.: 3225517
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Commissioner for Trademarks  
ATTN: Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**MEMORANDUM IN SUPPORT OF REGISTRANT'S MOTION  
TO REOPEN**

INTRODUCTION AND BACKGROUND

Petitioner commenced this proceeding on April 8, 2013 seeking cancellation of Registrant's incontestable trademark Registration No. 3225517 on three grounds: fraud, non-ownership and false suggestion of a connection with Bob Marley. Registrant moved for summary judgment on May 2, 2014, as a result of which the fraud and non-ownership claims have been dismissed. Although the Discovery Requests were outstanding prior to Registrant's motion for summary judgment, neither party specifically asked the Board to address, reopen or reset applicable objection and response deadlines, in the context of that motion. Registrant has attempted, without

success, to secure Petitioner's agreement to a reasonable deadline. As a direct consequence of Petitioner's refusals, Registrant submits the instant motion.

Registrant provides the following chronology for the Board's consideration:

- Having received no discovery-related communication, Registrant's counsel (Elizabeth Russell) took the initiative, writing on July 19, 2013 to remind Petitioner's counsel of the upcoming deadline for the parties' mandatory discovery conference, and to propose a date for the conference (Exhibit A). Russell received no response, and the deadline passed.
- On August 6, 2013 Russell wrote again, advising that she had still received no response and that she remained available for the conference (Exhibit B). In that letter, Russell also advised, specifically, that Registrant believed it was entitled to judgment on the pleadings on at least the first two of Petitioner's claims for cancellation (fraud and non-ownership); Russell expressly asked Petitioner to withdraw those claims voluntarily.
- The discovery conference finally took place on August 13, 2013 (Exhibit C). During that conference, Petitioner's counsel freely admitted she had not read Russell's letter of August 6, 2013 and was therefore unprepared to discuss Russell's request for voluntary withdrawal of the fraud and ownership claims. (Exhibit C). Russell requested a substantive reply and advised – for the second time – that barring voluntary withdrawal Registrant would seek pre-trial judgment on those claims.
- In December 2013 Petitioner sought Registrant's consent to an extension of time for discovery due to Petitioner's counsel's personal issues; Registrant consented and the extension was granted (Exhibit D; ESTTA578174, of record).

- By letter dated January 28, 2014 Russell wrote again, advising – yet again – that Registrant intended to seek summary judgment, and inviting Petitioner to participate in settlement negotiations (Exhibit E). Petitioner’s counsel responded by email on February 12, 2014, requesting a “concrete settlement offer” (Exhibit F).
- On February 14, 2014, by depositing with the United States Postal Service, Petitioner served Registrant with the following:
  - Petitioner’s First Set of Requests For Admission
  - Petitioner’s First Set of Requests for Production
  - Petitioner’s First Set of Interrogatories
- The foregoing are the “Discovery Requests” at issue in this motion.
- By letter dated February 19, 2014 Russell delivered a concrete settlement offer and further stated, “I am in receipt of the discovery materials you served yesterday. However, I respectfully request your consent to a motion for suspension for purposes of settlement negotiation” (Confidential Exhibit G).
- Hearing nothing, Russell followed up by email on February 24, 2014 (Exhibit H).
- Still hearing nothing, Russell again followed up by email on March 11, 2014 (Confidential Exhibit I).
- Finally, on March 27, 2014 Petitioner’s counsel responded on the settlement proposal, via email, but said nothing about Russell’s request for consent to a motion for suspension (Confidential Exhibit I).
- Registrant’s response deadline for the Discovery Requests (March 21, 2014) had already passed at the time of the March 27, 2014 email, but Petitioner’s counsel ignored it and said nothing.

- Registrant’s counsel responded to Petitioner’s counsel on April 8, 2014, further discussing settlement points (Confidential Exhibit J).
- Petitioner’s counsel received and read the April 8, 2014 email, on April 8, 2014 (Exhibit K).
- There was still no mention of the Discovery Requests.
- By letter dated April 15, 2014, with no prior inquiries or notice, Petitioner’s counsel accused Registrant of “wholesale failure” to respond to the Discovery Requests (Exhibit L).
- Registrant’s counsel responded immediately, by letter dated April 16, 2014 (Exhibit M). Therein, Registrant’s counsel set forth the chronology of communication (as outlined above); proposed a conference to meet and confer; again sought consent to suspension in contemplation of settlement; and further requested a reasonable extension of time for the Discovery Requests.
- Petitioner’s counsel received and read the email to which the April 16, 2014 letter was attached, on April 16, 2014 (Exhibit N).
- By letter dated April 28, 2014 Petitioner’s counsel refused the requests of Registrant’s counsel for any mutual extensions of time, and imposed a deadline of May 6, 2014 (Exhibit P).
- Petitioner’s baseless refusals to cooperate precluded the pursuit of efficient resolution, thus Registrant moved for summary judgment on May 2, 2014.
- The Board issued its decision on Registrant’s motion for summary judgment on September 17, 2014. The decision narrowed the questions of fact in this matter to Petitioner’s one remaining claim (false suggestion of a connection) and Registrant’s defense of laches.

- On October 6, 2014 Petitioner’s counsel and Registrant’s counsel exchanged emails (Exhibit Q) regarding a deadline for the Discovery Requests. Registrant’s counsel requested a deadline of November 17, 2014; Petitioner’s counsel refused (Exhibits R, S and T).

### THE LAW RELATING TO THIS MOTION

In *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997) the Board adopted “excusable neglect” as the standard for a motion to reopen time (see, *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership et al.*, 507 US 380 [1993]).

