

ESTTA Tracking number: **ESTTA1071505**

Filing date: **07/29/2020**

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

Proceeding	92072817
Party	Plaintiff Working Concepts, Inc.
Correspondence Address	KURT ROHLFS CHERNOFF VILHAUER LLP 111 SW COLUMBIA STREET, SUITE 725 PORTLAND, OR 97201 UNITED STATES Primary Email: kar.docket@chernofflaw.com 503-227-5631
Submission	Motion for Default Judgment
Filer's Name	Susan D. Pitchford
Filer's email	sdp.docket@chernofflaw.com, phung@chernofflaw.com, yfide@chernofflaw.com
Signature	/Susan D. Pitchford/
Date	07/29/2020
Attachments	Motion for Default.pdf(1727789 bytes )

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

In the Matter of Trademark Application Serial No. 4,499,800

Mark: SUPER-SOFT KNEE PADS

Filed: August 14, 2013

Registered: March 18, 2014

WORKING CONCEPTS, INC.,

Petitioner,

v.

SOUTHLAND TILE TOOLS & ACCESSORIES,  
INC. DBA TROXELL USA,

Registrant.

Cancellation No. 92072817

**PETITIONER'S MOTION FOR DEFAULT**

Pursuant to Federal Rule of Civil Procedure 55 and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 312.01, Petitioner Working Concepts, Inc. ("Working Concepts") hereby moves for an Order of Default be entered against Registrant Southland Tile Tools & Accessories, Inc. dba Troxell USA's ("Registrant"), or in the alternative, that the Board reset the deadline for the Parties' discovery obligations.

## **I. INTRODUCTION**

On November 22, 2019, Petitioner filed a Petition for Cancellation against Registrant's mark U.S. Reg. No. 4,499,800 for SUPER-SOFT KNEE PADS, alleging a likelihood of confusion between Registrant's mark and its mark SOFT KNEES, U.S. Reg. No. 2,454,396. On February 27, 2020, Registrant filed a motion to dismiss, to which the Board denied on March 11, 2020. In doing so, the Board did not reset the pending deadlines.

Subsequent to the Board's Order, Petitioner reached out to Registrant's counsel to schedule a Rule 26(f) conference (Ex. A). Petitioner's attempt to schedule a discovery conference has not been successful. Petitioner served its initial disclosures on March 31, 2020. In May, Registrant's counsel advised it was no longer representing Registrant (Ex. B).

To this date, Petitioner has not heard from new counsel. Neither former nor current counsel have filed an Answer to the Petition nor served initial disclosures on behalf of Registrant. There has not been a discovery conference.

## **II. The Board Should Enter a Default Against the Registrant.**

The Board may issue a Notice of Default pursuant to 37 CFR 2.106(a) if no answer is filed by the Registrant. Here, Registrant filed a motion to dismiss several months ago, but since that motion was denied, Registrant has given no indication that it intends to appear in the action or otherwise defend against the allegations of the Petition.

**III. Alternatively, the Board Should Reset the Discovery Deadlines when a Motion to Dismiss is Filed.**

In the alternative, given the Registrant's default on multiple discovery deadlines, Petitioner requests that the Board reset the pending deadlines, pursuant to TBMP 401.01 on Discovery Conferences, where the relevant portion provides:

The conference should take place once the pleadings have closed and by the deadline set forth in the Board's institution order (or by any extended deadline approved by the Board), and must take place no later than the opening of the discovery period. In instances, however, where the defendant is in default, or a **pleading motion under Fed. R. Civ. P. 12 has been filed**, or a counterclaim has been filed, **the parties' obligation to have a discovery conference is tolled or effectively stayed**. The rationale is that an answer must be filed to all claims and counterclaims, and issues related to the pleadings resolved before the parties can have a meaningful discovery conference. In such cases, **the Board will reset the deadline for the discovery conference as well as all subsequent dates, upon resolution of the default or Fed. R. Civ. P. 12 motion**, or acknowledgement of the counterclaim, which may include setting or resetting the deadline for filing an answer.

**IV. CONCLUSION**

For the foregoing reasons, Working Concepts respectfully requests that the Board enter an Order of Default against Registrant, or alternatively, reset the pending deadlines in the instant case, including the deadlines for expert disclosures and discovery.

