

ESTTA Tracking number: **ESTTA563874**

Filing date: **10/08/2013**

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

|                           |   |
|---------------------------|---|
| Proceeding                | 92056517  |
| Party                     | Plaintiff<br>Orley, LLC   |
| Correspondence<br>Address | TED SABETY<br>HAND BALDACHIN & AMBURGEY LLP<br>8 W 40TH STREET, FL 12<br>NEW YORK, NY 10018<br>UNITED STATES<br>docket@sabety.net |
| Submission                | Reply in Support of Motion  |
| Filer's Name              | Ted Sabety  |
| Filer's e-mail            | docket@sabety.net   |
| Signature                 | /ts/  |
| Date                      | 10/08/2013  |
| Attachments               | Ps Reply to Opposition to Motion to Extend Discovery.pdf(205797 bytes )   |

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

Orley, LLC,

Petitioner,

Orly International Inc.,

Registrant.

Cancellation No. 92056517

PETITIONER'S REPLY TO  
REGISTRANT'S OPPOSITION TO  
PETITIONER'S MOTION TO  
EXTEND DISCOVERY DATES

**PETITIONER'S REPLY TO REGISTRANT'S OPPOSITION TO PETITIONER'S  
MOTION TO EXTEND DISCOVERY AND TRIAL DATES**

Petitioner, Orley, LLC, ("Orley" or "Petitioner") with an address of 648 Broadway, Suite 1003, New York, New York 10012, hereby replies to Registrant's Opposition to Petitioner's Motion to Extend Discovery.

**I. PETITIONER HAS MET THE STANDARD OF GOOD CAUSE**

The baseline of good cause was adequately demonstrated by Petitioner to justify the Board granting its Motion to Extend. Good cause is generally found—especially on a first briefed motion to extend—when the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. *See Am. Vitamin Prods. Inc. v. DowBrands Inc.*, 22 U.S.P.Q.2d 1312, 1314 (T.T.A.B. 1992). The cause of delay in this case was the press of another federal patent litigation deadline, *UbiComm LLC v. OpenSky Project, Inc.*, No. 1:13-cv-01020 (D. Del. 2013), as well as Registrant's failure to meet its discovery obligations. Petitioner's First

Request for documents expressly requested evidence of sales and transportation of ORLY branded class 25 goods for every year from 1980 to 2013. But Registrant only provided documents from 2006 to 2013 in its reply, and the majority of which were not even relevant documents. Upon receiving Registrant’s non-responsive discovery document production by the extended deadline, Petitioner expected that Registrant would supplement its responses in order to meet its obligations under Federal Rule of Civil Procedure 26(e) and TMBP § 408. Those rules require that a responding party adequately search for records and supplement its responses and disclosures accordingly to meet its full duty to search and comply with Petitioner’s Request. Petitioner expected that Registrant would on its own live up to that duty to continue to search its records and supplement its responses—but now understands that it was mistaken. Therefore, filed concurrent with this Reply is a timely-filed Motion to Compel directed towards Registrant’s inadequate reply to the Petitioner’s First Request for Documents. This filing further renders moot Registrant’s objection to Petitioner’s allegation that Registrant’s deficient discovery replies were an additional cause of delay.

**A. Even Registrant’s Cited Cases Demonstrate that Petitioner’s Press of Litigation Constitutes Good Cause to Support an Extension of the Discovery Period**

Registrant fails to cite even one case to support its unfounded position that the press of non-extendible patent litigation deadlines on a small law firm somehow does not constitute good cause in seeking an extension of the discovery period. *Luemme, Inc. v. D.B. Plus Inc.*, 53 U.S.P.Q.2D 1758 (T.T.A.B. 1999) involved a second briefed motion to extend the discovery period, which in large part copied the same arguments of cause for delay from the first motion. In that case, the Board only concluded that a barefaced allegation of “extensive travel”—already sparsely alleged in the granted-first motion to extend—without supporting facts regarding that

travel, was not sufficient to demonstrate good cause. This case is distinguishable from *Luemme* because this is a first briefed unconsented motion to extend, not a second one, and Petitioner has alleged sufficient facts to support its claim of delay due to another complex and burdensome litigation, as well as Registrant's non-compliant responses.

The second case Registrant cited *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducali SCRL*, 59 U.S.P.Q.2d 1383, 1384 (T.T.A.B. 2001), actually supports Petitioner's position that the press of co-pending complex patent litigation deadlines is good cause to justify an extension of the discovery period. *Societa* involved a contested motion to extend due to the "press of other litigation" and deficiencies in discovery responses. The *Societa* Board granted the request to extend time on the basis of counsel's involvement in other litigation, and explained that "[i]t is settled that the press of other litigation . . . may indeed constitute good cause for an extension of time." *Id.* at 1384. As in *Societa*, Petitioner had demonstrated good cause to justify the extension.

**B. Registrant's Motion Contained Sufficient Facts to Demonstrate Good Cause for Delay Due to Scheduling Burdens of a Co-Pending Patent Litigation**

Registrant misconstrues and miscites Petitioner's Motion, but in fact Petitioner has alleged sufficient facts to support its claim of good cause for delay due to a co-pending complex patent litigation. Those facts include: its counsel experienced a heavy and heightened litigation work load; the litigation was a complex patent infringement case; counsel works at a small law firm; the small law firm was involved in responding to a non-extendible deadline with a substantive motion to dismiss brief due on Tuesday, September 3, 2013 (the deadline was previously extended twice and could no longer be extended; during this time counsel was involved in analyzing the asserted patent, analyzing the patent file history, researching the case

and dismissal theories, and drafting the complex argument for its motion to dismiss); upon the subsiding of that heightened litigation work-load, Petitioner's counsel realized the tight timeframe remaining in this proceeding and requested Registrant's counsel's consent to an extension of the discovery period; Petitioner assumed Registrant's counsel would grant consent as Petitioner itself had provided Registrant with consents for extensions upon Registrant's request; and when Registrant's counsel refused the Petitioner's request for extension consent, Petitioner's counsel had to then redirect its attention and efforts towards researching and drafting its Motion to Extend to be filed by the final date of discovery on Monday, September 9, 2013. *See Pet's Motion to Extend, at p. 3-4.* In light of these facts, as well as the others contained in Petitioner's Motion, Registrant's claim that Petitioner has not alleged supporting facts for its request is simply without merit.

**C. Petitioner Filed a Motion to Compel and Therefore Registrant's Failure to Comply With the First Requests is Indeed an Additional Ground to Extend Discovery**

Petitioner concurrently files a timely Motion to Compel. Therefore, that filing moots Registrant's claim that the allegation of discovery abuses without a filing of a Motion to Compel is not sufficient to show good cause. Furthermore, as Petitioner's previously arguments already demonstrated "the press of other litigation," *Societa*, 59 U.S.P.Q.2d at 1384, is sufficient good cause due to support a finding a good cause and grant the extension even if a Motion to Compel was not filed.

**II. PETITIONER HAS GRANTED REGISTRANT WITH CONSENT TO EXTEND ITS OWN DEADLINES ON NUMEROUS OCCASSIONS IN THE SPIRIT OF COOPERATION, YET REGISTRANT UNFAIRLY REFUSES TO GRANT PETITIONER WITH EVEN ONE EXTENSION**

Petitioner has granted Registrant with multiple consents to extend, and yet Registrant unfairly opposes Petitioner for its first request of any kind. Registrant's refusal to grant consent

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.