ESTTA Tracking number: **ESTTA1056321**

Filing date: **05/19/2020**

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

Proceeding	91224310
Party	Plaintiff University of Kentucky
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Date	05/19/2020
Attachments	Response to Board Order-FINAL.pdf(127810 bytes) Proposed Joint Stipulated Facts for Trial.pdf(179713 bytes) Stipulation for ACR-FINAL.pdf(83843 bytes)

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

In the Matter of Registration Application Serial No. 86/534,269

Filed February 13, 2015
For the mark 40-0
Published in the *Official Gazette* on September 29, 2015

UNIVERSITY OF KENTUCKY,	:	
	:	
Opposer,	:	
v.	:	OPPOSITION NO. 91224310
	:	
40-0, LLC,	:	
	:	
Applicant.	:	

OPPOSER'S RESPONSE TO ORDER DATED MAY 4, 2020

Pursuant to Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 536 and 37 C.F.R. §2.128(a)(3), the University of Kentucky ("Opposer") submits this Response to the Board's Order requiring Opposer to show cause why the Board should not treat the failure to file a brief as a concession of the case. While 40-0, LLC ("Applicant") does not join in the Response, Applicant has agreed to not file any opposition to Opposer's Response. For the reasons detailed below, Opposer has never lost interest in this case and has good cause including a showing of excusable neglect sufficient to support the case to be reopened in order for the parties to proceed under the Board's Accelerated Case Resolution (ACR) procedure.

On October 18, 2019, Opposer filed a Consented Motion for Suspension for Settlement as the parties continued to engage in negotiations for the settlement of this matter, which was granted by the Board. In the Order dated October 24, 2019, the Board suspended the proceeding and reset the scheduling deadlines, including Opposer's Opening Brief being due

on April 20, 2020. Although settlement negotiations were not successful, the parties through counsel worked together and agreed to pursue this matter via the Board's ACR Procedure. To this end, the parties were working on a set of Proposed Joint Stipulated Facts for Trial and requested a conference with Interlocutory Attorney Winston Folmar seeking guidance regarding the most efficient means of proceeding under the ACR Procedure.

The conference took place on November 14, 2019, and the parties agreed to submit a stipulation for ACR with a proposed briefing and evidence schedule. The parties via counsel continued to work together on drafting a Stipulation for ACR along with agreeing to a set of Proposed Joint Stipulated Facts through late January 2020. Although the parties had agreed in principle to the Stipulation for ACR, the parties were continuing to discuss the scheduling dates for Evidence and Briefs in the Stipulation for ACR and the set of Proposed Joint Stipulated Facts, which was the first required submission in the proposed schedule for the Stipulation for ACR. Indeed, Applicant's Counsel sent a "DRAFT Proposed Joint Stipulated Facts for Trial" to Opposer's Counsel on January 23, 2020. Opposer's counsel was still in the process of reviewing the "DRAFT Proposed Joint Stipulated Facts for Trial" and attempting to obtain any additional documents required for submission under the "DRAFT Proposed Joint Stipulated Facts for Trial" from its client when the COVID-19 pandemic arose.

As a result, Opposer effectively shut down its University as distance learning for students, remote working for employees, and social distancing measures were enforced by Opposer and the Governor of Kentucky. Consequently, Opposer's ability to obtain the information necessary from its client for completion of the "DRAFT Proposed Joint Stipulated Facts for Trial" and related documents has been significantly curtailed. Indeed, the deadline

for submitting Opposer's Brief (which necessitated the entry of the Board's Show Cause Order) was in the time period that Opposer's University was effectively shut down and remains so to date.

Opposer emphasizes that "[t]he principal purpose of **37 C.F.R. § 2.128(a)(3)** is to save the Board the burden of determining a case on the merits where the parties have entered into a final settlement of the matter, but have neglected to notify the Board thereof, or where the plaintiff has lost interest in the case." *See (TBMP) § 536.* These factors are clearly not at play as the parties (despite their efforts) have not entered a final settlement of the matter and Opposer has never indicated to Applicant or its counsel that it has lost interest in the case. Indeed, counsel for both parties have maintained a good working relationship throughout this proceeding and Opposer had never indicated a lost interest in this case or any desire to not pursue the case to a resolution.

Importantly, "[i]t is not the policy of the Board to enter judgment against a plaintiff for failure to file a main brief on the case if the plaintiff still wishes to obtain an adjudication of the case on the merits." *See id.* (citing NOTICE OF FINAL RULEMAKING, 48 Fed. Reg. 23122, 23132 (May 23, 1983); *Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1709-10 (TTAB 2011)). Rather, "[i]f a show cause order is issued under Trademark Rule 2.128(a)(3) and the plaintiff files a response indicating that it has not lost interest in the case, the show cause order will be discharged, and judgment will not be entered against the plaintiff for failure to file a main brief." *See Vital Pharmaceuticals*, 99 USPQ2d at 1710.

Although the show cause order for failure to file a brief should be discharged based upon the precedential *Vital Pharmaceuticals* decision, Opposer further requests that the time

for it to file its main brief be extended and for the Board to reset the remaining deadlines to allow the parties to conclude the trial period. The required showing to be made by a party seeking to reopen an expired period is "excusable neglect." *See id.* There are four factors to be considered to determine whether a party's neglect of a matter is excusable, which are: (1) the danger of prejudice to the non-moving party; (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 moving party; and, (4) whether the moving party has acted in good faith. *See id.*

In this case, there is no danger of prejudice to the non-moving party. Specifically, the parties have agreed that the "Proposed Joint Stipulated Facts for Trial" is ready for submission (a copy of the "Proposed Joint Stipulated Facts for Trial" is attached hereto as Exhibit A). Furthermore, the Stipulation for ACR is also ready for submission (a copy of the Stipulation for ACR is attached hereto as Exhibit B). Importantly, as expressly indicated in the Stipulation for ACR, the parties already stipulated to re-open Opposer's 30-day Trial Period.

Turning to the second factor, the reopening of the time to file a brief and its potential impact on the judicial proceedings would not cause a significant delay to this opposition as the parties have already agreed to the Stipulation for ACR. In the Stipulation for ACR, the parties seek an adjudication of this matter on the merits as expediently as possible, i.e., utilizing the Board's summary judgment format of ACR in lieu of a trial and the Board will render a final decision based on the ACR record and briefs and may resolve and decide any genuine dispute of material fact that the Board may find to exist based on the record.

With respect to the third factor, "several courts have stated the third factor may be

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