

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

In the matter of Applications:
Serial Nos.: 78/126,968 and 78/126,971
Filed: May 7, 2002
Applicant: ForeScout Technologies, Inc.
Marks: ACTIVESCOUT and FORESCOUT
Published in the Official Gazette of November 12, 2002

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TTAB

NetScout Systems, Inc.,)
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Opposer,)
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v.)
)
ForeScout Technologies, Inc.,)
)
Applicant.)
_____)



06-17-2004
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

Opposition No. 91158578

**MOTION TO SUSPEND DISCOVERY AND
TESTIMONY DEADLINES, AND IF NECESSARY, TO EXTEND
THE DISCOVERY PERIOD AND RESET ALL OTHER DATES**

COMES NOW the Opposer, NetScout Systems, Inc., and moves, pursuant to Section 510.03 of the Trademark Trial and Appeal Board (“Board”) Manual of Procedure (“TBMP”), for a suspension of the Discovery and Testimony deadlines pending the Board’s ruling on Opposer’s Motion for Default Judgment, which is being filed concurrently with this Motion. In addition, should the Board deny Opposer’s Motion for Default Judgment, Opposer requests, in accordance with TBMP § 509.01(a), that the Board extend the Discovery period by 180 days, such time being set to run from the date of the Board’s decision on these Motions, and to reset the other dates previously set by the Board in its November 25, 2003 Scheduling Order (the “Scheduling Order”). In support of this Motion, Opposer states as follows:

I. BACKGROUND.

Opposer is the owner of the inherently distinctive trademark NETSCOUT for and in connection with computer software and programs for monitoring and managing computer network traffic and computer network diagnostic software, and related goods and services. Opposer has registered its NETSCOUT trademark with the United States Patent and Trademark Office, and is the owner of Registration No. 1,764,154 for NETSCOUT, and Registration No. 2,287,610 for NETSCOUT and Design, both for computer software in International Class 9. Registration No. 1,764,154 has been made incontestable, in accordance with 15 U.S.C. § 1065.

Applicant is a Delaware corporation operating under the name ForeScout Technologies, Inc. Applicant is the owner of Serial No. 78/126,968 for the mark ACTIVECSOUT and Serial No. 78/126,971 for the mark FORESCOUT. The goods identified in these two applications are "computer software designed to provide computer network perimeter security; computer hardware." Both applications were published in the Official Gazette on November 12, 2002.

On March 12, 2003, Opposer timely filed its Consolidated Notice of Opposition against the ACTIVECSOUT and FORESCOUT applications. The Board instituted the Opposition, and a copy of the Notice of Opposition was mailed to Applicant on November 25, 2003. Along with the Notice of Opposition, the Board sent a notice that an Answer thereto was due forty (40) days after the mailing date of such notice. Accordingly, Applicant's Answer was due on or before January 5, 2004.

On February 3, 2004, Applicant filed a Consented-to Motion to Extend the time to file an Answer. The Board granted this Motion and, in an Order dated April 10, 2004, set a new deadline of twenty (20) days after the mailing date of such Order for Applicant to file its Answer. Accordingly, Applicant's Answer was due on or before April 30, 2004.

To Opposer's knowledge, Applicant has not filed an Answer nor otherwise pled, or, if it has done so, no copy of any responsive pleading has been served on Opposer or its undersigned counsel. Additionally, since the filing of the February 2004 Consented-to Motion to Extend, Applicant, either on its own or through counsel, has not attempted to

communicate in any way with Opposer or its undersigned counsel. Simultaneous with the filing of this Motion, Opposer has filed a Motion for Default Judgment.

The Board's November 25, 2003 Order set the Discovery Period to close on June 12, 2004. As June 12, 2004 fell on a Saturday, the discovery period is currently set to close on Monday, June 14, 2004. Opposer seeks to stay the discovery and testimony periods pending a ruling on its Motion for Default Judgment. If the Board denies its Motion for Default Judgment, Opposer requests that the Board reset the discovery and testimony periods.

