

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Baxley

Mailed: March 21, 2003

Opposition No. 117,623

RaceTrac Petroleum

v.

ETW Corporation

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of (1) applicant's tenth and eleventh motions (filed January 10, 2003 and February 10, 2003) to extend the remaining testimony periods herein, and (2) opposer's motion (filed January 16, 2003) to compel discovery.¹ The motions have been fully briefed.

Turning first to opposer's motion to compel discovery,² any motion to compel must be filed "prior to the

¹ In view of the Board's December 17, 2002 order, applicant's eighth and ninth motions to extend remaining testimony periods herein, which were filed on November 8, 2002 and December 10, 2002, but did not become associated with the proceeding file until after the issuance of the December 17, 2002 order, are moot.

² Inasmuch as opposer's motion to compel was served on applicant by first class mail on January 16, 2003, applicant was allowed until February 5, 2003 to file a brief in opposition thereto. See Trademark Rule 2.119(c) and 2.127(a). The Board notes that applicant did not file its brief in opposition until February 10, 2003 and that such brief includes no showing that applicant's failure to timely respond was caused by excusable neglect. See *Pioneer Investment Services Company v. Brunswick Associates*

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commencement of the first testimony period as originally set or as reset." See Trademark Rule 2.120(e)(1). As the final rule notice published in the Federal Register on September 9, 1998, prior to the enactment of Rule 2.120(e)(1) as amended, states, a motion to compel "deals with pre-trial matters and should be filed and determined prior to trial."³ 63 Fed. Reg. 48081, 48088. It is noted that opposer's motion to compel was filed approximately eleven months after the commencement of trial herein and therefore is untimely.

In view thereof, opposer's motion to compel is hereby denied. Nonetheless, applicant is reminded that it has a duty to make a good faith effort to satisfy opposer's discovery needs. See TBMP section 412.01. Applicant is further reminded that, when a party, without substantial justification, fails to disclose information required, or fails to amend or supplement a prior response, as required, that party may be prohibited from using as evidence the information not so disclosed. See Fed. R. Civ. P. 37(c)(1).

Turning to applicant's motions to extend the remaining testimony periods, the Board notes that applicant was

Limited Partnership, 507 U.S. 380 (1993); *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997). Accordingly, applicant's brief in opposition to the motion to compel will receive no consideration. Rather than grant the motion to compel as conceded, however, the Board, in its discretion, will rule thereon. See Trademark Rule 2.127(a).

³ Trial begins with the commencement of plaintiff's testimony period. See TBMP Section 701.

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advised in a December 17, 2002 order, wherein the Board granted as conceded applicant's first seven motions to extend testimony periods, that "no further extensions to its testimony period will be granted without opposer's consent thereto or a showing of extraordinary circumstances."⁴

A review of applicant's tenth and eleventh motions to extend testimony periods indicates that opposer has not consented thereto. Further, the Board finds that applicant's arguments in support thereof fall well short of a showing of extraordinary circumstances.⁵

In view thereof, applicant's tenth and eleventh motions to extend testimony periods are hereby denied. Nonetheless, the Board deems the filing of opposer's

⁴ Throughout its eleven unconsented motions to extend testimony periods herein, applicant appears to have assumed that the proposed dates set forth therein were operative and that the dates set in each new motion replaced those set forth in the previous one. Applicant is reminded that the Board has inherent authority to schedule cases on its docket and that any dates set forth in applicant's unconsented motions to extend are merely proposals. See Fed. R. Civ. P. 6(b); TBMP Section 509.

Having said that, the trial dates set forth in the December 17, 2002 order were operative when applicant filed its tenth and eleventh motions to extend testimony periods herein. Accordingly, applicant's testimony period was last reset to close on January 24, 2003.

Applicant is again advised that proposed dates should not be included in an unconsented motion to extend. The better practice is to request an extension of a specific length to run from the mailing date of the Board's decision thereon. See TBMP Section 509.02.

⁵ Opposer's request that the Board issue an order to show cause why judgment by default should be entered against applicant for its failure to put in any proofs is not well-taken. Applicant, as the defendant herein, does not bear the burden of proof herein and, as such, need not take testimony or file a brief. See Trademark Rules 2.128(a)(1) and 2.132; TBMP Section 801.02(b).

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motion to compel to have tolled the running of all dates herein. See Trademark Rule 2.120(e)(2). Accordingly, applicant will be allowed the time remaining in its testimony period (as last reset by the Board in the December 17, 2002 order) on the filing date of opposer's motion to compel, i.e., eight days, in which to take testimony. As the Board noted in the December 17, 2002 order, opposer is entitled to have this proceeding move forward without undue delay. Accordingly, applicant will not be allowed any further extensions in this proceeding without opposer's consent thereto in writing or a showing of extraordinary circumstances. Remaining testimony periods are hereby reset as follows:

Defendant's eight-day testimony period to close: **5/9/03**

15-day rebuttal testimony period to close: **6/23/03**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.