

ESTTA Tracking number: **ESTTA639721**

Filing date: **11/18/2014**

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

Proceeding	92058280
Party	Plaintiff APU XK
Correspondence Address	MARK LEBOW LADAS & PARRY LLP 1727 KING STREETSUITE 105 ALEXANDRIA, CA 22314 UNITED STATES mlebow@ladas.com, lebow@ttab.org, elinford@la.ladas.com
Submission	Motion to Extend
Filer's Name	Mark Lebow
Filer's e-mail	mlebow@ladas.com
Signature	/ml/
Date	11/18/2014
Attachments	2014-11-18 Motion To Correct and-or Extend.pdf(27877 bytes) Exhibit A.pdf(6001 bytes) Exhibit A email.pdf(72040 bytes) Exhibit B.pdf(6003 bytes) Exhibit B email.pdf(82724 bytes) Exhibit C.pdf(6003 bytes) Exhibit C email.pdf(150033 bytes)

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

APU XK,

Petitioner,

v.

TENGGIS CO.,

Applicant.

Cancellation No. 92058280

Registration No. 3949134

**REQUEST TO CORRECT AND/OR EXTEND
THE TIME FOR DISCOVERY AND TRIAL**

Petitioner, APU XK (“APU”), by and through the undersigned and recently added counsel, moves the Board for an Order correcting and/or extending the relevant discovery and trial dates in this proceeding. Specifically, APU requests that the discovery and trial schedule be corrected to account for an inadvertent error that caused the discovery and trial schedule to be miscalculated through the TTAB’s online filing system (ESTTA). In the alternative, Applicant requests that the relevant discovery and trial dates be extended by two (2) months.

BACKGROUND

As background, Petitioner, APU XK (“APU”) states the following:

On December 13, 2012, APU, a Mongolian joint stock company, filed an application (Serial No. 85801808) to register the following mark for “vodka”:

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On October 15, 2013, the Examining Attorney assigned to APU's application refused registration based on likelihood of confusion with Respondent's Registration No. 3949134 for the mark "CHINGGIS KHAAN KHAAN OF BEERS" for "beer" ("Respondent's Mark").

On November 22, 2014, following an investigation by APU which determined that Respondent's Mark was not in use in U.S. commerce, was never in use in U.S. commerce at the time of registration, and that the specimen submitted by Respondent to the USPTO was fake, APU filed the instant petition to cancel Respondent's registration. APU additionally alleged in the alternative that that if the mark had ever been used at, it had become legally abandoned for trademark registration purposes.

Respondent represented itself in the matter *pro se* through the filing of an Answer to the Petition on January 2, 2014. Thereafter, Respondent retained counsel, Peter D. Gordon, Esq., to represent him in this matter.

Three stipulated extensions of the relevant discovery and trial periods have been filed since the commencement of this proceeding during which time the parties have discussed

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possible amicable settlement of this matter. However, to date, no progress has been made towards settlement.

In the meantime, approximately 1 ½ weeks ago, the undersigned counsel took over the responsibility of handling this matter from APU's previous attorney, Ms. Elizabeth Linford, Esq., who resides in Los Angeles, California. The undersigned counsel, who resides in Alexandria, Virginia, has not previously worked with Ms. Linford and was not previously familiar with case.

On November 7, 2014, having just taken over the case and noting that only about 3 weeks remained in the discovery period, the undersigned counsel contacted Respondent's counsel by email to request a 90-day extension of time of the relevant discovery and trial periods. This email was ignored by Respondent's counsel, Mr. Gordon. A copy of that email is attached hereto as Exhibit A.

On November 12, 2014, the undersigned contact followed up on the November 7 email by calling Mr. Gordon. His secretary first advised that Mr. Gordon was on the phone, but while taking the undersigned counsel's detailed message, she further advised that he had just gotten off the phone. After a brief hold, the undersigned counsel was advised that Mr. Gordon would have call back. The undersigned counsel then sent a follow-up email. A copy of that email is attached hereto as Exhibit B.

Having received no call back, the undersigned counsel called Mr. Gordon back on November 13, 2014. Mr. Gordon was finally available for discussion. In that conversation,

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counsel discussed the currently requested extension of time; previous counsel Ms. Linford's ongoing cooperation with him to date; Mr. Gordon's belief that he should be able to take the live deposition of Petitioner's representatives despite their being in Mongolia; and his desire to receive a reply to the last settlement proposal tendered by his client. Mr. Gordon declined to consent to a further extension of time without first speaking to his client. He advised that he would refer back in reference to the extension request by Monday, October 17, 2014. However, Mr. Gordon did not refer back.

