

ESTTA Tracking number: **ESTTA1127815**

Filing date: **04/19/2021**

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

Proceeding	92075974
Party	Plaintiff AH License ApS
Correspondence Address	KATHERINE A. MARKERT BARCLAY DAMON LLP 100 CHESTNUT ST. 2000 FIVE STAR BANK PLAZA ROCHESTER, NY 14604 UNITED STATES Primary Email: ip@barclaydamon.com Secondary Email(s): kmarkert@barclaydamon.com, ecomin- olli@barclaydamon.com 585-295-4433
Submission	Opposition/Response to Motion
Filer's Name	Katherine A. Markert
Filer's email	ip@barclaydamon.com, kmarkert@barclaydamon.com
Signature	/Katherine A. Markert/
Date	04/19/2021
Attachments	Petitioners Resp to Registrants Mot for Ext of Time.pdf(31356 bytes) Ex. A - Petitioner's Response.pdf(253530 bytes)

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

REGISTRATION NO.: 4915973
REGISTERED: MARCH 15, 2016
MARK: BIBI

AH LICENSE APS	PETITIONER,	CANCELLATION No. 92075974
v.		
MEDELA HOLDING AG	RESPONDENT.	

PETITIONER'S RESPONSE TO RESPONDENT'S MOTION FOR EXTENSION OF TIME TO
RESPOND TO PETITIONER'S FIRST SET OF DISCOVERY REQUESTS

On March 4, 2021, AH License ApS ("Petitioner") served Medela Holding AG ("Respondent") with: (1) Petitioner's First Set of Requests for Production of Documents to Registrant; (2) Petitioner's First Set of Interrogatories to Registrant; and (3) Petitioner's First Set of Requests for Admission to Registrant (collectively, "Petitioner's First Discovery Requests"). Pursuant to Federal Rules and Regulations, Respondent's responses to Petitioner's First Discovery Requests were due 30 days from the date of service, or April 3, 2021. Fed. R. Civ. P. 33(b)(2), 34(b)(2)(A), 36(a)(3); 37 C.F.R. § 2.120(a)(3).

On March 31, 2021, Respondent filed its Motion requesting the Board grant a 60-day extension of time for Respondent to respond to Petitioner's First Set of Discovery Requests ("Respondent's Motion"). Petitioner has twenty (20) days to respond to Respondent's Motion, or until April 20, 2021, and therefore this Response is timely. 37 C.F.R. § 2.127(a).

In Respondent's Motion, Respondent raises several arguments in support of its request for an extension which are unpersuasive and do not rise to the standard required for obtaining its extension request. However, in light of Respondent's attorney's illness, of which Petitioner was

wholly unaware until Respondent's Motion was filed, Petitioner hereby consents to Respondent's request for a 60-day extension.

I. Applicable Legal Standard

The time to respond to written discovery requests may be extended upon stipulation of the parties or by the granting of a motion by the Board. 37 C.F.R. 2.120(a)(3). The applicable standard for granting such a request is "good cause." See 37 C.F.R. § 2.116(a); Fed. R. Civ. P. 6(b)(1)(A). "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 not sufficient." TBMP § 509.1(a), citing *SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372 (TTAB 2001).

II. Petitioner's Responses to Respondent's Arguments

Although Petitioner consents to Respondent's 60-day extension request, Petitioner will take this opportunity to briefly address Respondent's arguments.

a. **"Work From Home" Restrictions in Switzerland**

Respondent's Motion cited Swiss "work from home" requirements as a cause for necessitating an extension of 60-days' time to respond to Petitioner's First Set of Discovery Requests. In support of this contention, Respondent's Motion includes an Exhibit A that purportedly outlines the Swiss government's position that work must be conducted from home where it is "feasible."¹ Although Respondent may be domiciled in Switzerland, Respondent does not explain with sufficient particularity how this government policy has, in fact, impaired Respondent's ability to comply with Petitioner's First Set of Discovery Requests. Nor does Respondent allege that its employees are even working from home or that they are unable to

¹ Exhibit A to Respondent's Motion purportedly cites to Swiss government work-from-home rules. Notably, the exhibit is dated January 13, 2021 and discusses extensions of those rules through February 2021. Therefore, at the time Respondent's Motion was filed on March 31, 2021, the cited restrictions were no longer in effect, nor were they in effect when Respondent was served with Petitioner's First Set of Discovery Requests on March 4, 2021.

remotely access documents responsive to Petitioner’s First Set of Discovery Responses apart from certain “key” files and documents.

Moreover, Petitioner and Respondent are engaged in a multi-jurisdictional dispute over the use of their respective trademarks and there is no reason to believe Respondent is unable to comply with its discovery duties in the U.S. while it is actively engaged in related litigation in other jurisdictions.

