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

Butler

Mailed: September 3, 2008

Opposition No. 91177234

Opposition No. 91177365

Opposition No. 91177366

Opposition No. 91177367

Cancellation No. 92048172

CARDINAL HEALTH 303, INC.

v.

THE ALARIS GROUP, INC.

Before Bucher, Kuhlke and Bergsman, Administrative Trademark  
Judges.

By the Board:

Plaintiff opposes defendant's applications seeking to register the following marks: ALARIS SELECT for "medical consulting services in the field of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry";<sup>1</sup> ALARIS ADVANTAGE for "franchise services, namely, offering technical and business management assistance in the establishment and operation of medical consulting primarily for the workers compensation industry" and

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<sup>1</sup> Application Serial No. 78744914, filed on November 1, 2005, claiming a date of first use anywhere of April 1, 2003 and a date of first use in commerce of April 15, 2005. This application is the subject matter of Opposition No. 91177234.

"medical consulting services in the field of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry";<sup>2</sup> ALARISWARE for "computer software for the collection, editing, organizing, modifying, book marking, transmission, storage, reporting and sharing of data and information namely in the field of medical consulting";<sup>3</sup> and ALARIS for "franchise services, namely, offering technical and business management assistance in the establishment and operation of medical consulting primarily for the workers compensation industry."<sup>4</sup>

Plaintiff seeks to cancel defendant's registration for the mark ALARIS for "medical consulting services in the fields of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry."<sup>5</sup>

As grounds for opposition to the registration of each mark,<sup>6</sup> and as grounds for the petition to cancel,<sup>7</sup> plaintiff alleges that defendant's marks, when used in connection with the

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<sup>2</sup> Application Serial No. 78945025, filed on August 4, 2006, claiming a *bona fide* intention to use the mark in commerce. A disclaimer of ADVANTAGE is of record. This application is the subject matter of Opposition No. 91177365.

<sup>3</sup> Application Serial No. 78937067, filed on July 25, 2006, claiming a *bona fide* intention to use the mark in commerce. This application is the subject matter of Opposition No. 91177366.

<sup>4</sup> Application Serial No. 78945352, filed on August 4, 2006, claiming a *bona fide* intention to use the mark in commerce. This application is the subject matter of Opposition No. 91177367.

<sup>5</sup> Registration No. 2930177, issued on March 8, 2005, claiming a date of first use anywhere of December 14, 1999 and a date of first use in commerce of January 1, 2000.

<sup>6</sup> See the combined amended notices of opposition, filed November 7, 2007. Docket entry no. 20.

<sup>7</sup> See the amended petition to cancel, filed November 7, 2007. Docket entry no. 19.

identified goods and recited services, so resemble plaintiff's previously used and registered marks as to be likely to cause confusion, mistake or to deceive. Plaintiff's pleaded registered marks are: ALARIS for, *inter alia*, medical instruments and equipment, "service and repair of medical instruments, equipment and accessories" and "leasing and rental of medical instruments, equipment, and accessories";<sup>8</sup> and ALARIS for "electronic equipment and accessories, namely, fluid monitors; fluid flow rate meters; metered infusion pumps; ammeters; computer programs for controlling and monitoring fluid flows and detecting obstructions to fluid flows; and computer programs for capturing, storing, integrating, and presenting data in patient care management systems."<sup>9</sup>

In its answers,<sup>10</sup> defendant denies the salient allegations of plaintiff's claims and asserts affirmative defenses, including laches.

In accordance with the Board's orders dated October 4, 2007 and December 18, 2007, the discovery period was last set to close on April 12, 2008. This case now comes up on the following:

- 1) plaintiff's combined motion, filed January 9, 2008, to extend its time by thirty days from the date of the Board's determination to respond to defendant's second

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<sup>8</sup> Registration No. 2279724, issued on September 21, 1999, claiming a date of first use anywhere and a date of first use in commerce of July 24, 1997. Section 8 affidavit accepted, Section 15 affidavit acknowledged.

<sup>9</sup> Registration No. 2371410, issued on July 25, 2000, claiming a date of first use anywhere and a date of first use in commerce of July 24, 1997. Section 8 affidavit accepted, Section 15 affidavit acknowledged.

<sup>10</sup> An answer to the combined, amended notice of opposition and an answer to the amended petition to cancel were filed November 27, 2007. See docket entries Nos. 21 and 22, respectively.

set of interrogatories and request for production (served December 14, 2007), to suspend proceedings, and to reset discovery and trial dates. Defendant filed a response thereto on January 10, 2008.

