

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: August 26, 2005

Opposition No. **91160978**

Perfect Foods, Inc.

v.

John D. Gullahorn

Andrew P. Baxley, Interlocutory Attorney:

Consideration of opposer's motion (filed June 6, 2005) to strike applicant's testimony deposition of himself is deferred until final decision.

On August 17, 2005, applicant filed a motion to withdraw and amend his admissions and to strike opposer's notice of reliance thereon.¹ Opposer has filed a brief in opposition thereto.

Because opposer served upon applicant his first sets of interrogatories, document requests and requests for admission, by first-class mail on November 12, 2004,

¹ Although applicant served his motion to amend his admissions and to strike opposer's notice of reliance thereon upon opposer and sent that motion to the Board with a certificate of mailing dated August 2, 2005, the motion was not received by the USPTO mailroom until August 17, 2005. See Trademark Rule 2.197(a). The Board presumes that applicant's having sent his motion to the Board's former address caused the delay between mailing and receipt by the Board. As of November 2004, any mail sent to the Board should be sent to the address set forth in the letterhead of this order.

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applicant was allowed until not later than December 17, 2005 to serve responses thereto or to secure a timely extension of time to serve such responses. See Fed. R. Civ. P. 6(b) and 36(a); Trademark Rules 2.119(c) and 2.120(a); TBMP Sections 403.03, 407.03(a), and 509.01(a) (2d ed. rev. 2004). Applicant neither served responses to opposer's requests for admissions requests in a timely manner nor secured a timely extension of time to serve such responses. Accordingly, opposer's requests for admissions are deemed automatically admitted by default under Fed. R. Civ. P. 36(a).² See TBMP Section 411.02 (2d ed. rev. 2004).

Although the responses to opposer's first set of requests for admission that applicant served on December 30, 2004, thirteen days late, indicate that applicant did not intend to concede the admissions by default, service of late responses to requests for admission does not, by itself,

² By defaulting on his responses to opposer's requests for admission, applicant admitted to various matters, including not having used his involved COOL CAT PRODUCTS and design mark in the sale and shipment any of the products identified in response to opposer's interrogatory no. 3 prior to May 8, 2003, the filing date of applicant's involved intent-to use application (request nos. 5-6), and not having used his involved COOL CAT PRODUCTS and design mark in the sale and shipment any of the products identified in response to opposer's interrogatory no. 3 prior to January 1, 2002, the asserted date of first use in commerce set forth in opposer's pleaded application Serial No. 76254092 for the mark COOT CAT WHEATGRASS PET TREAT in standard character form for "fresh vegetables, particularly for use as a pet treat" in International Class 31 (request nos. 7-8).

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relieve applicant from his admissions by default.³ Further, applicant was notified that opposer considered its requests for admissions to be admitted by the December 30, 2004 letter that opposer's counsel to applicant's former counsel.⁴ To be relieved from the effect of admissions by default, applicant must (i) submit to the Board a showing that his failure to timely respond was the result of excusable neglect or (ii) file a motion to withdraw or amend his admissions pursuant to Fed. R. Civ. P. 36(b), which is granted by the Board. See TBMP Sections 411.02 and 525 (2d ed. rev. 2004).

Applicant's motion to withdraw and amend his admissions and to strike opposer's notice of reliance on his admissions by default includes arguments that his failure to timely

³ Strict compliance with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.

⁴ Although opposer contends that applicant's former counsel did not file a request to withdraw from this proceeding, no such request was necessary under the circumstances herein. Both the cover letter to the discovery responses that applicant served upon opposer on December 30, 2004, which applicant submitted as an exhibit to his motion to withdraw and amend his admissions, and the cover letter to the discovery responses that applicant filed with the Board on December 30, 2004 indicate that applicant revoked his attorney's authority and that applicant would be representing himself herein. See TBMP Section 116.01 (2d ed. rev. 2004).

Nonetheless, the December 30, 2004 letter was properly sent to applicant's former counsel because applicant served his aforementioned discovery responses by first class mail, and there is no information in the record which indicates that opposer's counsel knew that applicant had dismissed his attorney at the time the December 30, 2004 letter was sent.

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respond to opposer's requests for admission was caused by excusable neglect. The Supreme Court has held that the determination of whether a party's neglect is excusable is:

at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include. . . [1] the danger of prejudice to the [nonmovant], [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 movant, and [4] whether the movant acted in good faith.

Pioneer Investment Services Company v. Brunswick Associates Limited Partnership, 507 U.S. 380, 395 (1993). See also *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997). In subsequent applications of this test, several courts have stated that the third *Pioneer* factor, namely the reason for the delay and whether it was within the reasonable control of the movant, might be considered the most important factor in a particular case. See *Pumpkin, supra* at footnote 7 and cases cited therein.

The Board turns initially to the third *Pioneer* factor. While acknowledging damage sustained by applicant as a result of Hurricane Ivan in September 2004, nearly two months before opposer served its first set of discovery requests, the Board finds that applicant's delay was caused by his decision to pursue other business and personal matters while his discovery obligations in this case were outstanding and his decision, made on the day before his

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discovery responses were due, to represent himself in this case.⁵ The Board further finds that such decisions were within his control. Applicant's other business and personal obligations do not relieve him of his obligations herein. *See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000).