Also on November 17, 2014, and following a discussion with Ms. Linford, the undersigned counsel realized that, in actuality, there should actually be more than two (2) months remaining in the discovery period and that the current indication of dates in the last request is in error. Thereafter, the undersigned counsel again contacted Mr. Gordon by email to request his consent to APU's filing of a stipulated correction of the relevant trial dates. This would avoid filing a motion with the Board and a waste of time and resources. A copy of that email is attached here as Exhibit C. Mr. Gordon, however, did not reply back. In a follow-up telephone call, Mr. Gordon's secretary stated that he was in mediation.

REQUEST TO CORRECT AND/OR EXTEND

APU requests that the **inadvertent error** in the last stipulated extension of time be correct and that the new dates be set forth as follows:

Time to Answer:	CLOSED
Deadline for Discovery Conference:	CLOSED

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Discovery Opens:	CLOSED
Initial Disclosures Due:	CLOSED
Expert Disclosure Due:	12/30/2014
Discovery Closes:	1/29/2015
Plaintiff's Pretrial Disclosures:	3/15/2015
Plaintiff's 30-day Trial Period Ends:	4/29/2015
Defendant's Pretrial Disclosures:	5/14/2015
Defendant's 30-day Trial Period Ends:	06/28/2015
Plaintiff's Rebuttal Disclosures:	07/13/2015
Plaintiff's 15-day Rebuttal Period Ends:	08/12/2015

As grounds for this request, APU states the following:

1. When the June 19, 2014 stipulated extension of time was filed, the discovery close date was indicated as September 1, 2014, and the 60-day extension of time was automatically calculated by the TTAB online filing system based on that date. Based on that calculation, the new close of discovery was indicated as October 31, 2014.

2. When the last stipulated extension of time was filed on August 22, 2014, the close of discovery was inadvertently again indicated as September 1, which caused the agreed-upon further 90-day extension of time to be calculated as closing *only 30 days later* – instead of the requested 90 days – on November 30, 2014. The Board's Order granting that extension merely granting the inadvertent dates set forth in the motion.

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3. Based on the foregoing, APU is merely requesting that the previously agreed upon stipulation be corrected to reflect the dates that would have been set forth had the at-the-time known closing date of discovery been properly indicated as October 31, 2014 rather than September 1, 2014 and good cause exists for the granting of that request.

4. In the alternative, APU requests that the relevant discovery and trial dates be extended by 60 days to match the same dates as set forth above. Good cause exists for this first unilateral, non-consented request based on the foregoing facts.

WHEREFORE, Opposer prays the Board grant this request.

November 18, 2014

Respectfully submitted,

/Mark Lebow/
Mark Lebow
Attorney for Applicant
Ladas & Parry
1727 King Street, Suite 105
Alexandria, VA 22314
Tel: (703) 837-9600

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CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the within Request to Correct and/or Extend the Time for Discovery and Trial is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to Respondent's counsel, Peter D. Gordon, Esq., 8052 Melrose Avenue, 2nd Floor, Los Angeles, CA 90046-7015 this 18th day of November 2018.

/Mark Lebow/
Mark Lebow

EXHIBIT A

Lebow, Mark

From: Lebow, Mark
Sent: Friday, November 07, 2014 2:36 PM
To: 'peter@lawnet1.com'
Cc: 'web-inquiry6@lawnet1.com'; Linford, Elizabeth; Nguyen, Amy
Subject: APU XK v Tenggis Co., Ltd. - TTAB Cancellation No. 92058280

Importance: High

Tracking:	Recipient	Read
	'peter@lawnet1.com'	
	'web-inquiry6@lawnet1.com'	
	Linford, Elizabeth	
	Nguyen, Amy	Read: 11/7/2014 2:46 PM

Peter,

I write regarding the above cancellation matter. I will be taking over the handling of this matter from Elizabeth Linford, with whom you have been dealing with on this matter previously.

Since I am just getting into the case and coming up to speed, I would appreciate your professional courtesy in extending the relevant trial periods by 90 days. I understand Elizabeth has previously consented to your requests for extension and vice-versa and that counsel has been cooperating previously. I think Elizabeth may have left you some messages and I too just attempted to reach you by phone and left a message with your secretary.

Please let me know by today, if possible, so that I can file the relevant documents with the TTAB.

