

ESTTA Tracking number: **ESTTA1357428**Filing date: **05/08/2024**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	92081595
Party	Defendant Honest History Co.
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Attachments	Honest History Co.'s Request To Disregard Petitioner's Filings 4884-6 608-1212 v.2.pdf(158636 bytes)

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

Mercury One, Inc.,)	
)	
)	
v.)	Cancellation No. 92081595
)	
Honest History Co,)	
)	
Respondent)	
)	

**RESPONDENT HONEST HISTORY CO.’S REQUEST THAT THE BOARD
DISREGARD PETITIONER’S UNTIMELY FILINGS IN VIOLATION OF THE
SUSPENSION ORDER**

Respondent Honest History Co. (“Respondent” or “Honest History”) hereby submits the following request that the Board disregard Petitioner Mercury One’s (“Petitioner”) untimely and improper filings, including (1) Petitioner’s Motion for Summary Judgement (“SJ Motion”) and (2) Petitioner’s Pre-Trial Disclosures (“Disclosures”), which Petitioner filed in direct violation of the Notice of Suspension, until the Board issues a decision on Petitioner’s pending motion, lifts the suspension, and resets the deadlines in the case. *See Dkt. 14, 21, and 22.*

On March 25, 2024, the Interlocutory Attorney issued a Suspension Notice (“Notice”) suspending the current proceedings pending the disposition of Petitioner’s Motion to Declassify Six Deposition Transcripts From Attorney’s Eyes Only Highly Confidential Designation Under Protective Order (“Motion”). The Notice specifically states, “**Any paper filed during the pendency of this motion which is not relevant thereto will be given no consideration.**” *See Dkt. 14.* Petitioner’s SJ Motion and Disclosures are entirely irrelevant to the Motion. In addition to the Notice, the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) advises that “when a party files a motion to compel initial disclosures, expert disclosures or discovery, the

Board will issue an order suspending the proceeding with respect to all matters not germane to the motion, ***and no party should file any paper that is not germane to the discovery dispute, except as otherwise specified in the Board's suspension order.***” TBMP §510.03(a) (emphasis added). Petitioner’s Disclosures state “Plaintiff [sic] Mercury One is uncertain whether the submission of the Pretrial Order deadline in the Scheduling Order falls within the category of tolled deadlines as it could be considered a discovery obligation and/or a disclosure deadline.” *Dkt 22, pg. 2*. However, this statement is clearly erroneous because discovery has not yet closed in light of the suspension Notice. The parties were in the middle of expert discovery when Plaintiff filed its pending Motion and have not yet conducted expert witness depositions. Even if discovery had closed in the proceeding before the Notice was issued (it had not), pretrial disclosures would not need to be made until the suspension is lifted. *See* TBMP 510.03(a) (“When the motion to compel [that suspends the proceedings] is filed after discovery has closed, the parties need not make pretrial disclosures until directed to do so by the Board.”)

The Notice provides that it “does not toll the time for either party to respond to any outstanding discovery or to serve expert disclosures.” Those are the *only* activities not tolled by the Notice. The Parties have exchanged expert disclosures and rebuttals and timely served all outstanding discovery. As such, there should be no further activity or filings in the proceeding until the Board makes a decision on the Motion.

As with Petitioner’s Motion, Petitioner’s counsel continues to waste the resources of the Interlocutory Attorney and Respondent, and those of Petitioner itself, by making untimely and improper filings that disregard the clear and unambiguous instructions set out in the Notice instructing the parties not to file irrelevant papers during the pendency of the Motion. “Once a timely filed potentially dispositive motion operates to suspend proceedings in a case, no party

should file any paper that is not germane to the motion, except as otherwise may be specific in a Board order.” TMBP §510.03(a)

As such, Respondent respectfully requests the Board to disregard Petitioner’s untimely SJ Motion and Disclosures, which were filed in direct violation of the Notice to Suspend, until the Board issues a decision on the Motion, lifts the suspension, and resets the deadlines in the case. *Dkt. 14.* Respondent intends to depose Petitioners’ experts and oppose the SJ Motion once the proceedings resume and deadlines are reset.

Respectfully submitted,

NIXON PEABODY LLP

Dated: May 8, 2024

/Kaleigh P. Morrison/

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing “Respondent Honest History Co.’s Request That The Board Disregard Petitioner’s Untimely Filings In Violation Of The Suspension Order” was served on Petitioner’s counsel, this 8th day of May, 2024, addressed to Scott Hemingway via email to shemingway@hh-iplaw.com and ehartman@hh-iplaw.com .

May 8, 2024

/Kaleigh P. Morrison /