

ESTTA Tracking number: **ESTTA1042207**

Filing date: **03/13/2020**

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

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|------------------------|--|
| Proceeding | 92068364 |
| Party | Defendant Endura Ltd. |
| Correspondence Address | JANET F SATTERTHWAITE POTOMAC LAW GROUP 1300 PENNSYLVANIA AVE NW, SUITE 700 WASHINGTON, DC 20004 UNITED STATES tm@potomaclaw.com, jsatterthwaite@potomaclaw.com 202-486-1578 |
| Submission | Motion to Suspend for Settlement Discussions |
| Filer's Name | Janet Satterthwaite |
| Filer's email | tm@potomaclaw.com, jsatterthwaite@potomaclaw.com |
| Signature | /Janet F. Satterthwaite/ |
| Date | 03/13/2020 |
| Attachments | MOTION 2 TO SUSPEND LUMONITE.pdf(98548 bytes) |

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Cancellation No. 92068364

Handshake Trading Oy

v. Endura Ltd.

The parties seek a further 60-day suspension for settlement. The Board's Order of December 2, 2019, had the following instructions regarding a status report for future consent motions:

The report must set forth, at a minimum, 1) all dates on which the parties communicated, and the method of each communication (e.g. telephone conferences, emails, in-person meetings), 2) the general nature of each communication, 3) the issues that have been resolved, 4) the issues that remain to be resolved or that remain for trial, and 5) a proposed timetable for resolution of the remaining issues. Appropriately designated confidential information or materials may be filed under seal pursuant to Trademark Rule 2.126(c). See TBMP § 605.02.

Delay in this case stems, apparently on both sides, in large part on having to go through foreign instructing counsel to get instructions from the actual parties. The parties have, through counsel, been actively, but to date not successfully, negotiating settlement terms for a long time now, and have not just been sitting on this case.

Since the filing of the last consented extension motion, counsel have had the following exchanges:

Counsel for Petitioner emailed Counsel for Registrant on December 3, 2019, with comments on the latest settlement proposal.

Counsel for Registrant reported those comments to Registrant's UK counsel in December 3 with comprehensive advice on options and next steps.

UK Counsel for Registration sent instructions to Counsel for Registrant on January 8, 2020.

Counsel for Registrant was tied up in preparations for a Preliminary Injunction hearing in another matter on January 10 and was unable to review and consider the instructions until this week. On January 15, 2020, Counsel for Registrant reviewed the instructions and sent back questions re same to UK counsel for Registrant and thus has not yet been able to communicate back to Counsel for Petitioner before the deadline to Answer.

After some further email discussions with Registrant , on March 3, 2020, Counsel for Registrant visited *in person* with instructing counsel *in the UK* and discussed the counterproposal. Counsel for Registrant is now back from overseas and other travel and is working on a draft proposal to send to Registrant for approval, after which it will be sent to Counsel for Petitioner.

We cannot report that any issues have been resolved as the settlement negotiations are ongoing and one part cannot be agreed to in a vacuum until the while set of terms are negotiated.

Counsel for Petitioner endorsed this memo and consented to the extension via email on March 13, 2020.

The parties propose the following new scheduling order to which each party agrees:

Time to Answer

4/16/2020

| | |
|---|------------|
| Deadline for Discovery Conference Discovery Opens | 4/15/2020 |
| Initial Disclosures Due | 6/16/2020 |
| Expert Disclosures Due | 10/14/2020 |
| Discovery Closes | 11/13/2020 |
| Plaintiff's Pretrial Disclosures Due | 12/27/2020 |
| Plaintiff's 30-day Trial Period Ends | 2/11/2021 |
| Defendant's Pretrial Disclosures Due | 2/26/2021 |
| Defendant's 30-day Trial Period Ends | 4/10/2021 |
| Plaintiff's Rebuttal Disclosures Due | 4/25/201 |
| Plaintiff's 15-day Rebuttal Period Ends | 5/24/2021 |
| Plaintiff's Opening Brief Due | 7/25/2021 |
| Defendant's Brief Due | 8/25/2021 |
| Plaintiff's Reply Brief Due | 9/9/2021 |
| Request for Oral Hearing (optional) Due | 9/19/2021 |

Respectfully submitted,



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CERTIFICATE OF SERVICE

I certify that I sent a copy of the foregoing MOTION by email on March 13, 2020, to counsel for

Registrant:

rgan@wenderoth.com

WLP@wenderoth.com

A handwritten signature in black ink, appearing to read "Janet Salt". The signature is written in a cursive style with a long, sweeping tail on the "t".