Although applicant alleges that opposer failed to return telephone calls from applicant's former counsel regarding settlement negotiations while opposer's discovery requests were pending, proceedings herein were not suspended, and all dates continued to run.⁶ Further, even if the parties were negotiating to settle this case, the existence of those negotiations did not justify applicant's failure to timely act.⁷ *See Atlanta-Fulton County Zoo Inc. v. DePalma*, 45 USPQ2d 1858 (TTAB 1998). Accordingly, the Board finds that the third *Pioneer* factor weighs in opposer's favor.

⁵ While Patent and Trademark Office Rule 10.14 permits any person to represent himself, persons not acquainted with the technicalities of the procedural and substantive law involved in Board *inter partes* proceedings are advised to secure the services of an attorney who is familiar with such matters.

⁶ The Board notes, however, that it encourages parties to settle their cases where possible.

⁷ Rather, if applicant needed additional time to prepare his responses to opposer's requests for admission and other written discovery requests, he should have sought an extension of time to serve those responses, either by obtaining opposer's consent or upon motion, on or prior to the due date for his responses. See Fed. R. Civ. P. 6(b); TBMP Sections 408.01 and 509.01(a) (2d ed. rev. 2004).

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With respect to the first *Pioneer* factor, the Board finds that the danger of prejudice to opposer is significant. Because opposer's requests for admission were deemed admitted by default and applicant failed to file a motion to withdraw and amend his admissions prior to the commencement of testimony periods, opposer was justified in preparing for trial and offering evidence based on those admissions by default. If the Board were to allow applicant to withdraw and amend his admissions at this late juncture, opposer would be prejudiced because its opportunity to present evidence or witnesses with regard to the admissions that applicant now seeks to contest is closed. Accordingly, the Board finds that the first *Pioneer* factor weighs in opposer's favor.

With regard to the second *Pioneer* factor, the length of the delay and its impact on this case is significant. Applicant was on notice that opposer's requests for admission were deemed admitted since December 30, 2004, when opposer's counsel sent a letter to applicant's counsel stating that opposer deemed its requests for admission to be admitted. Applicant, however, took no action to withdraw and amend his admissions for roughly seven months, during which this case moved forward through the close of discovery

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and the taking of testimony to the final briefing stage.⁸ Applicant's apparent failure to appreciate the effect of his admissions by default until after opposer filed those admissions as evidence has had an adverse impact on the orderly administration of this case. Accordingly, the Board finds that the second *Pioneer* factor weighs in opposer's favor.

With regard to the fourth *Pioneer* factor, however, the Board finds that there is no evidence of bad faith on applicant's part. However, on balance, the Board finds that applicant has failed to show that his failure to timely respond to opposer's requests for admission was the result of excusable neglect.

Notwithstanding the foregoing, the Board may permit withdrawal and amendment of admissions by default when (i) the presentation of the merits of the proceeding will be subserved thereby, and (ii) the propounding party fails to satisfy the Board that withdrawal or amendment will prejudice said party in maintaining its action or defense on

⁸ Had applicant promptly moved to withdraw and amend his admissions upon receipt of the December 30, 2004 letter from opposer's counsel, any potential prejudice to opposer could have been remedied by reopening discovery for opposer for the purpose of taking discovery with regard to the amended admissions. See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989). So moving would have only slightly delayed this proceeding.

Contrary to applicant's assertion, opposer had no duty to "meet and confer" with regard to applicant's admissions by default because admissions by default are automatic by operation of Fed. R. Civ. P. 36(a).

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the merits. See Fed. R. Civ. P. 36(b); TBMP Section 525 (2d ed. rev. 2004). The timing of a motion to withdraw or amend an admission is significant in the Board's determination of whether a propounding party will be prejudiced by withdrawal or amendment. See TBMP Section 525 (2d ed. rev. 2004).

Under the first part of the test, it is clear that, if the admissions are allowed to stand, applicant would effectively concede that he did not use his involved COOL CAT DESIGNS mark prior to the date on which alleges first use in commerce of its pleaded COOL CAT WHEATGRASS PET TREAT mark in its pleaded application. Thus, allowing applicant to withdraw and amend his admissions would subserve the presentation of the merits of the proceeding. With respect to the second part of the test, however, the Board finds that, for reasons set forth earlier in this order, opposer will be unfairly prejudiced by the withdrawal and amendment of applicant's admissions at this late stage of the proceeding.

In view thereof, applicant's motion to withdraw and amend his admissions and to strike opposer's notice of reliance that includes those admissions is hereby denied. Applicant's admissions stand admitted by default and opposer's notice of reliance submitted during its rebuttal testimony period remains of record. See Trademark Rule 2.120(j); TBMP Section 704.09 (2d ed. rev. 2004).

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Opposer is allowed until thirty days from the mailing date of this order to file its brief on the case. Applicant is allowed until sixty days from the mailing date of this order to file his brief on the case, if any. Opposer is allowed until seventy-five days from the mailing date of this order to file a reply brief, if any. See Trademark Rule 2.128(a)(1); TBMP Section 801.02 (2d ed. rev. 2004).