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

Proceeding	92064261
Party	Defendant John Groat dba Holly Shirt!
Correspondence Address	ROBERT E PURCELL THE LAW OFFICE OF ROBERT E PURCELL PLLC 211 WEST JEFFERSON STREET, SUITE 24 SYRACUSE, NY 13202 UNITED STATES Email: rpurcell@repurcelllaw.com
Submission	Opposition/Response to Motion
Filer's Name	Robert E. Purcell
Filer's email	rpurcell@repurcelllaw.com
Signature	/Robert E. Purcell/
Date	08/30/2017
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration Serial No. 4,099,565

-----X
Michael Spitzbarth,

Petitioner,

Cancellation No.
92064261

-vs-

JOHN GROAT
D/B/A HOLY SHIRT!,

Registrant.

-----X
**REGISTRANT'S RESPONSE TO PETITIONER'S MOTION TO COMPEL
DISCOVERY AND REGISTRANT'S CROSS-MOTION TO STRIKE PETITIONER'S
MOTION**

Registrant, John Groat d/b/a Holy Shirt!, hereby responds to Petitioner's motion to compel discovery and to extend the discovery period (hereinafter "Petitioner's Motion"). Registrant also cross-moves to strike Petitioner's Motion. As grounds for the response and for the cross-motion, Registrant states as follows.

Petitioner first served discovery on February 10, 2017. That discovery is the subject of Petitioner's Motion.

On February 21, 2017, well before responses to the discovery were due, Registrant filed a motion for summary judgment. In accordance with the dictates of Rule 2.127(d), the Board suspended proceedings with respect to all matters not germane to the motion. In accordance with conventional Board practice and the Board's interpretation of Rule 2.127(d), the order specifically stated (1) the suspension was effective as of the filing date of the motion, and (2) the suspension tolls the time to respond to outstanding discovery requests. See also, TBMP 528.03.

The Board denied Registrant's summary judgment motion by order dated June 20, 2017. Registrant promptly filed a motion for reconsideration on June 27, 2017. The motion for reconsideration explained that the Board committed clear error by denying the summary judgment motion on the sole basis that Registrant had not pleaded lack of standing as an affirmative defense. The Board's ruling cited to no supporting authority, and as noted in

Registrant's motion for reconsideration, such a ruling was contrary to solid Board precedent to the effect that lack of standing is not an affirmative defense that must be pleaded and that, if such a defense is pleaded, it is subject to being stricken. The motion for reconsideration requested that the Board vacate its order denying summary judgment and that the Board address the merits of the summary judgment motion. As a precaution, Registrant concurrently filed a motion requesting suspension of proceedings pending a disposition of the motion for reconsideration.

As of the date of filing this response, the Board has addressed neither the motion for reconsideration nor the motion to suspend filed approximately two months earlier.

Rule 2.127(d) provides in pertinent part:

When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion **and** no party should file any paper which is not germane to the motion except as otherwise specified in the Board's suspension order.

(emphasis added). There is no dispute, nor can there be any dispute, that Registrant's motion for reconsideration is potentially dispositive of this cancellation proceeding. Accordingly, Rule 2.127(d) *compels* (1) the Board to suspend this proceeding,¹ and (2) no party should file any paper which is not germane to the motion for reconsideration.

Petitioner's Motion was filed on August 24, 2017, while the motion for reconsideration was still pending. The motion seeks to compel Registrant's responses to discovery served back on February 10, 2017 and further seeks to extend the discovery period for the sole purpose of permitting the Petitioner to take possible follow-up discovery depositions. Petitioner's Motion is not germane to the motion for reconsideration.

In correspondence with Petitioner's counsel, Registrant explained that the best course of action regarding outstanding discovery is for the parties to stipulate to a 60-day extension of time of all future dates. Such an extension would (1) give the Board additional time in which to decide the pending motion for reconsideration. (2) avoid unnecessary expense if the motion for reconsideration is granted and summary judgment is granted, and (3) still permit Petitioner to obtain discovery responses and follow-up discovery depositions if the motion for reconsideration


¹ Although the Board has issued decisions in which it finds some discretion in whether to suspend proceedings, Registrant believes the Rule is self-effectuating and permits no discretion in connection with its implementation.

is denied. Petitioner declined Registrant's suggested stipulation for a 60-day extension of all future dates.²

Petitioner's Motion clearly violates Rule 2.127(d), which compels, "[N]o party should file any paper which is not germane to the [potentially dispositive] motion except as specified in the Board's suspension order." Here, the Board has not issued any suspension order, and thus, the Board has not permitted any exception. Accordingly, Petitioner's Motion should be stricken.

Further, good cause exists for denying as premature Petitioner's Motion for the reasons stated above.

Dated: August 30, 2017

By: 
Robert E. Purcell, Esq.
THE LAW OFFICE OF ROBERT E. PURCELL, PLLC
211 West Jefferson Street, Suite 24
Syracuse, New York 13202
Telephone: (315) 671-0710
Facsimile: (315) 671-0711
E-mail: rpurcell@repurcelllaw.com
Attorneys for the Registrant, John Groat

² Registrant filed on August 24, 2017 a motion unilaterally requesting such a 60-day extension.

CERTIFICATE OF SERVICE

I certify that on the 30 day of August, 2017 a copy of the foregoing REGISTRANT'S RESPONSE TO PETITIONER'S MOTION TO COMPEL DISCOVERY AND REGISTRANT'S CROSS-MOTION TO STRIKE PETITIONER'S MOTION was sent via E-Mail and First Class U.S. Mail, postage pre-paid, to the following:

Norman P Soloway
Hayes Soloway PC
4640 E Skyline Drive
Tucson, AZ 85718
United States
Jbarton@Hayes-Soloway.com, Admin@Hayes-Soloway.com
Phone: 520-882-7623

/s/Allison Haines

Allison Haines