Excusable neglect is established by an equitable balancing of four factors: the danger of prejudice to the non-movant; the length of the delay and its potential impact on judicial proceedings; the reason for the delay, including whether it was within the reasonable control of the movant; and whether the movant acted in good faith. *Pumpkin Ltd.*, supra.

### ARGUMENT

#### **First factor: Granting the instant motion presents no danger of prejudice to Petitioner**

As set forth in the above chronology, the parties resumed discussion about discovery following the Board’s decision on Registrant’s motion for summary judgment. Petitioner’s counsel has refused all requests for mutual agreement on a response date reasonable to the circumstances, citing no reason or potential for prejudice other than Registrant’s general unwillingness. This stance has

caused unnecessary inefficiency and expense, requiring Registrant's counsel, a sole practitioner, to devote time and resources to the instant motion rather than to the task at hand: the Discovery Requests.

The pertinent points on prejudice are these:

- Petitioner had no objection to its own arbitrarily-imposed deadline of October 17, 2014. By definition, therefore, Petitioner would have suffered no prejudice had October 17, 2014 been the deadline. Petitioner has proffered no reason – and indeed, it is submitted that none exists – why prejudice would attach if the response deadline is set at a reasonable period of time thereafter.
- The delay that will necessarily attach by reason of this motion and its attendant processing time, is solely attributable to Petitioner's own refusals to cooperate.

**Second factor: Registrant is filing this motion  
immediately upon expiration of the deadline Petitioner imposed**

The second factor addresses length of the delay (between deadline and filing of motion) and its effect on the underlying proceeding. *Pumpkin Ltd.*, supra.

There are two deadline dates pertinent to the instant dispute: a) the original response date of March 21, 2014; and b) Petitioner's arbitrarily imposed deadline of October 17, 2014. With respect to the original deadline, Registrant respectfully defers to its discussion herein on the first, third and fourth

factors. As for the October 17, 2014 deadline that Petitioner arbitrarily imposed and refused to modify, Registrant is making this motion immediately upon its expiration.

There will be no adverse effect on the underlying proceeding if the instant motion is granted, and deadlines reset.

It bears observing, moreover, that Petitioner delayed seven years, two months and eight days between publication of the application giving rise to the disputed registration (January 31, 2006) and commencement of this cancellation proceeding (April 8, 2013). Delay of that magnitude belies any suggestion that Petitioner could possibly be prejudiced by the relief Registrant seeks in this motion; and it tips the requisite balancing of the equities strongly in Registrant's favor.

### **Third factor: Reason for the delay**

Registrant's failure to respond by the original deadline was based on a mistaken assumption that Petitioner would agree to suspension of the proceeding in contemplation of settlement. Registrant's counsel made this assumption based on the parties' previous course of dealing:

- Petitioner's initial attention to discovery was nonexistent, requiring Registrant to take the initiative. Even then, Registrant's counsel received no response for significant periods of time and had to follow up (Exhibits A, B and C).
- Petitioner's counsel requested an extension of time for personal reasons, to which Registrant's counsel freely agreed (Exhibit D; ESTTA578174, of record). This led Registrant to believe that the parties were proceeding with mutual respect and cooperation.

- Petitioner remained silent on Registrant's repeated requests for consent to a suspension, well after the original deadline had passed. Registrant assumed, mistakenly and based on the parties' prior course of dealing, that the parties were continuing to negotiate in good faith and that consent to suspension would be forthcoming.
- Registrant had repeatedly advised Petitioner of its intention to seek summary judgment, and the bases it claimed for such relief (Exhibits B, C and E). Engaging in burdensome discovery prior to disposition of those claims would have been extremely inefficient; Registrant also assumed, mistakenly, that Petitioner appreciated this consideration.

**Fourth factor: Registrant has conducted itself at all times in good faith**

As evidenced by the Exhibits attached hereto, and the diligence with which Registrant answered the complaint, initiated communication with Petitioner, and prepared and prosecuted its motion for summary judgment, there can be no doubt that Registrant has prosecuted this matter vigorously and in good faith.

Petitioner, on the other hand, has engaged in gamesmanship and has refused to accommodate reasonable requests for no reason other than the pursuit of such gamesmanship. Petitioner has remained silent on express requests; has led Registrant to believe that cooperation was forthcoming; and has then attempted to gain advantage by reason of Registrant's misplaced reliance.

## CONCLUSION

In view of the foregoing, Registrant submits that the equities balance in Registrant's favor. In balancing the factors, Registrant particularly asks the Board to consider:

- Petitioner's nearly eight year delay in commencing the cancellation proceeding.
- Petitioner's repeated failures to respond to Registrant's good faith communications.
- Petitioner's silence following expiration of the original deadline, followed by attack rather than inquiry.
- The absolute lack of any prejudice to Petitioner or the underlying proceeding, in granting this motion.
- The efficiency that will be achieved in permitting Registrant to object, in light of the Board's decision on Registrant's motion for summary judgment.
- Registrant's good faith and diligence in prosecuting this proceeding.

Accordingly and with respect, Registrant submits that the instant motion should be granted.

## **CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing MEMORANDUM IN SUPPORT OF REGISTRANT'S MOTION TO REOPEN was served on Petitioner by mailing a copy by First Class Mail, postage prepaid, to Petitioner's counsel at the following address on this 18th day of October, 2014:

Jill M. Pietrini and Paul Bost  
SHEPPARD MULLEN RICHTER & HAMPTON LLP  
1901 Avenue of the Stars, Suite 1600  
Los Angeles, CA 90067-6017

/elizabeth t russell/

The above is my electronic signature, personally entered by me in accordance with the requirements of 37 C.F.R. §2.193(c)

Elizabeth T Russell  
6907 University Ave., #227  
Middleton, WI 53562  
Telephone: 608-826-5007

Attorney Docket No.: 90656-001

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

Fifty-Six Hope Road Music Limited,  Petitioner,  v.  Island Food & Fun, Inc.,  Registrant.	Cancellation No.: 92057058  Registration No.: 3225517
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Commissioner for Trademarks  
ATTN: Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**DECLARATION OF ELIZABETH T RUSSELL**

I, Elizabeth T Russell, declare and state as follows:

1. I have represented Mormax, Inc., Island Food and Fun, Inc., and their owners (Jeff and Marci Morris) in trademark matters since October, 2010.

