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

Proceeding	92072649
Party	Plaintiff Air Skate & Air Jump Corp.
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Attachments	Motion to Reopen Discovery.pdf(89089 bytes) Paradise Decl.pdf(49511 bytes)

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

Air Skate & Air Jump Corp.,	:	
Petitioner,	:	Registration No. 3579672
v.	:	
	:	Cancellation No. 92072649
Columbia Insurance Company,	:	
Respondent.	:	
	x	

MOTION TO REOPEN DISCOVERY

Petitioner, Air Skate & Air Jump Corp. (″Petitioner″), through its undersigned attorneys, hereby moves for an Order to reopen time for discovery in this Cancellation proceeding for an additional period of sixty (60) days, as Petitioner's failure to act during the time previously allotted was the result of excusable neglect. *See* Fed. R. Civ. P. 6(b)(1)(B).

PETITIONER'S FAILURE TO ACT DURING THE TIME PREVIOUSLY ALLOTTED WAS THE RESULT OF EXCUSABLE NEGLECT

Pursuant to the Notice and Trial Dates set by the Trademark Trial and Appeal Board on November 2, 2019, discovery opened on January 11, 2020, and closed on July 9, 2020. As of the present, no discovery has been taken by either party. Petitioner's failure to act during the time previously allotted was the result of excusable neglect. *See* Fed. R. Civ. P. 6(b)(1)(B), and as such Petitioner requests that the period for discovery be reopened. Under the Supreme Court's precedent in *Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507 U.S. 380 (1993), which was adopted by the Trademark Trial and Appeal Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), a determination of excusable neglect must take into

account all relevant circumstances surrounding the party's delay, including (1) the danger of prejudice to the nonmovant; (2) the length of the delay and its potential impact on judicial proceedings; (3) the reason for the delay, including whether it was within the reasonable control of the movant; and (4) whether the movant acted in good faith.

1. THERE IS NO DANGER OF PREJUDICE TO THE NONMOVANT

Under the first *Pioneer* factor, the "prejudice to the nonmovant" contemplated must be more than mere inconvenience and delay or the loss of any tactical advantage the nonmovant would have enjoyed as a result of the delay. Rather, the prejudice contemplated is prejudice to the nonmovant's ability to litigate the case, such as where the delay results in a loss or unavailability of evidence or witnesses that otherwise would have been available if not for the delay. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1587 (TTAB 1997) (citing *Pratt v. Philbrook*, 109 F.3d 18 (1st Cir. 1997)); *Paolo's Associates L.P. v. Bodo*, 21 USPQ2d 1899, 1904 (Comm'r 1990).

Here, the nonmovant, Columbia Insurance Company ("Columbia"), will experience no prejudice in the delay of the proceeding as their mark will continue to be registered unless and until the proceeding concludes in a favorable outcome for Petitioner. Further, there is no evidence that any delay will impair Columbia's ability to litigate the case. In fact, Columbia is the party in possession of any relevant evidence and reopening discovery will aid in litigation.

2. THE LENGTH OF THE DELAY

As previously stated, Pursuant to the Notice and Trial Dates set by the Trademark Trial and Appeal Board on November 2, 2019, discovery opened on January 11, 2020, and closed on

July 9, 2020. As of the present, no discovery has been taken by either party. The delay, in light of the circumstances under the COVID-19 pandemic (discussed in more detail below), is not excessive, and thus should not preclude the reopening of discovery.

3. PETITIONER'S DELAY WAS DUE TO CIRCUMSTANCES RESULTING FROM THE COVID-19 PANDEMIC

It has been established that the third *Pioneer* factor, the reason for the delay, may be deemed the most important factor in a determination of whether the movant's neglect is excusable. In accordance with section 12004 of the Coronavirus Aid, Relief and Economic Security Act (CARES Act), the United States Patent and Trademark Office (USPTO) provided that extensions could be obtained if circumstances materially interfered with timely actions during a proceeding. Specifically, on April 6, 2020, the USPTO stated that:

> A delay in filing or payment is due to the COVID-19 outbreak for the purposes of this notice if a practitioner, Petitioner, registrant, or other person associated with the filing or fee was personally affected by the COVID-19 outbreak, including, without limitations, through office closures, cash flow interruptions, inaccessibility of files or other materials, travel delays, personal or family illness, or similar circumstances, such that the outbreak materially interfered with timely filing or payment.