Before filing this Motion and the Motion for Default Judgment, in an effort to determine whether Applicant intended to file an answer, and otherwise to pursue and defend itself in this opposition proceeding, Opposer's undersigned counsel attempted to contact the attorney of record for Applicant, Amanda Pecchoni Thompson of Barnes & Thornburg LLP. Apparently, Ms. Thompson had recently left Barnes & Thornburg LLP. Therefore, Julia Spoor Gard, another Barnes & Thornburg attorney stated that she would look into the matter. On June 11, 2004, Opposer's undersigned counsel conferred again with Ms. Gard. Ms. Gard stated that: Barnes & Thornburg LLP no longer represented Applicant and had transferred the relevant files, as well as responsibility of the matter, to Ayelet Steinitz, ForeScout Technologies, Inc., c/o Accel Partners, 2755 Campus Drive, Suite 115, San Mateo, California, 94403. This transfer of responsibility for this matter occurred on April 26, 2004, four days before the Answer was due,¹ and seven weeks ago.

Opposer's undersigned counsel then attempted to contact Applicant, at the contact information provided by Applicant's former counsel, to seek Applicant's consent to a stay of the Discovery and Testimony Periods. Undersigned counsel spoke with Ayelet Steinitz, who stated that she would speak with her employer about Applicant's position in this matter, but was unable to provide a definitive answer.

Applicant has failed to file an Answer, on its own or through counsel, or even attempt to confer with Opposer regarding settlement of this matter. Accordingly,

¹ It should be noted that according to the U.S. Patent and Trademark Office's records, Applicant's attorney of record in this matter is still Barnes & Thornburg LLP, and to Opposer's knowledge, no notice of withdrawal has been filed. Opposer would not have known of the transfer of responsibility, had Opposer not attempted to contact Applicant's counsel to discuss and attempt to obtain consent on these matters.

Applicant has moved for a judgment of default. While the Board's decision on the Motion for Default Judgment is pending, Opposer requests that the Discovery and Testimony deadlines be suspended. Should the Board deny Opposer's Motion for Default Judgment, thereby not disposing of this proceeding in its entirety, Opposer requests that the Board extend the discovery period by 180 days, such time being set to run from the date of the Board's decision on the Motion for Default Judgment and this Motion, and to reset the other dates previously set by the Board in its Scheduling Order.

II. THE DISCOVERY PERIOD SHOULD BE STAYED UNTIL THE BOARD HAS RULED ON APPLICANT'S MOTION FOR DEFAULT JUDGMENT; IF NECESSARY, THE DISCOVERY AND TESTIMONY PERIODS SHOULD BE EXTENDED.

A. There Is Good Cause To Suspend, And, If Necessary, To Extend The Discovery And Testimony Periods.

Applicant failed to file an Answer by the April 30, 2004 deadline set by the Board. Opposer has filed a Motion for Default Judgment and will await a ruling potentially dispositive of this consolidated opposition proceeding. These circumstances show good cause, as contemplated by TBMP §§ 510.03 and 509.01(a), for the Board to suspend, and, if necessary, to extend the Discovery and Testimony Periods.

Opposer has not served any discovery on Applicant nor has it noticed any depositions during the discovery period. Indeed, it would have been unreasonable and impractical for Opposer to have done so before the filing by Applicant of its Answer or other responsive pleading (including possibly counterclaims). Any requests for discovery, whether interrogatories, document requests, or the noticing of depositions, would have been premature and possibly irrelevant at this juncture. It is only after the Answer has been filed that Opposer would have information as to the scope of discovery needed to present its case.

Likewise, it will unreasonable and impractical for Opposer to conduct discovery while its Motion for Default Judgment is pending before the Board; the Board's decision is potentially dispositive of the case in its entirety. To proceed with discovery at this time would waste the valuable time and resources of all parties involved.

In sum, given that a potentially-dispositive motion is pending before the Board, and Applicant has not filed any Answer in the case, good cause exists for the suspension, and if necessary, the extension of all the Discovery and Testimony Periods.

B. There Is No Danger Of Prejudice To Applicant; Indeed, Applicant Will Benefit From The Suspension and Extension Of Discovery.