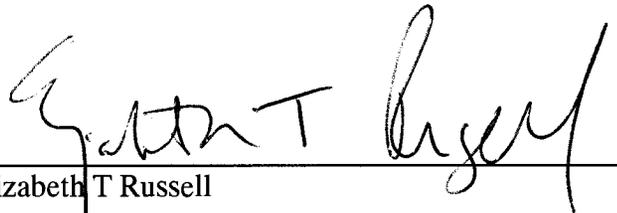
2. For convenience, I shall refer to Mormax, Inc., Island Food and Fun, Inc., and their owners, Jeff and Marci Morris, collectively, as the “Morris Entities” unless otherwise noted or required by the context.
3. By virtue of such representation, and based upon my review of the files in this matter, I have personal knowledge of the matters set forth herein.
4. The parties to this cancellation proceeding have made initial disclosures.
5. The parties to this cancellation proceeding have not agreed to any modifications of the Board’s Standard Protective Order.
6. Having received no discovery-related communication, I took the initiative, writing on July 19, 2013 to remind Petitioner’s counsel of the upcoming deadline for the parties’ mandatory discovery conference, and to propose a date for the conference (Exhibit A).
7. I received no response, and the deadline passed.
8. On August 6, 2013 I wrote again, advising that I had still received no response and that I remained available for the conference (Exhibit B).
9. In that letter, I also advised, specifically, that Registrant believed it was entitled to judgment on the pleadings on at least the first two of Petitioner’s claims for cancellation (fraud and non-ownership).
10. I expressly asked Petitioner to withdraw those claims voluntarily.
11. The discovery conference finally took place on August 13, 2013 (Exhibit C).
12. During that conference, Petitioner’s counsel admitted she had not read my letter of August 6, 2013 and was therefore unprepared to discuss my request for voluntary withdrawal of the fraud and ownership claims. (Exhibit C).

13. I requested a substantive reply and advised – for the second time – that barring voluntary withdrawal Registrant would seek pre-trial judgment on those claims.
14. In December 2013 Petitioner sought Registrant’s consent to an extension of time for discovery due to Petitioner’s counsel’s personal issues.
15. Registrant consented and the extension was granted (Exhibit D; ESTTA578174, of record).
16. By letter dated January 28, 2014 I wrote again, advising – yet again – that Registrant intended to seek summary judgment, and inviting Petitioner to participate in settlement negotiations (Exhibit E).
17. Petitioner’s counsel responded by email on February 12, 2014, requesting a “concrete settlement offer” (Exhibit F).
18. On February 14, 2014, by depositing with the United States Postal Service, Petitioner served Registrant with the following:
  - a. Petitioner’s First Set of Requests For Admission
  - b. Petitioner’s First Set of Requests for Production
  - c. Petitioner’s First Set of Interrogatories
19. By letter dated February 19, 2014 I delivered a concrete settlement offer and further stated, “I am in receipt of the discovery materials you served yesterday. However, I respectfully request your consent to a motion for suspension for purposes of settlement negotiation” (Confidential Exhibit G).
20. Hearing nothing, I followed up by email on February 24, 2014 (Exhibit H).
21. Still hearing nothing, I again followed up by email on March 11, 2014 (Confidential Exhibit D).

22. Finally, on March 27, 2014 Petitioner's counsel responded on the settlement proposal, via email, but said nothing about my request for consent to a motion for suspension (Confidential Exhibit I).
23. Registrant's response deadline for the Discovery Requests (March 21, 2014) had already passed at the time of the March 27, 2014 email, but Petitioner's counsel ignored it and said nothing.
24. Because Petitioner's counsel had not refused my request for consent to suspension, and given our prior course of dealing, I believed Petitioner was in the process of considering the request.
25. Registrant's counsel responded to me on April 8, 2014, further discussing settlement points (Confidential Exhibit J).
26. Petitioner's counsel received and read the April 8, 2014 email, on April 8, 2014 (Exhibit K).
27. There was still no mention of the Discovery Requests.
28. By letter dated April 15, 2014, with no prior inquiries or notice, Petitioner's counsel accused Registrant of "wholesale failure" to respond to the Discovery Requests (Exhibit L).
29. I responded immediately, by letter dated April 16, 2014 (Exhibit M).
30. Therein, I set forth the chronology of communication (as outlined above); proposed a conference to meet and confer; again sought consent to suspension in contemplation of settlement; and further requested a reasonable extension of time for the Discovery Requests.