Here, Petitioner, a business involved in the merchandising of footwear, was unable to gain access to Petitioner's place of business during the shut-down of non-essential businesses, and continues to experience significant difficulties in connection with its New York City Office. *See* Exhibit A, Declaration of Gregg A. Paradise, at ¶3. Thus, files were inaccessible during that

time, and communication with counsel was impaired. *Id.* at ¶ 4. Additionally, Petitioner was not confident that the business would survive the economic strain caused by the pandemic, and was hesitant to incur costs associated with the instant proceeding. *Id.* ¶ at 5. As such, there was good cause for the delay as the surrounding circumstances were not within the reasonable control of the movant.

4. PETITIONER HAS ACTED IN GOOD FAITH AS NONMOVANT PREVIOUSLY GAVE ASSURANCES THAT DISCOVERY WOULD BE PROVIDED AND NONMOVANT HAS NOT RESPONDED TO PETITIONER'S REQUESTS FOR CONSENT TO REOPEN DISCOVERY

Prior to the shut-down due to the pandemic, the parties engaged in multiple settlement discussions. During said discussions, Columbia assured Petitioner that evidence of continued use of Columbia's mark in commerce would be supplied. Petitioner continued such efforts, unsuccessfully, over the last month. Petitioner acted in reliance on Columbia's representations by waiting for the evidence to be provided informally, in the hope of saving both parties unnecessary expenses. Such evidence was never provided. *Id.* at ¶ ¶6-7.

Additionally, Petitioner has attempted to obtain consent from Respondent to reopen discovery. However, Respondent has failed to respond to Petitioner's requests on this subject. Id. at ¶8.

CONCLUSION

Petitioner's failure to act during the time previously allotted was the result of excusable neglect as (1) there is no danger of prejudice to the nonmovant, Columbia Insurance Company; (2) discovery only concluded in July of 2020; (3) the reason for the delay was not within Petitioner's control, as Petitioner experienced difficulties due to the COVID-19 pandemic; and

(4) Petitioner has acted in good faith by relying on the nonmovant's representations that discovery would be provided and by attempting to obtain consent to reopen discovery.

Thus, in light of the foregoing, Petitioner respectfully requests an Order reopening time for discovery in this Cancellation proceeding, allowing for an additional 60 days of discovery, and setting all other dates in the proceeding accordingly.

Respectfully submitted,

Air Skate & Air Jump Corp.

Dated: October 7, 2020

By: /Gregg A. Paradise/

Gregg A. Paradise
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Attorneys for Petitioner
Air Skate & Air Jump Corp.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing ″MOTION TO REOPEN DISCOVERY″ was served on Opposer's attorney, Tom Gulick, via e-mail at tgulick@ipattornrysgroup.com (through prior agreement of counsel) on October 7, 2020.

VIA E-MAIL
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/Gregg A. Paradise/
Gregg A. Paradise

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

Air Skate & Air Jump Corp.,	:	
	:	
Petitioner,	:	Registration No. 3579672
	:	
v.	:	
	:	Cancellation No. 92072649
Columbia Insurance Company,	:	
	:	
Respondent.	x	

DECLARATION OF GREGG A. PARADISE IN
SUPPORT OF PETITIONER'S MOTION TO REOPEN DISCOVERY

I, GREGG A. PARADISE, declare under penalty of perjury that the following is true and correct to the best of my knowledge.

1. I am a member of the firm of Lerner, David, Littenberg, Krumholz & Mentlik, LLP ("Lerner David"), and I am one of the attorneys of record for Petitioner Air Skate & Air Jump Corp. ("Petitioner") in the above-captioned matter.

2. I make this declaration on my own information, knowledge, and belief in support of Petitioner's Motion to Reopen Discovery.

3. Petitioner is a business involved in the merchandising of footwear. During the government shut-down due to the COVID-19 pandemic, Petitioner's business, which was non-essential, was closed. As a result, Petitioner was unable to gain access to Petitioner's place of business and continues to experience significant difficulties in connection with its New York City Office.

4. Due to Petitioner's inability to access its business during the shut-down, files were inaccessible during that time, and communication with counsel was impaired.

5. Due to the economic strain as a result of the pandemic, Petitioner was not confident that the business would survive, and was hesitant to incur any costs associated with the instant proceeding.

6. Prior to the shut-down due to the pandemic, I engaged in multiple settlement discussions with counsel for Respondent, during which he made representations that he would supply evidence of continued use of Respondent's mark in commerce. I continued such efforts, unsuccessfully, over the last month.

7. I acted in reliance on Respondent's representations by waiting for the evidence to be provided informally, in hopes of saving both parties unnecessary expenses. Such evidence was never provided.

8. I have also attempted to obtain consent from Respondent to reopen discovery, both by email and telephone. However, Respondent has failed to respond to my requests on this subject.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on: 10/7/2020

Gregg A. Paradise