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

Proceeding	92070407
Party	Defendant Chubb INA Holdings Inc.
Correspondence Address	TIMOTHY D PECSENYE BLANK ROME LLP ONE LOGAN SQUARE PHILADELPHIA, PA 19103 UNITED STATES pecsenye@blankrome.com, mhomyk@blankrome.com 215-569-5619
Submission	Opposition/Response to Motion
Filer's Name	Matthew A. Homyk
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Signature	/matthew homyk/
Date	01/11/2020
Attachments	Registrant Response to Petitioner Motion to Extend Discovery Period.pdf(137810 bytes) Exhibit A_Redacted.pdf(223867 bytes)

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

AWP USA INC.,	:	
	:	
Petitioner,	:	Registration No. 5323248
	:	
v.	:	Cancellation No. 92070407
	:	
CHUBB INA HOLDINGS INC.,	:	Mark: CHUBB TRAVEL SMART
	:	
Registrant.	:	
	:	

**REGISTRANT'S RESPONSE IN OPPOSITION TO
PETITIONER'S MOTION TO EXTEND DEADLINES**

Registrant, Chubb INA Holdings Inc. ("Chubb" or "Registrant"), by and through its attorneys, submits this Response in Opposition to Petitioner AWP USA Inc.'s ("Petitioner") Motion to Extend Deadlines. For the reasons set forth herein, Petitioner's Motion should be denied.

I. PROCEDURAL HISTORY

On May 1, 2018, Petitioner filed U.S. Application No. 87/901,868 for the TRAVELSMART mark. The U.S. Patent and Trademark Office refused registration of U.S. Application No. 87/901,868 under Section 2(d) of the Trademark Act based on a likelihood of confusion with Chubb's U.S. Registration No. 5,323,248 for the CHUBB TRAVEL SMART mark. In response to this refusal, on January 22, 2019, Petitioner filed a Petition for Cancellation in an attempt to cancel Chubb's U.S. Registration No. 5,323,248 for the CHUBB TRAVEL SMART mark.

On January 23, 2019, the Board issued a Scheduling Order in connection with Cancellation No. 92070407 in which it set, among other deadlines: (i) Petitioner's pretrial disclosures deadline as November 14, 2019; and (ii) Petitioner's 30-day Trial Period to end on December 29, 2019.

Petitioner failed to serve pretrial disclosures on or before the deadline of November 14, 2019, and has not served any such pretrial disclosures to date.

Petitioner then waited until mere days before the end of its 30-Day Trial Period to contact Registrant for an extension of the deadlines in this case. Initially, Registrant had contacted Petitioner on September 30, 2019 with a proposal to extend the deadlines in this proceeding while the parties were in settlement discussions. See email exchange between Petitioner's counsel and Registrant's counsel attached hereto as Exhibit A. Petitioner did not respond for **well over eleven (11) weeks later**, at which time it stated its "interest[] in exploring the 60-day suspension." See id. Notably absent from this response was any plausible explanation for: (i) failing to respond to Registrant's initial request for over two months; (ii) failing to offer any explanation - let alone a good faith cause - for the requested extension. Prior to any response from Registrant, Petitioner unilaterally filed the instant motion to extend the deadlines in this case, again with no plausible or good faith explanation for the requested last-minute extension.

II. ARGUMENT

Pursuant to Fed. R. Civ. P. 6(b), made applicable to Board proceedings by 37 C.F.R. § 2.116(a), a party may file a motion for an enlargement of the time in which an act is required or allowed to be done. To secure the requested enlargement of time, however, the moving party must demonstrate good cause for the requested extension. T.B.M.P. § 509.01. A motion to extend must set forth with particularity the facts said to constitute good cause for the requested extension; mere conclusory allegations lacking in factual detail are insufficient. T.B.M.P. § 509.01(a). Moreover, a party moving to extend time must demonstrate that the requested extension of time is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the previously allotted time. Id. The Board will "scrutinize carefully" any motion to extend time to determine whether the requisite good cause has been shown. Id.