31. Petitioner's counsel received and read the email to which the April 16, 2014 letter was attached, on April 16, 2014 (Exhibit N).
32. By letter dated April 28, 2014 Petitioner's counsel refused my requests for any mutual extensions of time, and imposed a deadline of May 6, 2014 (Exhibit P).
33. Petitioner's baseless refusal precluded the pursuit of efficient resolution, thus Registrant moved for summary judgment on May 2, 2014.
34. On October 6, 2014 Petitioner's counsel and I exchanged emails (Exhibit Q) regarding a deadline for the Discovery Requests.
35. I requested a deadline of November 17, 2014; Petitioner's counsel refused (Exhibits R, S and T).
36. I am a sole practitioner with no staff.
37. It was impossible for me to meet with my clients, assemble responses and prepare them for delivery by Petitioner's arbitrarily imposed deadline of October 17, 2014.
38. Had Petitioner agreed to my reasonable request of thirty days, I would now be devoting my time and attention to the Discovery Requests rather than to this motion.
39. Petitioner has never communicated to me any reason, other than its general unwillingness to cooperate, why extending the deadline as I requested would prejudice Petitioner or otherwise affect this proceeding.
40. I can reasonably respond to the Discovery Requests with objections and responses within thirty days from the Board's decision on this motion.
41. I am not aware of any way in which Petitioner or the underlying proceeding would be adversely affected by the granting of this motion.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

  
Elizabeth T Russell

Dated: 10-18-2014

# EXHIBIT A

# RussellLaw

49 Kessel Court Suite 200 Madison, WI 53711 608-285-5007 [www.erklaw.com](http://www.erklaw.com)

*Russell Law is a trade name of the Law Office of Elizabeth T Russell, LLC  
Elizabeth T Russell is admitted to practice in New York, Connecticut and Wisconsin*

July 19, 2013

Jill M. Pietrini, Esq.  
SHEPPARD MULLEN RICHTER & HAMPTON LLP  
1901 Avenue of the Stars, Suite 1600  
Los Angeles, CA 90067-6017

Re: Cancellation No. 92057058

Dear Ms. Pietrini:

Deadline for a discovery conference in connection with the above-referenced is July 24, 2013. I write via US Mail, as you expressed an unwillingness to communicate via email.

I am available for a telephone conference on July 24 between noon and 4pm, central time. Please advise.

Sincerely,

Elizabeth T Russell

# EXHIBIT B

# RussellLaw

6907 University Ave. #227 Middleton, WI 53562 608-826-5007 [www.erklaw.com](http://www.erklaw.com)

*Russell Law is a trade name of the Law Office of Elizabeth T Russell, LLC  
Elizabeth T Russell is admitted to practice in New York, Connecticut and Wisconsin*

August 6, 2013

Jill M. Pietrini, Esq.  
SHEPPARD MULLEN RICHTER & HAMPTON LLP  
1901 Avenue of the Stars, Suite 1600  
Los Angeles, CA 90067-6017

Re: Cancellation No. 92057058

Dear Ms. Pietrini:

Enclosed please find my change of correspondence address, filed today via ESTTA.

I remain available for the mandatory discovery conference and note that, despite my letter to you of July 19, 2013 and follow-up email of July 30, 2013 I have as yet received no communication from your office regarding same.

At this time I would like to request your withdrawal of claims "A" and "B" of the petition, namely, fraud on the office and registrant's ownership of the mark. As outlined in the answer, it seems clear that both claims are subject to dismissal on the pleadings. I intend to make a motion for partial judgment on the pleadings, if we are unable to agree upon your voluntary withdrawal of those claims. Please advise at your earliest convenience.

Sincerely,

Elizabeth T Russell

# EXHIBIT C

**From:** [Elizabeth Russell](#)  
**To:** "Whitney Walters"  
**Cc:** [jpietrini@sheppardmullin.com](mailto:jpietrini@sheppardmullin.com)  
**Subject:** Discovery conference summary: Island Food & Fun, Inc.  
**Date:** Friday, August 16, 2013 3:31:00 PM

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Re: Cancellation No. 92057058

Whitney:

Given that the deadline for initial disclosures is just a few days away, I provide this summary of our August 13 discovery conference via email rather than US Mail.

1. We conducted a discovery conference in the above-referenced, via telephone on August 13, 2013.
2. We agreed that the deadline for initial disclosures stands, at August 23, 2013.
3. Your client requests changes to the standard protective order. You will forward to me a redline of the requested changes, at your earliest convenience.
  - a. We did not discuss a date for this, but I would appreciate receiving the redline within the next week.
4. You will consult with your client about conducting this proceeding in accordance with the provisions for Accelerated Case Resolution (ACR).
5. You had not reviewed my letter of August 6, 2013. Accordingly, we were unable substantively to discuss my request that your client withdraw its claims regarding fraud on the office and ownership of the mark. You will respond substantively, as soon as possible. Again, I would appreciate a substantive reply within the next week. Barring that, I intend to make a motion for partial judgment on the pleadings, seeking the dismissal of these two claims.

Please advise if I have omitted or misstated anything.

Thanks very much,

Elizabeth

*Elizabeth T Russell* [beth@erklaw.com](mailto:beth@erklaw.com)

**NEW MAILING ADDRESS:**

6907 University Ave. #227  
Middleton, WI 53562 USA

Voice Telephone: 1-608-826-5007

# EXHIBIT D

## Elizabeth Russell

---

**From:** Whitney Walters <wwalters@sheppardmullin.com>  
**Sent:** Thursday, December 19, 2013 7:46 PM  
**To:** Elizabeth Russell  
**Subject:** 56 Hope Road v. Mormax

**Sensitivity:** Confidential

Elizabeth,

I just returned to the office after being out of commission for the past several weeks for medical reasons (associated with my pregnancy). My partner, Jill Pietrini, has also been out of the office for the last two months, as she had foot surgery in late October. In light of this, would you be willing to consent to an extension of all deadlines in the scheduling order by 60 days? Please let me know if this would be acceptable.

Thanks in advance,

Whitney

Circular 230 Notice: In accordance with Treasury Regulations we notify you that any tax advice given herein (or in any attachments) is not intended or written to be used, and cannot be used by any taxpayer, for the purpose of (i) avoiding tax penalties or (ii) promoting, marketing or recommending to another party any transaction or matter addressed herein (or in any attachments).

