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

Proceeding	91173105
Party	Plaintiff Honda Motor Co., Ltd.
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Submission	Motion to Extend
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Date	07/29/2008
Attachments	Opposer_s Motion to Extend Time for Testimony Period.pdf (11 pages)(45744 bytes)

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

_____)	
Honda Motor Co. Ltd.,)	
)	
Opposer)	
)	
v.)	Opposition No. 91/173,105
)	
Michael Dalton,)	
)	
Applicant)	
_____)	

MOTION TO EXTEND TIME FOR TESTIMONY PERIOD

Honda Motor Co. Ltd., the Opposer in the above-captioned proceeding, hereby requests that the testimony periods in this matter before the Trademark Trial and Appeal Board (“TTAB” or “the Board”) be extended for sixty (60) days as follows:

Testimony Period for Party in Position of Plaintiff to Close (opening thirty days prior thereto)	10/27/2008
Testimony Period for Party in Position of Defendant to Close (opening thirty days prior thereto)	12/26/2008
Rebuttal Testimony Period to Close (opening fifteen days prior thereto)	02/09/2009

This motion is based on the attached Memorandum of Points and Authorities.

MEMORANDUM OF POINTS AND AUTHORITIES

To prevail on its motion to extend time, the petitioner “must set forth with particularity the facts said to constitute good cause for the requested extension” of time. TBMP § 509.01(a); *see also* Fed. R. Civ. P. 6(b)(1). In addition, the movant “must demonstrate that the requested

extension of time is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefore." TBMP § 509.01(a). As set forth with particularity below, Opposer details its good cause for its motion to extend the testimony period based on the following: (1) the medical leave of Opposer's counsel; and (2) scheduling conflicts with a key witness. Furthermore, Opposer is able to demonstrate the extension of time has not been necessitated because of a lack of diligence or unreasonable delay on Opposer's part. Based on its ability to establish good cause coupled with its diligence and reasonableness in seeking an extension, Opposer respectfully asks that its motion to extend time the testimony period be granted.

Good cause exists to grant Opposer's motion for at least two reasons. First, Opposer's counsel primarily responsible for preparing Opposer's case was on medical leave for more than two weeks during the month of July immediately prior to the opening of the testimony period. Medical leave of individuals crucial to the pending matter, including a party's counsel, is a basis for establishing good cause for an extension request. *See Land O'Lakes, Inc. v. A. Duda & Sons, Inc.*, 2004 TTAB LEXIS 501, *2 (TTAB Sept. 10, 2004) (not precedential) (granting motion to extend based on the good cause of the surgery and subsequent recovery time for petitioner's counsel) (attached hereto as Exhibit 1); *see also Baron Philippe de Rothschild, S.A. v. Styl-Rite Optical Mfg. Co.*, 55 U.S.P.Q.2d 1848 (TTAB June 23, 2000) (noting "ordinarily, extended maternity leave may be sufficient to establish good cause to justify an extension of time," but denying motion to extend on other grounds). As Opposer's counsel was unavailable due to a major surgical procedure during a time critical to preparing for the testimony period, good cause has been established for an extension of time.

Good cause also exists because of scheduling conflicts. Counsel and the main witness for

Opposer have had scheduling issues for August due to vacation and demanding work schedules. Not only does the witness have a particularly busy work schedule, but she also resides in California while counsel for petitioner is based in New York, which also makes the coordination of schedules difficult for August. For these reasons, the Board should find that good cause exists for an extension of time.

Having established a good cause basis for an extension of time, Opposer has not shown a lack of diligence or unreasonable delay in taking the required action required during the current testimony period. First, once it became apparent that Opposer could not complete its case within the testimony period, it immediately sought Applicant's consent for an extension. Applicant refused to extend without explanation. Opposer then followed the Board's noted "better practice" for filing a motion to extend. *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 U.S.P.Q.2d (BNA) 1383, FN 3 (TTAB May 2, 2001) (granting a motion to extend filed at the end of the testimony period but noting that filing the motion earlier in the testimony period would be the "better practice"). Specifically, following Applicant's refusal to consent to an extension, Opposer filed the motion seeking an extension of time on the day that its testimony period opened. *Id.*; *see also Baron Philippe de Rothschild, S.A. v. Styl-Rite Optical Mfg. Co.*, 55 U.S.P.Q.2d (BNA) 1848 (TTAB June 23, 2000) (denying motion to extend, in part, because petitioner waited until the last day of the period to file a motion to extend); *Sysco Corp. v. Princess Paper, Inc.*, Canc. No. 92042937 (TTAB March 22, 2006) (not precedential) (noting that a request for an extension was made "well prior to the deadline as originally set" is evidence of petitioner's good faith and diligence). Second, this is the first time during these proceedings where Opposer has sought an extension of the discovery or testimony schedule. *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v.*

Colli Spolentini Spoletoducale SCRL, 59 U.S.P.Q.2d (BNA) 1383 (TTAB May 2, 2001)

(acknowledging that it was the petitioner's first request for an extension while granting its motion to extend the testimony period).