- 2) Defendant's fully briefed combined motion, filed February 19, 2008, for summary judgment in its favor on its laches affirmative defense for Cancellation No. 92048172;<sup>11</sup> alternatively, to compel discovery responses and to impose discovery sanctions; and, also alternatively, for leave to file an amended answer asserting a *Morehouse* defense and counterclaiming to cancel plaintiff's pleaded Registration No. 2279724 on the grounds that it was fraudulently procured and maintained.
- 3) Plaintiff's motion, filed April 18, 2008, to strike the declaration of defendant's attorney, submitted with defendant's reply brief to its summary judgment motion. Defendant responded thereto on May 5, 2008.

**Defendant's motion for summary judgment and plaintiff's motion to strike the declaration submitted with defendant's reply brief**

As background, defendant states that, on December 21, 2000, it filed an application to register the mark THE ALARIS GROUP, INC. for "consulting services in the fields of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry," which registered on November 30, 2001;<sup>12</sup> that it has never faced any actual confusion, overlap in customers or channels of trade with plaintiff, or any objection from plaintiff; that, on July 3, 2003, it filed an application to register the mark ALARIS, which issued on March 8,

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<sup>11</sup> Defendant does not seek summary judgment on its laches defense with respect to its applications which are the subject matter of the opposition proceedings. In any event, because laches may only start to run from the date an application was published for opposition, the affirmative defense of laches is not available for opposition proceedings. See J. Thomas McCarthy, 3 *McCarthy on Trademarks and Unfair Competition* § 20:35 (4th ed. 2008).

<sup>12</sup> This registered mark is not the subject matter of any *inter partes* proceedings between the parties.

2005;<sup>13</sup> and that neither plaintiff nor its predecessor-in-interest sent cease and desist letters, opposed registration of the marks, previously brought a petition to cancel, or sued in a court of law over defendant's use and registration of such marks. Defendant also provides that it has expanded over the past eight years in terms of gross revenue, marketing and adding over 200 people to the ranks of its original five-person company;<sup>14</sup> that further expansion is anticipated; that, only upon publication of the four applications that are the subject matter of this consolidated proceeding did petitioner first raise any objection to defendant's use and registration of its ALARIS and ALARIS-formative marks; and that such objection is more than five years after defendant's first ALARIS mark registered (THE ALARIS GROUP, INC.). Defendant argues that plaintiff unduly delayed in asserting its rights by more than five years and that prejudice to defendant has resulted in such delay because defendant has seriously worked to develop its business and generated exponential growth. Defendant argues that it had no reason to believe, and no indication from plaintiff, that its ALARIS brand would be challenged. Defendant's motion is supported by the declaration of one of its officers, Nancy Craven, and by the declaration of its attorney, Kristine M. Boylan, introducing numerous exhibits.

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<sup>13</sup> Registration No. 2930177, the subject matter of Cancellation No. 92048172.

<sup>14</sup> Defendant provides specific information about such growth under seal.

In response, plaintiff points out that defendant was aware of plaintiff's use of the ALARIS mark as early as November 17, 2000 yet chose to register the mark ALARIS. Plaintiff argues that respondent has grown and changed its business, including geographic expansion, the addition of new goods and services, and the names used to brand its goods and services. Plaintiff points out that defendant changed its mark from THE ALARIS GROUP, INC. to ALARIS, revised the recitation of services from "consulting services ..." to "medical consulting services ...," and filed to register additional ALARIS-formative marks. Plaintiff states that it first became aware of defendant's marks in early 2007 during the course of monitoring the Official Gazette; that it filed requests to extend time to oppose; that settlement discussions ensued, including the proposal of a coexistence agreement; and that, when defendant stated further settlement discussions would not be productive, plaintiff also filed the petition to cancel. Plaintiff argues that it began its investigation of defendant's marks in March 2007, just two years after Registration No. 2930177 issued; that it had no previous knowledge of defendant's ALARIS mark; and that it filed its petition to cancel six months after learning of the registration, after a period of attempting settlement. Plaintiff contends that it did not delay in asserting its rights, that the cancellation proceeding was brought in a reasonable time, and that the time frame involved (less than three years) does not result in laches.

Plaintiff also argues that defendant's progressive encroachment excuses any delay that exists; that a genuine issue of material fact exists as to whether defendant's initial use was de minimus, particularly because defendant began in 1999 as a small, five-person company and it was not until at least 2005 that defendant's growth was significant; and that defendant's adoption of new trademarks incorporating the term ALARIS for an expanded line of goods and services brings defendant's use of its mark into conflict with plaintiff's goods and services sold in the medical field. Plaintiff's response is supported by the declaration of its attorney introducing numerous exhibits.

In reply, defendant argues that there is no progressive encroachment because it has offered the same consulting services since its inception in 1999, focusing on the workers compensation industry; that its services are not now different or expanded and do not conflict with plaintiff's goods; that its services, customers and channels of trade are different than those of plaintiff; and that at no time in the past eight years did plaintiff raise an issue concerning defendant's ALARIS trademark use. Defendant argues that, even if there were grounds for plaintiff's position, plaintiff has delayed unreasonably because it has been eight years since defendant began use of the mark "ALARIS," seven years since defendant filed the underlying application, and six years since the first mark has been

registered.<sup>15</sup> Defendant emphasizes that it has been economically prejudiced by plaintiff's delay. Defendant's reply is supported by the declaration of its attorney, Scott M. Oslick, concerning his review of the documents produced and submitted by plaintiff, and accompanying exhibits.

