

ESTTA Tracking number: **ESTTA883152**

Filing date: **03/14/2018**

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

Proceeding	92065051
Party	Plaintiff Master Inspector Certification Board, Inc.
Correspondence Address	JAMES A SHERIDAN SHERIDAN LAW LLC 1600 JACKSON ST STE 350 GOLDEN, CO 80401 UNITED STATES Email: email@sheridanlaw.com, jsheridan@sheridanlaw.com, mking@sheridanlaw.com, mark@cohenslaw.com
Submission	Opposition/Response to Motion
Filer's Name	James A. Sheridan
Filer's email	jsheridan@sheridanlaw.com, mking@sheridanlaw.com, mark@cohenslaw.com
Signature	/James A. Sheridan, 43114/
Date	03/14/2018
Attachments	Certified Inspection Expert response motion to test sufficiency - signed.pdf(104578 bytes)

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

MASTER INSPECTOR CERTIFICATION)	
BOARD, INC.,)	
)	
Petitioner,)	Cancellation No. 92/065,051
)	
)	Certification Mark: CERTIFIED
)	INSPECTION EXPERT
)	
PHILLIP NATHAN THORNBERRY,)	Reg. No.: 4,801,335
)	
Registrant.)	
_____)	

**RESPONSE TO MOTION TO TEST SUFFICIENCY OF AND DEEM UNTIMELY
RESPONSES REQUESTS FOR ADMISSIONS, AND CROSS-MOTION TO
WITHDRAW ANY RESPONSES DEEMED ADMITTED**

Petitioner submits this Response to Registrant’s Motion to Test Sufficiency of Deem Untimely Responses (sic) Requests for Admission (Motion). Petitioner believes the TTAB should deny the Motion, but if the TTAB deems the requests to have been admitted, Petitioner moves to withdraw the admissions for the reasons set forth below.

Petitioner agrees with the basic facts alleged in the Background section of Registrant’s Motion. However, Registrant omits critical relevant facts. During the relevant period only Ms. Vollmer represented Registrant. Ms. Vollmer knew InterNACHI had two lawyers in two different locations – its trademark counsel, Mr. Sheridan, and its in-house General Counsel, Mr. Cohen. See, Certificate of Service on **EXHIBIT A** to Registrant’s Motion.

However, when Ms. Vollmer sent her email on November 10, 2017, she emailed it only to Mr. Sheridan’s paralegal, Marcie King, not to Mr. Sheridan or Mr. Cohen.

See, **EXHIBIT B** to Registrant's Motion at bottom of the first page. Clearly, by inquiring about the status of the discovery responses on November 10, 2017, Ms. Vollmer was not at that time taking the position that the deadline to respond to the Requests for Admissions had passed and was not claiming that Registrant had been prejudiced. Once Mr. Cohen became aware of the communication from Ms. Vollmer, and reasonably believing she was still willing to accept responses, he immediately drafted responses to all the discovery requests. Petitioner served those responses on November 28, 2017. See, **EXHIBIT 1** attached.

Registrant is estopped from claiming the admissions are deemed admitted because Registrant's counsel, Ms. Vollmer, affirmatively led Petitioner's counsel to believe she still wanted to receive responses. Once aware of this, Petitioner promptly submitted responses. Petitioner incurred attorney's fees in preparing those responses in response to Ms. Vollmer's request.

If the TTAB deems the requests for admission to have been admitted, pursuant to FRCP 36(b), Petitioner asks to withdraw those admissions. FRCP 36(b) provides:

Effect of an Admission; Withdrawing or Amending It. A matter admitted under this rule is conclusively established unless the court, on motion, permits the admission to be withdrawn or amended. Subject to Rule 16(e), the court may permit withdrawal or amendment if it would promote the presentation of the merits of the action and if the court is not persuaded that it would prejudice the requesting party in maintaining or defending the action on the merits. An admission under this rule is not an admission for any other purpose and cannot be used against the party in any other proceeding.

In this case, allowing Petitioner to withdraw any admissions deemed admitted would promote presentation of the merits. Moreover, Registrant can hardly argue prejudice given the Registrant's own counsel did not take the position that the requests had been

deemed admitted and given that Petitioner promptly provided responses once Mr. Cohen became aware of Ms. Vollmer's email to Mr. Sheridan's paralegal.

The party opposing an FRCP 36(b) request to withdraw admissions has the burden of proving prejudice. *Hadley*, 45 F.3d at 1345, 1348 (9th Cir. 1995). See also, *Raiser v. Utah County*, 409 F.3d 1243 (10th Cir. 2005)(District Court abused its discretion in denying motion to withdraw admissions deemed admitted where no prejudice was shown); *Perez v. Miami-Dade County*, 297 F.3d 1255 (11th Cir. 2002); (District Court abused its discretion in denying motion to withdraw admissions deemed admitted where no prejudice was shown).

CONCLUSION

The TTAB should deny the Motion because Registrant's own behavior provides a basis for estoppel. If the TTAB deems the requests admitted, the TTAB should grant Petitioner's Motion to withdraw the admissions because doing so will promote presentation of the merits and Registrant cannot show that it will be prejudiced.

Dated: March 14, 2018

Respectfully submitted,

/James A. Sheridan 43114/
James A. Sheridan
Libby Huskey
SHERIDAN LAW LLC
1600 Jackson Street, Ste. 350
Golden, CO 80401
Telephone: (303) 953-9083
Facsimile: 720-548-9810

/Mark Cohen/
MARK COHEN, J.D., LL.M. - #13178
MICB General Counsel
P.O. Box 19192
Boulder, CO 80308
(303) 638-3410
mark@cohenslaw.com

**ATTORNEYS FOR PETITIONER
MASTER INSPECTOR CERTIFICATION BOARD,
INC.**

CERTIFICATE OF SERVICE

I certify that on March 14, 2018, I served a true and correct copy of the foregoing PRETRIAL DISCLOSURES U.S. mail, postage prepaid, and addressed to the following:

Alix Lei Vollmer, Esq.
General Counsel, Residential Warranty Services, Inc.
P.O. Box 797
Carmel, IN 46082

Alice A. Kelly
Shyla N. Jones
Ice Miller, LLP
200 W. Madison Street
Suite 3500
Chicago, IL 60606

and further certify that on the same day I sent a copy of this document to Ms. Vollmer via email to her at alix@alixvollmer.com and to Alice.Kelly@icemiller.com, Shyla.Jones@icemiller.com, and chiipdockete@icemiller.com.

/James A. Sheridan 43114/
James A. Sheridan
SHERIDAN LAW LLC