As the period of time has not yet elapsed, and Honda has demonstrated both good cause and its diligence in seeking this extension, Honda respectfully requests that the Board grant its motion to extend. *American Vitamin Products Inc., v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992) (noting that the Board is ordinarily "liberal in granting extensions of time before the period to act has elapsed").

Respectfully submitted,

WILMER CUTLER PICKERING
HALE AND DORR LLP

Date: July 29, 2008

/s/

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being served by e-mail and first class mail to the Applicant at the following addresses:

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/s/

Barbara Winterble

Exhibit 1

LEXSEE 2004 TTAB LEXIS 501

LAND O' LAKES, INC. v. A. DUDA & SONS, INC.

Opposition No. 91125580

Trademark Trial and Appeal Board

2004 TTAB LEXIS 501

September 10, 2004, Mailed

JUDGES: [*1]

Before Hanak, Hohein and Holtzman, Administrative Trademark Judges.

OPINION:

THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE TTAB

By the Board:

This case now comes up on the following motions:

1) Opposer's motion for summary judgment, filed December 20, 2002. n1

n1 Decision on the motion for summary judgment was deferred at the request of the parties and proceedings were suspended for settlement negotiations. On December 30, 2003, opposer requested resumption of proceedings, and on March 2, 2004, the Board reset applicant's time to respond to the motion for summary judgment, but otherwise continued the suspension of proceedings pending disposition of the motion for summary judgment.

2) Applicant's motion for an extension of time to respond to opposer's motion for summary judgment, filed April 5, 2004; and

3) Opposer's motion to strike applicant's response to the motion for summary judgment as untimely, filed May 3, 2004.

We turn first to applicant's motion for extension of time to respond to opposer's motion for summary judgment. In support of its motion, applicant states that an extension is necessary because the attorney assigned [*2] to prepare the responsive brief had a medical emergency involving unexpected surgery requiring a one-month time period for recovery and that the work had to be reassigned to another attorney; that the attorney now handling the response has a "busy schedule" and was impacted by a change in law firms which resulted in "delays in the receipt and integration of files"; and that applicant's counsel needs sufficient time to confer with the client in preparation of the responsive brief.

In response, opposer argues that applicant has been involved in a pattern of delay and already received opposer's consent to extensions with regard to applicant's time to respond to the motion for summary judgment on three previous

occasions "under the guise of settlement discussions"; and that applicant has not provided a "reasonable excuse" to extend applicant's time to respond to the motion for summary judgment.

In reply, applicant argues that opposer consented to all but one prior extension; that the resultant delays in the proceeding were primarily due to settlement negotiations; and that the grounds provided by applicant in its motion are sufficient to allow an extension.

The standard for allowing [*3] an extension of a prescribed period prior to the expiration of that period is good cause. See *Fed. R. Civ. P. 6(b)(1); American Vitamin Products, Inc. v. DowBrands, Inc.*, 22 USPQ2d 1316 (TTAB 1992); and TBMP Section 509. Having considered the arguments of the parties in this case, the Board finds that applicant has made a sufficient showing of good cause for a further extension of time to respond to the motion for summary judgment. Accordingly, applicant's motion to extend its time to respond to opposer's motion for summary judgment is granted.

Inasmuch as applicant's request to extend its time to file its response to the motion for summary judgment has been granted and applicant's response is deemed timely, opposer's motion to strike applicant's responsive brief as untimely filed is denied.

Turning now to opposer's motion for summary judgment, applicant has filed an application to register the mark INDIAN MAIDEN for "citrus fruit, fresh fruit and fresh vegetables" in International Class 31. As grounds for opposition, opposer alleges that applicant's mark, when used in connection with the recited goods, so resembles opposer's [*4] previously used and registered "family" of Land O'Lakes marks as to be likely to cause confusion, or mistake, or to deceive. Opposer's registered marks are as follows: Reg. No. 1001608, which is for the mark shown below,

[SEE ILLUSTRATION IN ORIGINAL]

for "natural and processed cheese and cheese products, frozen liquid egg mix, whey products, dry milk and dried milk products"; Reg. Nos. 1379400 and 2090674, which are for the following mark

[SEE ILLUSTRATION IN ORIGINAL]

for, respectively, "bakery goods" and "macaroni and cheese dinners", Reg. No. 1061307, which is for the mark reproduced

[SEE ILLUSTRATION IN ORIGINAL]

here

for "fluid milk, buttermilk and cream, sour cream dip, butter egg nog [sic], yogurt, natural and processed cheese, cheese foods, cheese spreads, frozen liquid egg mix, margarine, sodium caseinae, whey, whey products containing whey and dry milk, dry milk and dry buttermilk" and "ice cream, sherbet, dessert mix, [and] ice milk mix"; n2 Reg. No. 097648, for the mark reproduced below,

[SEE ILLUSTRATION IN ORIGINAL]

n2 This mark was also the subject of opposer's pleaded mark, Reg. No. 1252357, oleomargarine, which has since been cancelled.