Lastly, it is undeniable that COVID-19 has caused disruption all over the world. However, as we enter our second year of the global pandemic, we cannot continue to use it as a blanket excuse for our difficulties without further explanation. The world has learned to adapt, as it must, and COVID-19-related challenges must be spelled out in greater detail if they are to be relied upon as grounds for relief in legal disputes. The argument in Respondent’s Motion regarding Swiss work from home rules fails to set forth the required factual particularity to establish good cause for the requested extension.

b. Respondent Not “Familiar” with U.S. Discovery

As further justification for its extension request, Respondent states that its employees “are not very familiar with the discovery process involved in US *inter partes* actions before the USPTO.” Respondent’s Mot. at 2. This does not represent “good cause” for requesting an extension for responding to discovery. A party before the Board has a duty to abide by its rules and procedures notwithstanding that party’s familiarity with them. By registering the BIBI mark in the U.S. (Reg. 4,915,973), Respondent availed itself to applicable U.S. law and consented to the Board’s authority. 15 U.S.C. § 1067 (the Board has authority over cancellation proceedings).

To aid Respondent’s understanding of its obligations under U.S. law, it is not only incumbent upon Respondent to obtain U.S. counsel, but it required of Respondent as a non-U.S.

entity appearing as a party to a Board proceeding. *See* 37 C.F.R. § 2.11(a). Respondent is a sophisticated business operating in many jurisdictions and has retained U.S. counsel with specialized knowledge in Board proceedings. Respondent does not warrant special treatment to meet its legal obligations in a timely fashion. Accordingly, whether or not Respondent is “unfamiliar” with the discovery process cannot serve as “good cause” for extending its discovery response deadline.

c. Petitioner’s First Discovery Requests served “early”

Respondent points to Petitioner’s “early” service of Petitioner’s First Discovery Requests as a reason warranting the extension request. Pursuant to the Board’s Scheduling Order (Dkt 2), discovery opened on February 24, 2021, and, on March 4, 2021 Petitioner served its Initial Disclosures together with Petitioner’s First Discovery Requests. Petitioner’s action was not “early”; the action was timely. Respondent’s argument disregards the information counsel exchanged during the discovery conference, which was summarized in Petitioner’s counsel’s February 23, 2021 email and not contested by Respondent’s counsel. Exhibit A. Petitioner’s counsel consistently advised that it intended to move forward with the discovery process in a prompt fashion, especially since Respondent’s U.S. counsel is not authorized to discuss settlement of the U.S. matter. In any event, Petitioner should not be faulted for taking prompt action to move forward with prosecution of this action, particularly, where such action was consistent with representations made during the discovery conference. As such, Petitioner disagrees that the so-called “early” service of discovery creates an entitlement to extension or constitutes good cause.

d. Respondent’s Attorney’s Health

Petitioner regrets the health-related concerns affecting Respondent’s counsel and gladly consents to Respondent’s Motion on this ground alone. In fact, Petitioner would have granted

Respondent's extension without its Motion, had Petitioner been made aware of this fact earlier. Accordingly, Petitioner believes it is appropriate to provide some context as to why it is agreeing to an extension now while having recently not agreed to a similar request.

On March 31, 2021 at 7:53 am EST, Respondent's attorney emailed Petitioner's attorney requesting an extension to Respondent's deadline to respond to Petitioner's First Set of Discovery Requests. *See Exhibit A.* In this email, Respondent's attorney asserted the following grounds for an extension: (1) Respondent's "physical offices" were closed due to Swiss law; (2) Respondent was having difficulties accessing "old files" stored in its office; and (3) the response deadline fell on a public holiday in Switzerland. In light of these reasons, Respondent requested a 30-day extension to its deadline to respond to Petitioner's First Set of Discovery Requests. Notably, Respondent's attorney did not disclose any health conditions that may warrant the requested extension.

After declining the extension request, Respondent's Motion was filed later that same day. It was only at that time that Petitioner learned of Respondent's Attorney's health condition. It remains unclear whether one of Respondent's Attorney's colleagues may be able to assist with the matter should it become necessary. However, in light of this new information, Petitioner agrees to Respondent's requested, longer, 60-day extension.