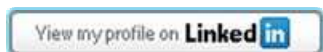
Sincerely yours,

Mark Lebow

Partner



*- Celebrating 102 Years -
1912 - 2014*



LADAS & PARRY LLP | 1727 King Street, [Suite](#) 105 | Alexandria VA 22314 | Tel: [703 837 9600](tel:7038379600) | Fax: [703 837 0980](tel:7038370980) | E mail: lebow@ttab.org | Web: www.ladas.com

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EXHIBIT B

Lebow, Mark

From: Lebow, Mark
Sent: Wednesday, November 12, 2014 11:16 AM
To: 'peter@lawnet1.com'
Cc: 'web-inquiry6@lawnet1.com'; Linford, Elizabeth; Nguyen, Amy
Subject: RE: APU XK v Tenggis Co., Ltd. - TTAB Cancellation No. 92058280

Tracking:	Recipient	Read
	'peter@lawnet1.com'	
	'web-inquiry6@lawnet1.com'	
	Linford, Elizabeth	
	Nguyen, Amy	Read: 11/12/2014 11:24 AM

Hi Peter,

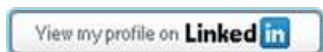
I'm following up on last week. When I spoke to your assistant, she mentioned you would need to call me back. The courtesy of a reply would be appreciated.

Best regards,

Mark Lebow
Partner



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From: Lebow, Mark
Sent: Friday, November 07, 2014 2:36 PM
To: 'peter@lawnet1.com'
Cc: 'web-inquiry6@lawnet1.com'; Linford, Elizabeth; Nguyen, Amy
Subject: APU XK v Tenggis Co., Ltd. - TTAB Cancellation No. 92058280
Importance: High

Peter,

I write regarding the above cancellation matter. I will be taking over the handling of this matter from Elizabeth Linford, with whom you have been dealing with on this matter previously.

Since I am just getting into the case and coming up to speed, I would appreciate your professional courtesy in extending the relevant trial periods by 90 days. I understand Elizabeth has previously consented to your requests for extension and vice-versa and that counsel has been cooperating previously. I think Elizabeth may have left you some messages and I too just attempted to reach you by phone and left a message with your secretary.

Please let me know by today, if possible, so that I can file the relevant documents with the TTAB.

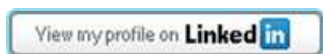
Sincerely yours,

Mark Lebow

Partner



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EXHIBIT C

Lebow, Mark

From: Lebow, Mark
Sent: Monday, November 17, 2014 4:20 PM
To: peter@lawnet1.com
Cc: Linford, Elizabeth; Nguyen, Amy
Subject: RE: APU XK v Tenggis Co., Ltd. - TTAB Cancellation No. 9205828
Attachments: APU XK v Tenggis Co., Ltd. - TTAB Cancellation No. 92058280; RE: APU XK v Tenggis Co., Ltd. - TTAB Cancellation No. 92058280

Importance: High

Peter,

I refer to our conversation on Thursday November 13, 2014. At the time, you apologized for not having returned my phone call and two separate emails sent to you on November 7 and 13 (attached), respectively, regarding this matter.

To recap, I, as counsel in the Washington, D.C. office taking over the handling of this dispute on behalf of the Petitioner, APU XK, requested as a matter of courtesy a request for an extension of 90-days of the relevant discovery and trial periods. The Board prefers that parties' cooperative and will usually grant agreed upon extension of time, particularly if the parties have engaged in settlement discussions. As you then realized, I am part of Ladas & Parry's Alexandria, VA office and had not previously worked with the Ladas & Parry LA office. Furthermore, I confirmed with you that Elizabeth Linford, the attorney handling the matter to this point, has been very cooperative with you procedurally and further to your own requests for extension.

In our conversation, you indicated that:

- You believed the Petitioner, a Mongolian company, should have to submit to person jurisdiction in California for deposition as opposed to your having to go through standard TTAB requirements of taking a foreign party's deposition; and
- You complained about not having received a response to your clients most recent settlement proposal.

The requested extension would allow time for us to address those issues without having the relevant discovery and trial periods run and would act to protect both sides in taking appropriate steps in the event settlement discussions broke down.

You said you need to speak to your client before agreeing to a further extension of time, complaining that your client may not like the additional time to be extended. You said you would refer back to me on Monday. However, I have yet to hear from you and it is already 4:19 pm on Monday, November 17. Your secretary states you are in Mediation today.

As demonstrated by the below forwarded emails, you wanted a 60-90 day extension of time due to your "heavy trial schedule and a delayed vacation starting a week from now". Elizabeth kindly agreed to file both of the last two extensions of time on behalf of the parties.