Attention: This message is sent by a law firm and may contain information that is privileged or confidential. If you received this transmission in error, please notify the sender by reply e-mail and delete the message and any attachments.

# EXHIBIT E

# RussellLaw

6907 University Ave. #227 Middleton WI 53562 608-826-5007 [www.erklaw.com](http://www.erklaw.com)

*Russell Law is a trade name of the Law Office of Elizabeth T Russell, LLC  
Elizabeth T Russell is admitted to practice in New York, Connecticut and Wisconsin*

January 28, 2014

Jill M. Pietrini, Esq.  
Whitney Walters, Esq.  
SHEPPARD MULLEN RICHTER & HAMPTON LLP  
1901 Avenue of the Stars, Suite 1600  
Los Angeles, CA 90067-6017

Via email: [wwalters@sheppardmullin.com](mailto:wwalters@sheppardmullin.com); [JPietrini@sheppardmullin.com](mailto:JPietrini@sheppardmullin.com)

Re: Cancellation No. 92057058

**Legal Correspondence for Settlement Purposes Only. Not Admissible Under FRE 408.**

*My statements herein are made for the purposes of settling the dispute between our clients. Anything that I might say or propose is neither an admission of any allegations that you or your client might have made nor a waiver of any rights or defenses that my client may have.*

Dear Ms. Pietrini and Ms. Walters:

Having reviewed the undisputed facts in this matter, I believe that the Registrant is entitled to judgment as a matter of law on all three of the claims raised in the petition for cancellation. Specifically:

1. **Fraud.** Registrant's alleged dates of first use were not material to registrability of the *intent-to-use* application that eventually matured into the challenged registration. As well, the required *Bose* factors are not present.
2. **Ownership of the Mark.** Non-ownership of a mark at the time of registration cannot be asserted against a registration more than five years old.
3. **False "Association."** This claim is barred on grounds of laches and estoppel, as your client expressly raised and failed to pursue identical claims over a period of at least eight years.

Accordingly, my client has instructed me to make a motion for summary judgment.

Before doing so, however, I write to ascertain your interest in discussing a settlement. I believe the likelihood of my client prevailing on summary judgment is very strong – even without discovery. However, the motion process will require both your client and mine to incur otherwise

unnecessary expenses. A confidential settlement would permit your client to avoid a public record of having failed to prevail on these issues; it would, as well, afford us an opportunity to negotiate terms finally disposing of the issues between our clients.

I draw your attention to Rule 3-510 of the California Rules of Professional Conduct, which require a lawyer promptly to inform the client of “all amounts, terms, and conditions of any written offer of settlement made to the client.” Accordingly, in any reply I request your affirmative representation that your client has received a copy of this letter; that it is aware of the unique facts of this matter; and that it has instructed you specifically to deliver the reply.

Thank you for your thoughtful consideration, and I look forward to hearing from you.

Sincerely,

Elizabeth T Russell

# EXHIBIT F

## Elizabeth Russell

---

**From:** Whitney Walters <wwalters@sheppardmullin.com>  
**Sent:** Wednesday, February 12, 2014 4:50 PM  
**To:** Elizabeth Russell  
**Cc:** Jill Pietrini  
**Subject:** RE: 56 Hope Road v. Mormax

**Sensitivity:** Confidential

Elizabeth:

We are in receipt of your letter dated January 28, 2014.

While we strongly dispute that your client is entitled judgment as a matter of law on any of the three claims asserted in the cancellation petition and are prepared to vigorously defend against any motion along those lines, we would be happy to entertain the possibility of resolving this dispute without further expenditure of attorneys' fees and costs. Your letter indicates that your client is interested in pursuing this option, yet you propose no actual "amounts, terms, [or] conditions" of settlement for our client to consider.

If you have a concrete settlement offer that you would like our client to entertain, please forward it to us, and we will send it to our client for consideration.

Best,

Whitney

---

**From:** Elizabeth Russell [mailto:[beth@erklaw.com](mailto:beth@erklaw.com)]  
**Sent:** Tuesday, January 28, 2014 9:58 AM  
**To:** Whitney Walters  
**Cc:** Jill Pietrini  
**Subject:** RE: 56 Hope Road v. Mormax  
**Sensitivity:** Confidential

Whitney and Jill,

Please confirm your receipt of the attached letter from me. I look forward to hearing from you at your earliest convenience.

Best,  
Elizabeth

Elizabeth T Russell [beth@erklaw.com](mailto:beth@erklaw.com)

Mailing address:

# EXHIBIT G

(Confidential)

# EXHIBIT H

**From:** [Elizabeth Russell](#)  
**To:** ["Whitney Walters"](#)  
**Cc:** ["Jill Pietrini"](#)  
**Subject:** RE: 56 Hope Road v. Mormax  
**Date:** Monday, February 24, 2014 11:24:00 AM  
**Sensitivity:** Confidential

---

Whitney/Jill,

Please suggest a time in the coming week when we can discuss the settlement proposal I emailed on Wednesday.

Thank you,  
Elizabeth

*Russell Law*

Mailing address:  
6907 University Ave. #227  
Middleton, WI 53562 USA

Voice Telephone: 1-608-826-5007

*Arts Law Conversations* is available at [www.rulypress.com](http://www.rulypress.com)

# EXHIBIT I

(Confidential)

# EXHIBIT J

(Confidential)

# EXHIBIT K

## Elizabeth Russell

---

**From:** Whitney Walters <wwalters@sheppardmullin.com>  
**To:** Elizabeth Russell  
**Sent:** Tuesday, April 08, 2014 11:56 AM  
**Subject:** Read: RE: 56 Hope Road v. Mormax

Your message

To: Whitney Walters  
Subject: RE: 56 Hope Road v. Mormax  
Sent: Tuesday, April 08, 2014 9:53:59 AM (UTC-07:00) Arizona

was read on Tuesday, April 08, 2014 9:56:05 AM (UTC-07:00) Arizona.