Dated: April 19, 2021

BARCLAY DAMON LLP

/s/ Katherine A. Markert
Elizabeth A. Cominoli, Esq.
Katherine A. Markert, Esq.
Jeffrey M. Koegel, Esq.
Barclay Damon LLP
100 Chestnut Street
2000 Five Star Bank Plaza
Rochester, NY 14604
Tel.: (585) 295-4400
ecomonoli@barclaydamon.com
kmarkert@barclaydamon.com
jkoegel@barclaydamon.com

*Attorneys for Applicant,
AH License ApS*

CERTIFICATE OF SERVICE

I hereby certify that, on April 19, 2021, a true and complete copy of the foregoing Petitioner's Response to Respondent's Motion for Extension of Time to Respond to Petitioner's First Set of Discovery Requests has been served on:

James R. Menker
Holley & Menker, P.A.
PO Box 331937
Atlantic Beach, FL 32233

via email at the following addresses: eastdocket@holleymenker.com and jmenker@holleymenker.com.

/s/ Katherine A. Markert

Exhibit

A

Koegel, Jeffrey M.

From: Markert, Katherine A.
Sent: Wednesday, March 31, 2021 1:20 PM
To: jmenker@holleymenker.com
Cc: Cominolli, Elizabeth A.; Koegel, Jeffrey M.
Subject: RE: [Service of Initial Disclosures, Interrogatories, Document Demands & Requests for Admission] Cancellation Proceeding No. 92075974 | AH License ApS v. Medela Holding AG [IWOV-Active.FID2943521]

Jim,

Thank you for your email.

I would ordinarily agree to this type of extension request without hesitation and encourage my client to do so. However, this case does not appear to be one of ordinary circumstances. I've been advised that Medela's in-house counsel already asked for a request of the deadline in this US cancellation proceeding by directing its request to Danish counsel, and such request was declined. My client does not wish to change its response in view of your renewed request.

I preliminarily reviewed Medela's initial disclosures directing me to <https://www.bibi.ch>, which discloses that your client rebranded from BIBI to MEDELA BABY. Perhaps, if your client prefers to avoid the time and expense of responding to discovery demands, a suitable next step is for Medela to surrender its U.S. registration. Otherwise, I look forward to timely receiving responses to the interrogatories, document demands, and initial disclosures.

Best,
Katie

From: jmenker@holleymenker.com <jmenker@holleymenker.com>
Sent: Wednesday, March 31, 2021 7:53 AM
To: Markert, Katherine A. <KMarkert@barclaydamon.com>
Cc: Cominolli, Elizabeth A. <ECominolli@barclaydamon.com>; Koegel, Jeffrey M. <JKoegel@barclaydamon.com>
Subject: RE: [Service of Initial Disclosures, Interrogatories, Document Demands & Requests for Admission] Cancellation Proceeding No. 92075974 | AH License ApS v. Medela Holding AG [IWOV-Active.FID2943521]

Katherine,

I am writing to request your consent to a 30 day extension of the deadline for responding to the discovery requests served on March 4. We will of course reciprocate when you make a similar request. We will also consent to a 30 day extension of the cancellation dates should you find it necessary to complete discovery. I note that my client's physical offices are closed by Swiss law and thus my client has difficulties accessing its old files stored in the office. Moreover, the response deadline falls on a public holiday in Switzerland.

I look forward to hearing from you at your earliest convenience.

Best regards,

Jim

Holley & Menker, P.A.

Tel 571-278-3366

This e-mail and any attachments may contain information that is privileged and/or confidential. If you are not the intended recipient and appear to have received this e-mail in error, please notify us immediately and then delete all copies from your computer system. Any unauthorized use, copying or further distribution is prohibited.

From: Markert, Katherine A. <kmarkert@barclaydamon.com>

Sent: Thursday, March 4, 2021 1:35 PM

To: jmenker@holleymenker.com; eastdocket@holleymenker.com

Cc: ecominolli@barclaydamon.com; jkoegel@barclaydamon.com

Subject: [Service of Initial Disclosures, Interrogatories, Document Demands & Requests for Admission] Cancellation Proceeding No. 92075974 | AH License ApS v. Medela Holding AG [IWOV-Active.FID2943521]

Jim,

Attached for service in the referenced cancellation proceeding, please find the following documents.

1. AH License's Initial Disclosures;
2. AH License's First Set of Interrogatories to Registrant;
3. AH License's First Set of Requests for Production of Documents; and
4. AH License's First Set of Requests for Admission.

I am also producing a copy of the Marksmen Report identified in the Initial Disclosures.

Kindly reply confirming receipt of the five (5) attachments.

Best,
Katie

From: Markert, Katherine A. <kmarkert@barclaydamon.com>

Sent: Tuesday, February 23, 2021 11:42 AM

To: jmenker@holleymenker.com

Cc: jp@barclaydamon.com; ecominolli@barclaydamon.com

Subject: RE: [Request to Schedule Discovery Conference] Cancellation Proceeding No. 92075974 | AH Licensing ApS v. Medela Holding AG [IWOV-Active.FID2943521]

Hi Jim,

It was a pleasure speaking with you today. Following is a summary of the salient points of our discovery conference call. If I've misstated anything, please let me know.

