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

Proceeding	91173105
Party	Defendant Michael Dalton
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Submission	Reply in Support of Motion
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Date	03/12/2009
Attachments	ReplyOppMangham.pdf ( 21 pages )(1882406 bytes )

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

Honda Motor Co. LTD	:	
	:	
Opposer	:	
	:	
vs.	:	Opposition No. 91173105
	:	
Michael Dalton	:	
	:	
Applicant	:	

**REPLY TO PLAINTIFF'S OPPOSITION TO APPLICANT'S MOTION TO  
STRIKE ENTIRE TESTIMONY OF  
CYNDEE MANGHAM**

Now comes Defendant – Applicant, Michael Dalton, in reply to plaintiff's opposition to defendant's motion to strike the untimely deposition of Cyndee Mangham.

Plaintiff had requested the board for additional time to schedule the testimony of their witness citing an attorney illness two weeks prior to the testimony period and stating scheduling conflicts with a key witness that did not allow for a testimony deposition during the set testimony period.

Defendant argued that Opposer's attorney, in their extra-judicial request for rescheduling their testimony period, made no mention of any illness. The defendant also argued that this action was brought on September 27, 2006 and plaintiff was noticed on February 28, 2008 of their testimony period in plenty of time to schedule arrangements for travel, etc. for their testimony period beginning some 120 days later. Defendant then argued that the request to reschedule was due to a lack of due diligence.

The record reflects that plaintiff specifically laid out their request to set their testimony period as follows:

“Testimony Period for Party in Position of Plaintiff to Close (opening thirty days prior thereto) 10/27/2008”<sup>1</sup>

(emphases added)

The board took under advisement the pleading, opposition, reply and made a clearly defined decision on August 20, 2008<sup>2</sup> as follows:

*“The trial schedule is **reset as indicated in opposer’s motion**, namely, as follows:*

*30-day testimony period for party in position of plaintiff to close: **10/27/08***

*30-day testimony period for party in position of defendant to close: **12/26/08***

*15-day rebuttal testimony period to close: **02/09/09**”*

The plaintiff cannot act surprised, or now assume another position<sup>3</sup>, as their request was clear that their testimony period would be (opening thirty days prior thereto) on 10/27/2008, see exhibit 1.

The key terms of the order are: **reset as indicated in opposer’s motion**

The board additionally reasserted their order particulars on February 12, 2009 by stating:

*“opposer’s first testimony period opened September 28, 2008 and closed on October 27, 2008”.<sup>4</sup>*

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<sup>1</sup> See doc 16, exhibit 1

<sup>2</sup> See doc 20, exhibit 2

<sup>3</sup> General estoppel

<sup>4</sup> See doc 42, exhibit 3

In summary:

The trademark trial and appeal board, on February 29, 2008, set the time for discovery to close on May 30, 2008<sup>5</sup>.

The board, on August 20, 2008, set the time for plaintiff s 30-day testimony period to open on September 28, 2008 and close on October 27, 2008.<sup>6</sup>

The Opposer insisted on conducting their trial testimony deposition of Cyndee Mangham on September 16, 2008. The applicant did not participate in that proceeding.

The assignment of testimony periods corresponds to setting a case for trial in court proceedings.<sup>7</sup>

The taking of depositions during the assigned testimony periods corresponds to the trial in court proceedings.<sup>8</sup>

The Trademark Trial and Appeal Board will issue an order setting a deadline for each party's required pretrial disclosures and assigning to each it's time for taking testimony. NO testimony shall be taken except during the times assigned ...<sup>9</sup>

The Opposer lacks the authority to schedule their own court date of September 16, 2008 when the board has set their testimony period to begin September 28, 2008.

The court should note, without wavier of applicant's motion to strike, during the process of the Mangham deposition it was revealed all of opposer's claimed and submitted evidence was discovered on August 3, 2008, outside the discovery period which ended on May 30, 2009<sup>10</sup> and may confirm defendants argument that the original

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<sup>5</sup> see doc 15

<sup>6</sup> See doc 42, exhibit 3

<sup>7</sup> Trademark rule 2.116(d)

<sup>8</sup> Trademark rule 2.116(e)

<sup>9</sup> Trademark rule 2.121(a)

<sup>10</sup> Deposition of Cyndee Mangham, p. 21 at 20

request to reset plaintiff's testimony period was due to a lack of due diligence and should be stricken.

Therefore;

As a matter of law, pursuant to trademark rules, the applicant is entitled to have the entire testimony of Cyndee Mangham and accompanying exhibits stricken from the record as untimely.

Respectfully submitted,

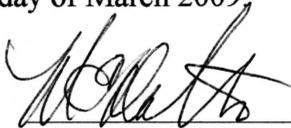


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**Certificate of Service**

I, Michael Dalton, hereby certify that this Reply to Opposition has been served by electronic email upon Opposor's council Dyan Finguerra-Ducharme, dyan.finguerra-ducharme@wilmarhale.com and standard U.S. mail upon Dyan Finguerra-DuCharme at Wilmer Cutler Pickering Hale and Dorr LLP, 399 Park Ave, New York, NY 10022 this 12th day of March 2009,



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# EXHIBIT 1

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/  
\_\_\_\_\_  
Dyan Finguerra-DuCharme  
399 Park Ave.  
New York, NY 10022  
(212) 937-7203

**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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Cincinnati, Ohio 45218-0137

DALTONME@hotmail.com

/s/  
Barbara Winterble

# **EXHIBIT 2**

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

Mailed: August 20, 2008

Opposition No. 91173105

Honda Motor Co., Ltd.

v.

Michael Dalton

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for determination of opposer's motion (filed July 29, 2008) to extend time for testimony period. The motion is fully briefed.