# EXHIBIT L

# SheppardMullin

Sheppard Mullin Richter & Hampton LLP  
1901 Avenue of the Stars, Suite 1600  
Los Angeles, CA 90067-6055  
310.228.3700 main  
310.228.3701 main fax  
www.sheppardmullin.com

Whitney Walters  
310.228.3714 direct  
wwalters@sheppardmullin.com

April 15, 2014

File Number: 29WG-171210

## VIA EMAIL AND CONFIRMATION BY MAIL

Elizabeth T. Russell  
Russell Law  
6907 University Ave. #227  
Middleton, WI 53562  
beth@erklaw.com

**Re: *Fifty-Six Hope Road Music Limited v. Island Food and Fun, Inc. (assignee of Mormax, Inc.) – Cancellation No. 92-057058***

Dear Elizabeth:

We write to address Registrant Mormax, Inc.'s and its assignee Island Food and Fun, Inc.'s (collectively, "Registrant") wholesale failure to respond to Petitioner Fifty-Six Hope Road Music Limited's ("Petitioner") First Sets of Requests for Production of Documents and Things ("RFPs") and Interrogatories. This letter is an effort to meet and confer over the deficiencies noticed herein pursuant to 37 C.F.R. § 2.120(e)(1) and TBMP § 523.

On February 14, 2014, Petitioner served Registrant with its first set of RFPs and Interrogatories by first class mail. Registrant's written responses to the RFPs were due to be served on Petitioner no later than March 21, 2014. Although Registrant was never granted an extension of this deadline, Registrant has not served any responses to the RFPs or Interrogatories to date. In the meantime, discovery in this case has since closed.

Registrant's failure to serve written responses is in contravention of Fed.R.Civ.P. 33(b)(2) and 34(b)(2), which require a party to serve responses and/or objections to requests for production and interrogatories within 30 days of service. Accordingly, Registrant has waived all of its objections thereto, and must immediately serve written responses to the RFPs and Interrogatories **without objection** and produce **all documents** in its possession, custody, or control responsive to the RFPs. See TBMP §§ 405.04(a), 406.04(a); *Crane Co. v. Shimano Industrial Co.*, 184 U.S.P.Q. 691, 691 (TTAB 1975). Registrant may not refuse to produce documents on the basis of any objection, nor may it resurrect any objections it is deemed to have waived by responding to the discovery requests after the deadline to respond has passed.

Registrant's service of responses with objections or its continued failure to serve responses to the RFPs or Interrogatories or to produce all responsive documents without objection will result in Petitioner filing a motion to compel with the Board.

Please confirm that Registrant will immediately comply with its obligations under the Fed.R.Civ.P. and TMBP, as articulated above. Should you wish to discuss any of these issues

# SheppardMullin

Elizabeth T. Russell  
April 15, 2014  
Page 2

further, please let us know what your availability is this week for a further meet and confer. My colleague, Paul Bost, will handle those discussions, as I am in the process of going out on maternity leave.

Very truly yours,



Whitney Walters  
for SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

SMRH:421798501.2

cc: Jill M. Pietrini, Esq.  
Paul A. Bost, Esq.

**EXHIBIT M**

# RussellLaw

6907 University Ave. #227 Middleton WI 53562 608-826-5007 [www.erklaw.com](http://www.erklaw.com)

*Russell Law is a trade name of the Law Office of Elizabeth T Russell, LLC  
Elizabeth T Russell is admitted to practice in New York, Connecticut and Wisconsin*

April 16, 2014

Paul Bost, Esq.  
SHEPPARD MULLEN RICHTER & HAMPTON LLP  
1901 Avenue of the Stars, Suite 1600  
Los Angeles, CA 90067-6017

Via email and confirmation by US Mail

Re: Cancellation No. 92057058

Dear Mr. Bost:

I understand you will be handling the above-referenced proceeding, in Whitney Walters' absence.

This will reply to Ms. Walters' letter to me dated April 15, 2014.

As I advised Ms. Walters by letter dated January 28, 2014, Registrant believes it is entitled to judgment as a matter of law and intends to file a motion for summary judgment. In the interest of judicial economy, however, the parties have been in settlement negotiations. Some chronology might be help to inform our next steps.

- I received no response to my letter of January 28, 2014 until February 12, 2014, when Ms. Walters emailed, indicating that Petitioner would be interested in discussing settlement, and inviting Registrant to prepare a detailed proposal.
- By letter dated February 19, 2014 I provided Ms. Walters with a proposal for settlement. In that letter, I specifically requested Petitioner's consent to a motion for suspension for purposes of settlement negotiation.

Ms. Walters never responded to my request for consent. She did, however, continue to participate in settlement discussions. Accordingly, Registrant conducted itself in good faith, believing that Petitioner's ongoing participation in settlement discussions suggested that Petitioner would consent to suspension or a reasonable extension of time.

I am available this week to meet and confer, and I would hope to accomplish the following:

- Ascertain whether settlement is possible and/or whether further discussions are likely to be fruitful; I have received no response to my latest correspondence to Ms. Walters, email dated April 8, 2014.
- If so: I once again seek your consent to suspension for purposes of settlement negotiation.
- If not: I seek your agreement to a reasonable extension of time for Registrant to respond to the outstanding RFPs and Interrogatories.