There will be no danger of prejudice to Applicant should the Board suspend, and, if necessary, extend the Discovery Period. Given that Applicant has not taken any action in this case, nor expended any resources, except to file its one request for extension of the time to answer, there is simply no harm to Applicant by staying and possibly resetting the clock on the discovery periods. Applicant's ability to defend against Opposer's claims will not be prejudiced by a delay in the proceedings if the Discovery Period is reopened, since (1) that delay is due to Applicant's failure timely to file an Answer, and (2) all witnesses and evidence still will be available. See Pumpkin, Ltd. v. The Seed Corps., 43 U.S.P.Q.2d 1582, 1587 (TTAB 1997) (no danger of prejudice where applicant failed to show that any witnesses or evidence had become unavailable).

Moreover, far from being prejudiced, Applicant will benefit from the resetting of discovery and testimony dates. If the Discovery Period closes, it closes for both Applicant and Opposer, and Applicant has neither served nor taken any discovery. If the Board were to suspend and ultimately extend the Discovery period, Applicant would be able to obtain evidence and identify witnesses, aiding its ability to defend its position. Indeed, by staying and resetting discovery, both sides will have a far better opportunity to determine the nature, scope, and severity of the conflict and possibly resolve matters amicably.

If the Board denies Opposer's Motion for Default Judgment, and Applicant does appear to defend this action, which does not appear at all to be the case, Opposer could be willing to consider a resolution of the matter with Applicant. Without information about Applicant's products, customers, and the like, however, either furnished voluntarily by Applicant, or through discovery, Opposer would be entirely unable to explore the possibility of a settlement or other resolution. If the Discovery period is stayed and extended, and the parties are allowed to conduct fact discovery, it is possible that this

matter could be resolved, which would save time and resources for both parties and the Board.

C. Applicant Should Not Be Rewarded
For Its Failure To File A Timely Answer.

To deny Opposer's Motion would unfairly prejudice Opposer, and would reward Applicant for its failure to file an Answer. If the Board were to allow the Discovery Period to close, Applicant would no longer be subject to any discovery requests. Applicant would have produced no documents, nor responded to any written interrogatories. Thus, the Board would be rewarding Applicant for ignoring its deadline to answer.

Moreover, Opposer has always acted fairly and in good faith in this matter. For example, Opposer consented to Applicant's first request to extend the time to Answer; before filing this Motion and the Motion for Default Judgment, Opposer attempted to confer with Applicant's counsel, and then, upon learning that Applicant's counsel of record no longer represents Applicant, with Applicant itself. Opposer should not be prejudiced; it was Applicant that failed to meet the answer deadline set by the Board, whereas Opposer has always acted in good faith.

D. Conclusion.

In light of the foregoing, and all of the relevant facts and circumstances, there is good cause to suspend, and, if necessary, extend the Discovery and Testimony Periods. The Board may dispose of this proceeding in its entirety based on Applicant's failure to file an Answer and Opposer's Motion for Default Judgment. Applicant would not be prejudiced where the Board to suspend, and, if necessary, reset the discovery and testimony periods; rather, both parties will benefit from the opportunity to evaluate the facts and possible avenues of resolution. At a minimum, the parties will be able to obtain information and identify witnesses prior to the Testimony period, resulting in a more productive and efficient Testimony period that will generate better information on which the Board can make its decision.

WHEREFORE, Opposer respectfully requests that the Board: Suspend the Discovery Period, and, should it deny Opposer's Motion for Default Judgment, Amend the Scheduling Order to Extend the Discovery Period for 180 days from the date of the Board's decision on this Motion, with all other discovery dates reset accordingly.

Date: June 14, 2004

Respectfully submitted,

NETSCOUT SYSTEMS, INC.

By its Attorneys



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CERTIFICATE OF MAILING

I hereby certify that a true and correct copy of the foregoing Motion To Suspend Discovery And Testimony Deadlines, And If Necessary, To Extend The Discovery Period And Reset All Other Dates is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia, 22202-3514, Attn: TTAB, this 14th day of June 2004.



Jennifer K. Lawson

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Motion To Suspend Discovery And Testimony Deadlines, And If Necessary, To Extend The Discovery Period And Reset All Other Dates is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Applicant at: Ayelet Steinitz, ForeScout Technologies, Inc., c/o Accel Partners, 2755 Campus Drive, Suite 115, San Mateo, California, 94403, with a copy to counsel of record for Applicant, Barnes & Thornburg LLP, 11 South Meridian Street, Indianapolis, Indiana, 46204, Attn: Julia Gard, Esq., this 14th day of June 2004.



Jennifer K. Lawson