[*5]

for "oleomargarine"; Reg. No. 295002, for the mark illustrated below,

[SEE ILLUSTRATION IN ORIGINAL]

for "sweet milk, powdered milk, sweet cream, poultry feed; calf feed, dairy feed, hog feeds, and skim milk powder, dried skim milk (spray process), dried sweet butter-milk, dried whole milk, sweet cream butter, ice cream, cream powder, frozen eggs, dried albumen, cheese, eggs"; Reg. No. 1102829, for the following mark,

[SEE ILLUSTRATION IN ORIGINAL]

for "natural and processed cheese, cheese foods, cheese spreads, frozen liquid egg mix, sodium caseinate, whey, milk substitutes having whey as a principal ingredient, dry milk and dry buttermilk, butter, and frozen turkeys, breast of turkey, turkey roasts, patties, steaks, breast filets and slabs" and "puddings, gravies, ice cream, and sauce". Reg. No. 1102829, for the mark illustrated below,

[SEE ILLUSTRATION IN ORIGINAL]

for "natural and processed cheese, cheese foods, cheese spreads, frozen liquid egg mix, sodium caseinate, whey, milk substitutes having whey as a principal ingredient, dry milk and dry buttermilk, butter, and frozen turkeys, breast of turkey, turkey roasts, patties, steaks, breast filets and [*6] slabs" and "puddings, gravies, ice cream, and sauce"; Reg. No. 1073269, which is

for the following mark,

[SEE ILLUSTRATION IN ORIGINAL]

for "butter"; Reg. No. 1073270, for the mark illustrated below,

[SEE ILLUSTRATION IN ORIGINAL]

for "butter"; Reg. Nos. 1170457 and 1306239, which are for the following mark,

[SEE ILLUSTRATION IN ORIGINAL]

for, respectively, "natural and processed cheese for institutional use only" and for "processed turkey"; Reg. No. 1399729 for the following mark

[SEE ILLUSTRATION IN ORIGINAL]

for "cheese"; and Reg. No. 2212915, for the mark shown below

[SEE ILLUSTRATION IN ORIGINAL]

for "recipe booklets and cookbooks". n3

n3 Opposer has also pleaded common law use of a Land O'Lakes and Design mark for fruit juices including orange juice.

Opposer's motion for summary judgment is brought on the ground that there is no genuine issue of material fact regarding opposer's priority and that there is a likelihood of confusion between opposer's Land O'Lakes family of marks

and applicant's INDIAN MAIDEN mark as a matter of law.

In a motion for summary judgment, the moving party has the burden of establishing the absence of [*7] any genuine issues of material fact and that it is entitled to judgment as a matter of law. See *Fed. R. Civ. P. 56(c)*. All reasonable inferences must be viewed in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Having carefully considered the arguments and evidence submitted by the parties in connection with opposer's motion for summary judgment, we find that there are genuine issues of material fact which preclude disposition of this matter by summary judgment. At a minimum, genuine issues of material fact exist as to the whether the purchasing public recognizes opposer's Land O'Lakes marks as a family of marks n4 and whether the design portion of opposer's mark is regarded by the purchasing public as the equivalent of the words INDIAN MAIDEN for purposes of likelihood of confusion. n5

n4 Simply using a series of similar marks does not of itself establish the existence of a family of marks. *J & J Snack Foods Corp. v. McDonald's Corp.*, 18 USPQ2d 1889, 1893 (Fed. Cir. 1991); *Colony Foods, Inc. v. Sagemark, Ltd.* 222 USPQ 185, 186 (Fed. Cir. 1984); *Polaroid Corporation v. Richard Manufacturing Company*, 144 USPQ 419, 421 (CCPA 1965).

[*8]

n5 The fact that we have identified some factual issues that serve as a basis for denial of the motion for summary judgment should not be construed as a finding that these are necessarily the only genuine issues which remain for trial.

In view thereof, opposer's motion for summary judgment is denied.

Proceedings herein are resumed and the parties are allowed until THIRTY DAYS from the mailing date of this order to serve responses to any outstanding discovery requests. Trial dates, including the close of discovery, are reset as follows:

DISCOVERY PERIOD TO CLOSE: October 24, 2004

30-day testimony period for party in position of plaintiff January 22, 2005
to close:

30-day testimony period for party in position of defendant March 23, 2005
to close:

15-day rebuttal testimony period for party in position of plaintiff to close: May 7, 2005

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). [*9] An oral hearing will be set only

upon request filed as provided by Trademark Rule 2.129.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark Law Likelihood of Confusion Similarity Appearance, Meaning & Sound General Overview Trademark Law U.S. Trademark Trial & Appeal Board Proceedings Oppositions Grounds

GRAPHIC:

Illustration 1, no caption; Illustration 2, no caption; Illustration 1, no caption; Illustration 2, no caption; Illustration 1, no caption; Illustration 2, no caption; Illustration 3, no caption; Illustration 4, no caption; Illustration 5, no caption; Illustration 6, no caption; Illustration 7, no caption; Illustration 8, no caption; Illustration 9, no caption; Illustration 10, no caption; Illustration 11, no caption; Illustration 12, no caption