Sincerely,

Elizabeth T Russell

cc: Jill M. Pietrini, Esq.

# EXHIBIT N

## Elizabeth Russell

---

**From:** Whitney Walters <wwalters@sheppardmullin.com>  
**To:** Elizabeth Russell  
**Sent:** Wednesday, April 16, 2014 12:08 PM  
**Subject:** Read: RE: Fifty-Six Hope road v. Island Food and Fun

Your message

To: Whitney Walters  
Subject: RE: Fifty-Six Hope road v. Island Food and Fun  
Sent: Wednesday, April 16, 2014 10:01:05 AM (UTC-07:00) Arizona

was read on Wednesday, April 16, 2014 10:07:52 AM (UTC-07:00) Arizona.

# EXHIBIT P

Paul A. Bost  
310.228.2249 direct  
pbost@sheppardmullin.com

April 28, 2014

File Number: 29WG-171210

## VIA EMAIL AND CONFIRMATION BY MAIL

Elizabeth T. Russell  
RUSSELL LAW  
6907 University Ave. #227  
Middleton, WI 53562  
beth@erklaw.com

**Re: *Fifty-Six Hope Road Music Limited v. Island Food and Fun, Inc. (assignee of Mormax, Inc.) – Cancellation No. 92-057058***

Dear Elizabeth:

This letter responds to your letter of April 16, 2014 on behalf of Registrant Mormax, Inc. and its assignee Island Food and Fun, Inc. (collectively, "Registrant"), which was written in response to Whitney Walter's April 15, 2014 letter addressing Registrant's wholesale failure to respond to Petitioner Fifty-Six Hope Road Music Limited's ("Petitioner") First Sets of Requests for Production of Documents and Things ("RFPs") and Interrogatories.

Registrant's alleged justification for failing to serve timely responses to Petitioner's RFPs and Interrogatories is insufficient and does not establish excusable neglect. The parties never agreed to suspend the matter, much less their discovery obligations, for any purpose, including negotiating settlement. No papers seeking suspension were ever filed with the Board. As you tacitly admit in your letter, neither Whitney Walters nor anyone else acting on Petitioner's behalf ever agreed to suspend this matter for purposes negotiating settlement. Of course, Petitioner's participation in settlement discussions is not tantamount to an agreement to suspend the matter, and your construal of it otherwise is unreasonable. Finally, Registrant never requested an extension of its deadline to respond to the RFPs and Interrogatories.

Accordingly, Petitioner maintains its position that Registrant's responses to the RFPs and Interrogatories are untimely without justification, and reasserts its demand that Registrant immediately serve written responses to the RFPs and Interrogatories without objection and produce all documents in its possession, custody, or control responsive to the RFPs. If Registrant does not fully comply with the foregoing obligations by **May 6, 2014**, Petitioner will file a motion to compel Registrant's compliance.

As to the issue of settlement, Petitioner is considering Registrant's most recent correspondence of April 8, 2014 and will respond in due course. However, until such time that this matter settles, Mormax's discovery obligations continue without abatement. In the event it believes settlement is possible on the terms proposed or other terms, and Registrant fulfills its

# SheppardMullin

Elizabeth T. Russell  
April 28, 2014  
Page 2

discovery obligations, Petitioner will consider consenting to a suspension of the matter to pursue settlement negotiations.

Very truly yours,

A handwritten signature in blue ink, appearing to read 'P. A. Bost', with a long horizontal flourish extending to the right.

Paul A. Bost  
for SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

SMRH:422195611.1

cc: Jill M. Pietrini, Esq.  
Whitney Walters, Esq.

# EXHIBIT Q

## Elizabeth Russell

---

**From:** Elizabeth Russell <beth@erklaw.com>  
**Sent:** Monday, October 06, 2014 1:47 PM  
**To:** 'Paul Bost'  
**Subject:** RE: 56 Hope Road v. Island Food and Fun

As I said, we will agree to a date certain. But the responses are not prepared and can't be, by October 10. I am a sole practitioner with no staff, and numerous immediate deadlines. I can reasonably respond by November 17.

Elizabeth T Russell

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Middleton, WI 53562  
608-826-5007  
[www.erklaw.com](http://www.erklaw.com)  
[www.rulypress.com](http://www.rulypress.com)

---

**From:** Paul Bost [mailto:PBost@sheppardmullin.com]  
**Sent:** Monday, October 06, 2014 1:34 PM  
**To:** Elizabeth Russell  
**Cc:** Jill Pietrini; Beth Anderson  
**Subject:** RE: 56 Hope Road v. Island Food and Fun

Beth:

We need a date certain by which Registrant will provide its responses. Registrant's obligation to respond has never been suspended or tolled. Registrant's responses are over six months late (below, I meant to write March 21, 2014, not May 21, 2014) and Registrant has had more than enough time to prepare its responses. Even if Registrant was waiting until the disposition of its motion to respond to the discovery requests (despite its lack of basis for doing so), the motion was decided on September 17, 2014. Thus, in any event, Registrant has had sufficient time to prepare its responses. If Registrant does not provide responses by October 10, 2014 or another date certain in the near future, Petitioner must protect its rights by filing a motion to compel.

Best,

Paul

**Paul Bost**  
Los Angeles | x12249  
**SheppardMullin**

---

**From:** Elizabeth Russell [mailto:beth@erklaw.com]  
**Sent:** Monday, October 06, 2014 11:02 AM  
**To:** Paul Bost  
**Subject:** RE: 56 Hope Road v. Island Food and Fun

I understand that Registrant must now respond. It is not possible to prepare responses by October 10 but we are open to a later mutually agreed-upon date and will join in any related motion to extend trial deadlines accordingly.