Dated: July 29, 2020

Respectfully submitted,

By /Susan D. Pitchford/  
Susan D. Pitchford  
sdp@chernofflaw.com  
Chernoff Vilhauer LLP  
111 SW Columbia Street, Suite 725  
Portland, OR 97201  
Tel: (503) 227-5631  
Attorney for Petitioner

## PROOF OF SERVICE

The undersigned hereby certifies that a copy of this filing has been served upon Registrant's counsel, at their address of record by email as below:

Kirk Buhler  
Buhler & Associates Patenting  
[buhlerassoc@aol.com](mailto:buhlerassoc@aol.com)  
(951) 735-4001

Dated: July 29, 2020

By           /Susan D. Pitchford/            
Susan D. Pitchford  
sdp@chernofflaw.com  
Chernoff Vilhauer LLP  
111 SW Columbia Street, Suite 725  
Portland, OR 97201  
Tel: (503) 227-5631  
Attorney for Petitioner

# EXHIBIT A

**From:** [Susan Pitchford](#)  
**To:** [James O'Neill](#)  
**Cc:** [Yvonne Fide](#)  
**Subject:** Re: Cancellation of South Tile Tools & Accessories, Inc. (DBA Troxell) Reg. No. 4499800 for SUPER-SOFT KNEE PADS  
**Date:** Wednesday, March 18, 2020 8:16:37 PM

---

Received with thanks. I look forward to connecting when you are back in the office or the Board so indicates. Be well.  
Susan

On Mar 18, 2020, at 6:37 PM, James O'Neill <[JamesO'Neill@koslaw.com](mailto:JamesO'Neill@koslaw.com)> wrote:

Susan:  
Because of my age and health concerns I'm required to shelter-in-place for 2 weeks, at home.  
Additionally, my client's business is closed down for the same time period, unless extended. I will get back to you when I am back in the office.  
James

Sent from my iPad

On Mar 18, 2020, at 11:20 AM, Susan Pitchford <[sdp@chernofflaw.com](mailto:sdp@chernofflaw.com)> wrote:

Thank you!

---

**From:** Denise Cheung <[DeniseCheung@koslaw.com](mailto:DeniseCheung@koslaw.com)>  
**Sent:** Wednesday, March 18, 2020 10:51 AM  
**To:** Susan Pitchford <[sdp@chernofflaw.com](mailto:sdp@chernofflaw.com)>; James O'Neill <[JamesO'Neill@koslaw.com](mailto:JamesO'Neill@koslaw.com)>  
**Cc:** Yvonne Fide <[YFide@chernofflaw.com](mailto:YFide@chernofflaw.com)>; Phoebe C. Hung <[PHung@chernofflaw.com](mailto:PHung@chernofflaw.com)>  
**Subject:** RE: Cancellation of South Tile Tools & Accessories, Inc. (DBA Troxell) Reg. No. 4499800 for SUPER-SOFT KNEE PADS

Forwarding to James O'Neill's correct email address.

Jim,

Please see email from Ms. Pitchford below.

Best regards,

Denise C. Cheung



Intellectual Property Assistant  
Klein, O'Neill & Singh, LLP  
16755 Von Karman Ave, Suite 275  
Irvine, CA 92606  
Tel: 949-955-1920  
Fax: 949-955-1921

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**From:** Susan Pitchford [<mailto:sdp@chernofflaw.com>]  
**Sent:** Wednesday, March 18, 2020 10:47 AM  
**To:** [joneill@koslaw.ocm](mailto:joneill@koslaw.ocm); Info Koslaw <[Info@koslaw.com](mailto:Info@koslaw.com)>; Denise Cheung <[DeniseCheung@koslaw.com](mailto:DeniseCheung@koslaw.com)>  
**Cc:** Yvonne Fide <[YFide@chernofflaw.com](mailto:YFide@chernofflaw.com)>; Phoebe C. Hung <[PHung@chernofflaw.com](mailto:PHung@chernofflaw.com)>  
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Dear Mr. O'Neill,

Following the Board's denial of the Motion to Dismiss, we need to have a discovery conference. The dates in this matter do not appear to be reset. Please let me know your availability for a discovery conference in the next week (March 18 – March 25).