It has come to my attention today that there was a typographical error in the consented filing, which resulted in a miscalculation of the current dates, to wit:

1. When The 6/19/14 stipulated extension of time was filed, the discovery close date was indicated as September 1, 2014, and the 60-day extension of time was automatically calculated by the TTAB online filing system based on that date. Based on that calculation, the new close of discovery was indicated as October 31, 2014.
2. When the last stipulated extension of time was filed on August 22, 2014, the close of discovery was inadvertently again indicated as September 1, which caused the agreed-upon further 90-day extension of time to be calculated as closing only 30 days later – instead of the requested 90 days – on November 30, 2014.

Elizabeth advised me today that she mentioned this to you and you did not have a reply. Therefore, it seems fairly disingenuous of you to complain about my current request to extend the current dates.

My position now is that a **corrected** consented motion should now be filed to clarify the obvious error. If you do not consent, it will waste everyone's time, including the Board's time.

Given the unnecessary time that has already passed following my first contact with you on November 7, I ask you to confirm your consent within today.

Sincerely yours,

Mark Lebow

Partner



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From: Linford, Elizabeth

Sent: Monday, November 17, 2014 3:34 PM

To: Lebow, Mark

Subject: FW: DISCOVERY -- EXTENSION IN TIME ----- \$100,000 OFFER OVERLOOKED

From: <Linford>, Elizabeth Linford <elinford@la.ladas.com>

Date: Friday, August 22, 2014 3:48 PM

To: Peter D Gordon <peter@lawnet1.com>

Subject: Re: DISCOVERY -- EXTENSION IN TIME ----- \$100,000 OFFER OVERLOOKED

Thank you, Peter. I will go ahead and request the 90 days. It sounds like that will benefit us both.

Have a good vacation. I am out of the office next week, so lets try to reconnect when you get back from your vacation.

Best regards,

Elizabeth



From: Peter D Gordon <peter@lawnet1.com>

Date: Friday, August 22, 2014 4:34 PM

To: Elizabeth Linford <elinford@la.ladas.com>, Peter Gordon <peter@lawnet1.com>

Subject: Re: DISCOVERY -- EXTENSION IN TIME ----- \$100,000 OFFER OVERLOOKED

Dear Elizabeth:

Thanks for your understanding.

I would favor extending the deadlines by 60 or 90 days.
I have a heavy trial schedule and a delayed vacation starting
a week from now.

I will be discussing the offer/situation with my client and
co counsel next week.

Kind regards,

Peter

On 8/22/2014 1:50 PM, Linford, Elizabeth wrote:

Peter,

No worries. Happens to me all the time. I have discovery requests ready to go out shortly, but if you would like more time to discuss the settlement offer with your client, as well as time for follow up on your own discovery, if needed, I can extend the deadlines out another 30 days. Just let me know. Thanks.

Best regards,
Elizabeth



From: Peter D Gordon <peter@lawnet1.com>

Date: Friday, August 22, 2014 1:32 PM

To: Elizabeth Linford <elinford@la.ladas.com>, Peter Gordon <peter@lawnet1.com>

Subject: Re: \$100,000 OFFER OVERLOOKED -- APPLICATION TO TTAB FOR TRIAL DATE EXTENSION and EXTENSION TO RESPOND TO DISCOVERY TO 7/3/14

Dear Elizabeth:

I am sorry to inform you that this email was overlooked.
I am so inundated with unwanted emails that now and again an item
is just lost in the morass.

While \$100,000 is 1/10 of our demand, it is my solemn duty to pass
it on. Also, I apologize for this oversight and the delay it has caused.

Kind regards,

Peter

--

Peter D. Gordon, Attorney at Law

8050 Melrose Avenue, 2nd Floor
Los Angeles CA 90046-7015

Tel: 323-651-2700
Fax: 323-651-3726
peter@lawnet1.com



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On 8/22/2014 12:51 PM, Linford, Elizabeth wrote:

Dear Peter,

I am following up on my email below. Please advise if you have had a chance to discuss APU's proposed settlement terms with your client. I look forward to hearing from you.

Best regards,
Elizabeth



...

--

Peter D. Gordon, Attorney at Law

8050 Melrose Avenue, 2nd Floor
Los Angeles CA 90046-7015

Tel: 323-651-2700

Fax: 323-651-3726

peter@lawnet1.com

**GORDON & [REDACTED]
[REDACTED] ASSOCIATES**

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