1. Settlement – Medela did not authorize settlement discussions in the U.S. context in view of the global nature of the dispute.
2. Nature of Claims – We agreed that AHS License's non-use/abandonment claims are straightforward. We did not discuss your defenses in detail as they were asserted as standard defenses.
3. Discovery – We agreed to production of documents in PDF form via email. AHS License intends to serve interrogatories and document demands, and is yet undecided on depositions.

4. Suspension – Medela is interested in suspending the U.S. proceeding while matters continue to be worked on in other jurisdictions. I did not have authority to provide consent, but will discuss with my client and return to you if they are amenable to suspending.
5. ACR – We agreed not to pursue ACR at this time and are open to mutually exploring a consolidated/expedited proceeding to the extent the matter moves forward.

Best,
Katie

From: Markert, Katherine A.
Sent: Wednesday, February 17, 2021 2:56 PM
To: jmenker@holleymenker.com
Subject: RE: [Request to Schedule Discovery Conference] Cancellation Proceeding No. 92075974 | AH Licensing ApS v. Medela Holding AG [IWOV-Active.FID2943521]

Thanks, Jim. I will call you at 571-278-3366.

From: jmenker@holleymenker.com <jmenker@holleymenker.com>
Sent: Wednesday, February 17, 2021 2:23 PM
To: Markert, Katherine A. <KMarkert@barclaydamon.com>
Cc: Cominoli, Elizabeth A. <ECominoli@barclaydamon.com>; IP <IP@barclaydamon.com>
Subject: RE: [Request to Schedule Discovery Conference] Cancellation Proceeding No. 92075974 | AH Licensing ApS v. Medela Holding AG [IWOV-Active.FID2943521]

Hi Katie,

Tuesday, February 23, 2021 at 11:00 am works for me.

Regards,

Jim

Holley & Menker, P.A.

Tel 571-278-3366

This e-mail and any attachments may contain information that is privileged and/or confidential. If you are not the intended recipient and appear to have received this e-mail in error, please notify us immediately and then delete all copies from your computer system. Any unauthorized use, copying or further distribution is prohibited.

From: Markert, Katherine A. <kmarkert@barclaydamon.com>
Sent: Wednesday, February 17, 2021 1:41 PM
To: jmenker@holleymenker.com
Cc: ecominoli@barclaydamon.com; ip@barclaydamon.com; eastdocket@holleymenker.com
Subject: [Request to Schedule Discovery Conference] Cancellation Proceeding No. 92075974 | AH Licensing ApS v. Medela Holding AG [IWOV-Active.FID2943521]

Cancellation Proceeding No. 92075974
Petition to Cancel BIBI Registration

Dear James,

I am contacting you to schedule the discovery conference in the referenced cancellation proceeding.

Please let me know your availability the following days/times:

- Tuesday, February 23, 2021 between 11:00 am and 1:30 pm; or
- Wednesday, February 24, 2021 at 10:00 am, 1pm or 2:00 pm.

Best,
Katie

Katherine A. Markert

Counsel

2000 Five Star Bank Plaza • 100 Chestnut Street•Rochester,NY14604
D: (585) 295-4433•F: (585) 295-8457•C: (585) 456-4544
E: KMarkert@barclaydamon.com

www.barclaydamon.com • [vCard](#) • [Profile](#)

This electronic mail transmission is intended only for the use of the individual or entity to which it is addressed and may contain confidential information belonging to the sender which is protected by the attorney-client privilege. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution, or the taking of any action in reliance on the contents of this information is strictly prohibited. If you have received this transmission in error, please notify the sender immediately by e-mail and delete the original message.

From: jmenker@hollymenker.com <jmenker@hollymenker.com>

Sent: Monday, January 25, 2021 8:28 AM

To: IP <IP@barclaydamon.com>; Markert, Katherine A. <KMarkert@barclaydamon.com>; Cominolli, Elizabeth A. <ECominolli@barclaydamon.com>

Subject: 92075974

Dear Ms. Markert,

A service copy of Medela Holding AG's Answer to the Petition to Cancel is attached.

Regards,



James R. Menker
Shareholder

60 Ocean Boulevard, Suite 3 | Atlantic Beach, FL 32233
P: 571.278.3366 | jmenker@hollymenker.com
hollymenker.com



This e-mail and any attachments may contain information that is privileged and/or confidential. If you are not the intended recipient and appear to have received this e-mail in error, please notify us immediately and then delete all copies from your computer system. Any unauthorized use, copying or further distribution is prohibited.

This email has been checked for viruses by Avast antivirus software.

www.avast.com