In the present matter, Petitioner has failed to show any good cause for its extension request. Petitioner merely contends that "since the closing of the Discovery Period [on September 30, 2019], the parties have undergone discussion of potentially suspending this proceeding and entering into a coexistence agreement" See Petitioner's Motion at pp. 3-4. Indeed, such a contention wholly mischaracterizes the series of events leading up to the extension request and altogether fails to establish any good cause on the part of Petitioner for its request.

The notion that the parties engaged in "discussion of potentially suspending this proceeding" fails to hold muster as there was no continuing discussion between the parties. Petitioner's delayed extension request can only be qualified as a unilateral attempt to draw out this case, at the risk of prejudicing Registrant. Indeed, although Registrant contacted Petitioner on September 30, 2019 to gauge interest in a 60-day extension of the deadlines, Petitioner's counsel failed to respond for **well over eleven (11) weeks**. Before receiving any response from Registrant, and a mere six (6) days before the end of its 30-Day Trial Period, Petitioner filed the instant motion. Notably, Petitioner's motion sets forth no facts to demonstrate good cause for its request to suspend its trial period.¹ Such a hurried motion at the tail end of Petitioner's trial period begs the question: what was Petitioner doing from September to December? The only reasonable explanation for the delay is Petitioner's own lack of diligence. Such lack of diligence and unreasonable delay on the part of Petitioner does not constitute the good cause necessary for the requested extension of time. Instruments SA Inc. v. ASI Instruments Inc., 53 U.S.P.Q.2D (BNA) 1925 (T.T.A.B. 2000) ("Cursory or conclusory allegations that are denied unequivocally

¹ Furthermore, in an email dated October 1, 2019, Registrant's counsel responded to Petitioner's request for a 60-day extension claiming he had asked his client regarding an extension but that "there have already been so many delays in this matter." See Exhibit A. In response, Registrant's counsel immediately clarified: "we note that there have been no delays in the pending cancellation proceeding despite your comment about "so many delays in this

by the non-movant, and that are not otherwise supported by the record, will not constitute a showing of good cause.”).

In a final effort to manufacture good cause, Petitioner would have the Board believe that, because the parties were engaged in settlement discussions, there was an “implied expectation by each party that the proceeding at hand would not move forward pending the negotiations.” See Petitioner’s Motion, p. 4. Such reasoning is wholly illogical and baseless. Needless to say, there are certain mechanisms (i.e., extension requests) available to parties to allow for settlement discussions without the pressure of deadlines. Deadlines do not just magically extend or disappear merely because parties are engaged in settlement negotiations. While Registrant does not deny that settlement discussions took place, it is inappropriate to suggest that those discussions in any way substantiate or support a finding of good cause for an extension of time. Fairline Boats plc v. New Howmar Boats Corp., 59 U.S.P.Q.2d 1479, 1480 (T.T.A.B. 2000) (mere existence of settlement negotiations or proposals, without more, would not justify delay in proceeding with testimony). Ultimately, the alleged settlement discussions do not provide the requisite good case for Petitioner’s motion to extend time. Petitioner’s motion is simply a strategic tactic to drag out the cancellation and increase the amount of

matter”. In fact, neither party has extended any deadlines or requested a suspension of proceedings.” Id.

money Registrant must spend on this proceeding with no legitimate benefit to either party.

In summary, Petitioner has not shown the good cause necessary to grant its motion to extend time. Accordingly, Petitioner's motion should be denied by the Trademark Trial and Appeal Board.

III. CONCLUSION

For the foregoing reasons, Chubb INA Holdings Inc., respectfully requests that the Trademark Trial and Appeal Board deny Petitioner's Motion to Extend the Deadlines.

BLANK ROME LLP

Dated: January 11, 2020

By: /Matthew A. Homyk/
Timothy D. Pecsénye
Matthew A. Homyk
One Logan Square
Philadelphia, PA 19103
(215) 569-5500

Attorneys for Registrant,
Chubb INA Holdings Inc.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is addressed to Hon. Commissioner for Trademarks, Attention: Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia 22314-1451, and is being deposited the Electronic System for Trademark Trial and Appeals (ESTTA) on January 11, 2020.