Elizabeth T Russell

Russell Law  
6907 University Ave., #227  
Middleton, WI 53562  
608-826-5007  
[www.erklaw.com](http://www.erklaw.com)  
[www.rulypress.com](http://www.rulypress.com)

---

**From:** Paul Bost [<mailto:PBost@sheppardmullin.com>]  
**Sent:** Monday, October 06, 2014 11:54 AM  
**To:** [beth@erklaw.com](mailto:beth@erklaw.com)  
**Cc:** Beth Anderson; Jill Pietrini  
**Subject:** 56 Hope Road v. Island Food and Fun

Elizabeth:

Registrant's responses to Petitioner's First Set of Interrogatories and Requests for Production, which were originally due on May 21, 2014, are still outstanding. If we do not receive them by Friday, October 10, 2014, we will file a motion to compel with the Board. Thank you.

Paul Bost

310.228.2249 | direct  
310.228.3960 | direct fax  
[PBost@sheppardmullin.com](mailto:PBost@sheppardmullin.com) | [Bio](#)

## SheppardMullin

Sheppard Mullin Richter & Hampton LLP  
1901 Avenue of the Stars, Suite 1600  
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310.228.3700 | main  
[www.sheppardmullin.com](http://www.sheppardmullin.com)

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**Attention:** This message is sent by a law firm and may contain information that is privileged or confidential. If you received this transmission in error, please notify the sender by reply e-mail and delete the message and any attachments.

# EXHIBIT R

## Elizabeth Russell

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**From:** Paul Bost <PBost@sheppardmullin.com>  
**Sent:** Wednesday, October 08, 2014 12:55 PM  
**To:** Elizabeth Russell  
**Cc:** Jill Pietrini; Beth Anderson  
**Subject:** RE: 56 Hope Road v. Island Food and Fun

We cannot wait until November 17 for responses. That is the date our pretrial disclosures are due. Also, as noted below, Registrant has had more than six months to prepare its responses and gather documents for production. In the interest of compromise and with respect to the deadlines set by the Board, and also in the interest of obtaining a prompt resolution of this matter (which was delayed by Registrant's MSJ), we will agree to service of responses without objections – which have been waived – by October 17.

### Paul Bost

Los Angeles | x12249

**SheppardMullin**

---

**From:** Elizabeth Russell [mailto:beth@erklaw.com]  
**Sent:** Monday, October 06, 2014 11:47 AM  
**To:** Paul Bost  
**Subject:** RE: 56 Hope Road v. Island Food and Fun

As I said, we will agree to a date certain. But the responses are not prepared and can't be, by October 10. I am a sole practitioner with no staff, and numerous immediate deadlines. I can reasonably respond by November 17.

Elizabeth T Russell

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608-826-5007  
[www.erklaw.com](http://www.erklaw.com)  
[www.rulypress.com](http://www.rulypress.com)

---

**From:** Paul Bost [mailto:PBost@sheppardmullin.com]  
**Sent:** Monday, October 06, 2014 1:34 PM  
**To:** Elizabeth Russell  
**Cc:** Jill Pietrini; Beth Anderson  
**Subject:** RE: 56 Hope Road v. Island Food and Fun

Beth:

We need a date certain by which Registrant will provide its responses. Registrant's obligation to respond has never been suspended or tolled. Registrant's responses are over six months late (below, I meant to write March 21, 2014, not May 21, 2014) and Registrant has had more than enough time to prepare its responses. Even if Registrant was waiting until the disposition of its motion to respond to the discovery requests (despite its lack of basis for doing so), the motion was decided on September 17, 2014. Thus, in any event, Registrant has had sufficient time to prepare its responses. If

# EXHIBIT S

## Elizabeth Russell

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**From:** Paul Bost <PBost@sheppardmullin.com>  
**Sent:** Tuesday, October 14, 2014 1:42 PM  
**To:** Elizabeth Russell  
**Cc:** Jill Pietrini; Beth Anderson  
**Subject:** RE: 56 Hope Road v. Island Food and Fun

Elizabeth:

We have, in good faith, considered Registrant's request for an extension of all dates in order to discuss settlement. We respectfully refuse to agree to an extension and, furthermore, request that Registrant provide us with its discovery responses without objection by October 17, 2014, failing which Petitioner will move to compel them. This matter needs to move forward after the long delay occasioned by Registrant's motion for summary judgment, and we believe that the parties can litigate this matter and discuss settlement simultaneously.

Best,

Paul

### Paul Bost

Los Angeles | x12249

**SheppardMullin**

---

**From:** Elizabeth Russell [mailto:beth@erklaw.com]  
**Sent:** Wednesday, October 08, 2014 12:16 PM  
**To:** Paul Bost  
**Cc:** Jill Pietrini; Beth Anderson  
**Subject:** RE: 56 Hope Road v. Island Food and Fun

I have received this message and forwarded it to my client. We will respond as soon as possible and my client is, indeed, willing to negotiate a settlement.

Regarding the discovery deadline. I have also received your message imposing October 17 as a deadline. I can't meet with the clients until early next week, and responses will simply not be ready by that date. I respect and understand that the date I proposed would require a consented motion to extend the deadlines the Board imposed. Considering that we are, as well, discussing settlement, I am requesting your consent to such a motion.

Elizabeth T Russell

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Middleton, WI 53562  
608-826-5007  
[www.erklaw.com](http://www.erklaw.com)  
[www.rulypress.com](http://www.rulypress.com)

---

**From:** Paul Bost [mailto:PBost@sheppardmullin.com]  
**Sent:** Wednesday, October 08, 2014 1:07 PM