Thank you,

Susan

Susan D. Pitchford

<image001.png>

Tel: 503-227-5631 Fax: 503-228-4373

111 SW Columbia Street, Ste. 725, Portland, OR 97201 USA

Email: [sdp@chernofflaw.com](mailto:sdp@chernofflaw.com)

<[image002.jpg](#)> <[image003.gif](#)> <[image004.gif](#)> <[image005.gif](#)>

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**From:** Susan Pitchford <[sdp@chernofflaw.com](mailto:sdp@chernofflaw.com)>  
**Sent:** Wednesday, February 26, 2020 10:53 AM  
**To:** [joneill@koslaw.ocm](mailto:joneill@koslaw.ocm); [info@koslaw.com](mailto:info@koslaw.com)  
**Cc:** Yvonne Fide <[YFide@chernofflaw.com](mailto:YFide@chernofflaw.com)>

**Subject:** Cancellation of South Tile Tools & Accessories, Inc. (DBA Troxell) Reg. No. 4499800 for SUPER-SOFT KNEE PADS

Dear Mr. O'Neill,

As you know, our office represents Working Concepts, Inc., who has petitioned to cancel your client's SUPER-SOFT KNEE PADS mark. The schedule in this matter requires us to have a discovery conference by March 1, 2020, which falls on a Sunday. Would you be so kind as to provide me with your availability for a call prior to this date? I have good availability today through Friday.

Thank you,  
Susan

Susan D. Pitchford  
<image001.png>  
Tel: 503-227-5631 Fax: 503-228-4373  
111 SW Columbia Street, Ste. 725, Portland, OR 97201 USA  
Email: [sdp@chernofflaw.com](mailto:sdp@chernofflaw.com)

[<image006.jpg>](#) [<image003.gif>](#) [<image004.gif>](#) [<image005.gif>](#)

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# EXHIBIT B

## Yvonne Fide

---

**From:** Susan Pitchford  
**Sent:** Thursday, May 21, 2020 3:02 PM  
**To:** Phoebe C. Hung; Yvonne Fide  
**Subject:** FW: Cancellation of South Tile Tools & Accessories, Inc. (DBA Troxell) Reg. No. 4499800 for SUPER-SOFT KNEE PADS

---

**From:** Susan Pitchford  
**Sent:** Thursday, May 21, 2020 3:01 PM  
**To:** 'James O'Neill' <JamesO'Neill@koslaw.com>  
**Subject:** RE: Cancellation of South Tile Tools & Accessories, Inc. (DBA Troxell) Reg. No. 4499800 for SUPER-SOFT KNEE PADS

James,

I had not been contacted. Thank you for letting me know. Do you have contact information for new counsel by chance, or are they self-represented now?

Thank you - Susan  
Susan D. Pitchford



Tel: 503-227-5631 Fax: 503-228-4373  
111 SW Columbia Street, Ste. 725, Portland, OR 97201 USA  
Email: [sdp@chernofflaw.com](mailto:sdp@chernofflaw.com)



In response to the COVID-19 outbreak, our office is only working remotely until further notice. You can still contact us via the phone number above and email. Please let us know of any adjustments necessary to accommodate your office's policies. Be well.

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**From:** James O'Neill <JamesO'Neill@koslaw.com>  
**Sent:** Thursday, May 21, 2020 2:50 PM  
**To:** Susan Pitchford <[sdp@chernofflaw.com](mailto:sdp@chernofflaw.com)>  
**Subject:** RE: Cancellation of South Tile Tools & Accessories, Inc. (DBA Troxell) Reg. No. 4499800 for SUPER-SOFT KNEE PADS

Susan:

In case you have not yet been contacted, this is to advise you that Klein, O'Neill & Singh and I are no longer representing Southland Tool and/or Ron Troxell in this matter.

James O'Neill

---

**From:** Susan Pitchford <[sdp@chernofflaw.com](mailto:sdp@chernofflaw.com)>

**Sent:** Wednesday, March 18, 2020 8:17 PM

**To:** James O'Neill <[JamesO'Neill@koslaw.com](mailto:JamesO'Neill@koslaw.com)>

**Cc:** Yvonne Fide <[YFide@chernofflaw.com](mailto:YFide@chernofflaw.com)>

**Subject:** Re: Cancellation of South Tile Tools & Accessories, Inc. (DBA Troxell) Reg. No. 4499800 for SUPER-SOFT KNEE PADS

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Forwarding to James O'Neill's correct email address.

Jim,

Please see email from Ms. Pitchford below.

Best regards,

Denise C. Cheung  
Intellectual Property Assistant  
Klein, O'Neill & Singh, LLP  
16755 Von Karman Ave, Suite 275

Irvine, CA 92606  
Tel: 949-955-1920  
Fax: 949-955-1921

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**Cc:** Yvonne Fide <[YFide@chernofflaw.com](mailto:YFide@chernofflaw.com)>  
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