 /Matthew A. Homyk/
Matthew A. Homyk

CERTIFICATE OF SERVICE

I hereby certify that on January 11, 2020, I caused a copy of the foregoing Registrant's Response to Petitioner's Motion to Extend Deadlines to be served by email mail on:

David Ludwig
Hyung Gyu Sun
Dunlap Bennett & Ludwig PLLC
211 Church Street, SE
Leesburg, VA 20175
Tel.: (703) 777-7319
Fax.: (703) 777-3656
<hsun@dbllawyers.com>
<dludwig@dbllawyers.com>

/Matthew A. Homyk/
MATTHEW A. HOMYK

EXHIBIT A

Homyk, Matthew A.

From: David Ludwig <dludwig@dbllawyers.com>
Sent: Tuesday, December 17, 2019 5:14 PM
To: Homyk, Matthew A.
Cc: Litigation Paralegals; Hyung Gyu Sun; Pecsénye, Timothy
Subject: RE: AWP USA INC. v. CHUBB INA HOLDINGS INC., Petition for Cancellation Proceeding No. 92070407

Matt,
AWP is interested in exploring the 60-day suspension previously proposed.

Best regards,
David Ludwig – Partner
DUNLAP BENNETT & LUDWIG
T: +1 703-777-7319 D: +1 571-252-3310

From: Homyk, Matthew A. <MHomyk@BlankRome.com>
Sent: Wednesday, October 9, 2019 4:22 PM
To: David Ludwig <dludwig@dbllawyers.com>
Cc: Litigation Paralegals <litigation@dbllawyers.com>; Hyung Gyu Sun <hsun@dbllawyers.com>; Pecsénye, Timothy <Pecsénye@BlankRome.com>
Subject: RE: AWP USA INC. v. CHUBB INA HOLDINGS INC., Petition for Cancellation Proceeding No. 92070407

Subject to FRE 408

Hi, David –

Have you heard back from your client regarding the possible 60-day suspension of the U.S. cancellation proceeding

Also, not that it should necessarily change your client's position, but we note that there have been no delays in the pending cancellation proceeding despite your comment about "so many delays in this matter". In fact, neither party has extended any deadlines or requested a suspension of proceedings. So it might be worth reminding your client of this fact when seeking its instructions regarding the proposal above.

Regards,
Matt

Matthew A. Homyk | BLANKROME
One Logan Square | 130 North 18th Street | Philadelphia, PA 19103
O: 215.569.5360 | F: 215.832.5360 | mhomyk@blankrome.com

From: David Ludwig <dludwig@dbllawyers.com>
Sent: Tuesday, October 1, 2019 12:09 PM

To: Homyk, Matthew A. <MHomyk@BlankRome.com>

Cc: Litigation Paralegals <litigation@dbllawyers.com>; Hyung Gyu Sun <hsun@dbllawyers.com>; Pecsénye, Timothy <Pecsénye@BlankRome.com>

Subject: RE: AWP USA INC. v. CHUBB INA HOLDINGS INC., Petition for Cancellation Proceeding No. 92070407

Thanks, Matt.

Per your other email, I am waiting to hear back from my client on suspension, but as there have already been so many delays in this matter, I do not have high hopes.

Best regards,

David Ludwig – Partner

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Homyk, Matthew A.

From: Homyk, Matthew A.
Sent: Monday, September 30, 2019 4:12 PM
To: David Ludwig
Cc: Pecsenev, Timothy; Trademarks: Hyung Gyu Sun; Litigation Paralegals
Subject: RE: Cancellation against CHUBB TRAVEL SMART U.S. Trademark Registration

Attachments:

Importance: High

Subject to FRE 408

Dear David,

Following up on the discussions between the parties in July and August, it seems like a reasonable idea to suspend the U.S. cancellation proceeding

suspending the cancellation proceeding for 60 days

. Would your client be open to

Please let us know what you think.

Sincerely yours,
Matt

Matthew A. Homyk | BLANKROME

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