By operation of the Board's February 29, 2008 order, opposer's assigned thirty-day testimony period was set to close on August 28, 2008. Applicant filed its motion on July 29, 2008. Accordingly, we treat opposer's motion as captioned, namely, as a motion for an extension of time.

Pursuant to Fed. R. Civ. P. 6(b), made applicable to Board proceedings by operation of Trademark Rule 2.116(a), 37 CFR § 2.116(a), a party may file a motion for an enlargement of the time in which an act is required or allowed to be done. If the motion is filed prior to the expiration of the period as originally set or previously extended, the motion is a motion to extend, and the moving party need only show good cause for the requested extension.

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See TBMP § 509.01 (2d ed. rev. 2004). A motion to extend must set forth with particularity the facts said to constitute the requisite good cause, and 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 allotted therefor. If a motion to extend the time for taking action is denied, the time for taking such action may remain as previously set. See TBMP § 509.01(a) (2d ed. rev. 2004).

Turning to the merits of opposer's motion, said motion sets forth with sufficient particularity the facts asserted in support thereof. Specifically, opposer states that primary counsel was on medical leave for several weeks immediately prior to the opening of the testimony period, that both primary counsel and opposer's main witness have anticipated and experienced scheduling difficulties, and that opposer sought applicant's consent for the requested extension immediately upon determining that it could not complete its testimony within the prescribed period.

With respect to whether opposer's request for an extension of its testimony period is necessitated by its own lack of diligence, applicant asserts that opposer has been aware of the trial schedule since February 29, 2008, that opposer has made a last minute request of the Board, that opposer failed to demonstrate that it has "exhausted all

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remedies to compel testimony" of its witness, that opposer failed to identify its key witness, that opposer's claim of medical leave is "less than genuine," and that opposer's request is "one of convenience and not good cause."

Inasmuch as the Board does not consider the filing of a motion to extend at the commencement of an assigned period to constitute a last minute request, does not require the movant for an extension of a testimony period to exhaust all remedies to compel testimony, and does not require that the movant identify its key witness to prevail on such a motion, we note, but find unpersuasive, applicant's arguments.

Moreover, the record fails to support either a conclusion that opposer's assertion of medical leave is less than sincere, or a determination that opposer's request is merely for its own convenience.

The Board finds it relevant that opposer assessed its ability to depose its witness prior to or at the start of its testimony period, sought the consent of applicant upon determining that it could not complete its testimony as assigned, and filed its motion at the commencement of its testimony period. Accordingly, the underlying facts indicate that opposer's motion has not been necessitated by its own lack of diligence.

With respect to whether opposer acted with unreasonable delay, we find, for reasons similar to those noted above,

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that neither opposer's actions during its assigned testimony period, nor its filing of a motion to extend have effectuated a delay that is unreasonable. Opposer requests one sixty-day extension, and provides ample support therefor. The motion under consideration does not present a scenario in which the record is devoid of explanation, or in which the movant did not decide until the close or near close of its assigned period to file a motion to extend. *Cf. Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.*, 61 USPQ2d 1542 (TTAB 2001) (petitioner, without explanation, waited until final day of its testimony period to request extension); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ 1848 (TTAB 2000) (defendant's counsel knew that defendant would not be able to comply with its required deadline, but waited until penultimate day of response period to file a motion to extend). To the contrary, here, opposer moved promptly by filing its request on the day its testimony period commenced, and this is its first such request.

On balance, the Board finds that opposer's motion demonstrates good cause for the extension requested. In view thereof, opposer's motion to extend time for testimony period is granted.

The trial schedule is reset as indicated in opposer's motion, namely, as follows:

Opposition No. 91173105

30-day testimony period for party in position of plaintiff to close: 10/27/08

30-day testimony period for party in position of defendant to close: 12/26/08

15-day rebuttal testimony period to close: 02/09/09

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 Rules 2.128(a) and (b).

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:  
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>  
[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any

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protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:  
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>

# EXHIBIT 3

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

Mailed: February 17, 2009

Opposition No. 91173105

Honda Motor Co., Ltd.

v.

Michael Dalton

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of opposer's motion (filed January 16, 2009) for an extension of trial periods. On January 19, 2009, applicant filed a motion for an extension in response thereto, and filed concurrently therewith an opposition to opposer's motion to extend.

While opposer's motion for an extension sets forth a new closing date for its testimony period, namely, March 28, 2009, it is noted that, as last reset by the Board's order of August 20, 2008, and by the Board's order of December 17, 2008 granting the stipulated motion filed on December 1, 2008, opposer's first testimony period opened September 28, 2008 and closed on October 27, 2008. It is further noted that opposer filed, on October 27, 2008, a notice of reliance and trial testimony in support of its case.

Applicant's motion for an extension, filed on January 19, 2009, sets forth a schedule wherein the next testimony period to be extended is applicant's testimony period, and sets forth

Opposition No. 91173105

a closing date thereof of March 28, 2009. In its brief in opposition, filed concurrently therewith, applicant requests that opposer's motion be denied, states that applicant did not agree to reopen or extend opposer's testimony period, and sets forth a new proposed closing date for its testimony period of March 26, 2009.

Inasmuch as opposer's testimony period closed on October 27, 2008, opposer's motion sets forth a ground for an extension which appears to be in error or not pertinent to the extension it seeks therein ("Opposer's counsel is on trial for the first two weeks of February and therefore unavailable for depositions."), and opposer does not appear to seek to extend or reopen its testimony period, opposer's motion for an extension is denied. Applicant's motion for an extension is granted to the extent that remaining testimony periods are hereby reset as follows:

30-day testimony period for party in position of defendant to close:

**04/10/09**

15-day rebuttal testimony period to close:

**05/25/09**

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.

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