1. Motion to strike the declaration of Scott M. Oslick.

As a preliminary matter, plaintiff has moved to strike the declaration of Mr. Oslick on the basis that he is offering evidence as an expert on trademark law in support of defendant's purportedly conclusory arguments that the parties' products and services differ. Plaintiff argues that the declaration does not set forth facts that would be admissible and that it does not show Mr. Oslick would be competent to testify.

More specifically, plaintiff argues that Mr. Oslick states he has reviewed "all of the documents submitted to date" by plaintiff and, without specifically identifying such documents, states they do not "show use of the ALARIS mark for every good and/or service listed in Registration No. 2279724" (paragraph No. 4); that they fail to show "use of the ALARIS mark in any way related to The Alaris Group's claimed goods/services" (paragraph No. 5); and that the documents produced by plaintiff "show very narrow use of its claimed ALARIS mark" (paragraph No. 6).

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<sup>15</sup> Defendant appears to be referring to the mark THE ALARIS GROUP, INC., which is not part of this consolidated proceeding. As indicated previously, defendant's registration for the mark ALARIS issued March 8, 2005.

Plaintiff argues that, even if Mr. Oslick is considered an expert, the conclusions he made are not binding on the Board.

Plaintiff argues that Mr. Oslick's declaration does not provide any indication that he has special knowledge or expertise that would make him competent to testify in the medical field (for example) or any special expertise in trademark law not already present with the Board. Thus, plaintiff concludes, Mr. Oslick's declaration is incapable of assisting the Board in determining the pending summary judgment motion.

In response, defendant argues that the declaration meets the requirements for submission on summary judgment. According to defendant, Mr. Oslick reviewed every document produced (over 2700) and provides a description of what he reviewed in his declaration rather than submitting the documents; Mr. Oslick is competent, as defendant's attorney and in view of his background as a former trademark examining attorney, to describe what the documents do and do not contain; and what the documents show or fail to show is not a matter for an expert. Defendant contends that, even if Mr. Oslick's declaration can be characterized as opinion testimony, it is permissible because Fed. R. Evi. 704 provides that "testimony in the form of an opinion or inference otherwise admissible is not objectionable because it embraces an ultimate issue to be decided by the trier of fact." Defendant points out that plaintiff objects only to three paragraphs of the declaration; that plaintiff does not contend the Mr. Oslick's

statements are inaccurate; and that the admissibility of the declaration should not affect the outcome of the summary judgment motion because the statements address plaintiff's arguments regarding the relatedness of the parties' goods and services, which is not central to the affirmative defense for which summary judgment is sought.

Affidavits may be submitted in support of, or in opposition to, a motion for summary judgment provided that they (1) are made on personal knowledge; (2) set forth such facts as would be admissible in evidence; and (3) show affirmatively that the affiant is competent to testify to the matters stated therein. See TBMP §528.05(b) (2d ed. rev. 2004). An affidavit that is not supported by documentary evidence may nevertheless be given consideration if the statements contained in the affidavit are clear and convincing in character, and uncontradicted. *Id.*

Here, because Mr. Oslick stated he reviewed the produced documents, the statements made in the declaration are made of his own knowledge. While ordinarily the best course of action is to submit documents discussed, in view of the number of documents, and in view of the nature of evidence submitted on a summary judgment motion, we find that the facts averred to in the declaration are of the type which would be admissible into evidence. Moreover, being aware of the nature of evidence submitted on summary judgment, and that the adverse party does not have an opportunity to cross examine, the Board accords an

appropriate probative value to any evidence submitted in connection with a summary judgment motion. The Board also finds Mr. Oslick to be competent insofar as he simply provided statements as to what he did or did not see in his review of the documents.

Accordingly, plaintiff's motion to strike the declaration of Mr. Oslick is denied.<sup>16</sup>

2. Defendant's motion for summary judgment.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved 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).

In order to prevail on its affirmative defense of laches, respondent is required "to establish that there was undue or unreasonable delay [by petitioner] in asserting its rights, and

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<sup>16</sup> In any event, the Board does not find the declaration particularly probative because we have a duty to review the evidence ourselves. Such duty cannot be delegated.

prejudice to [respondent] resulting from the delay." See *Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460, 1462-1463 (Fed. Cir. 2001). In the absence of actual notice before the close of the opposition period, the date of registration is the operative date for calculating laches. See *Teledyne Technologies, Inc. v. Western Skyways, Inc.*, 78 USPQ2d 1203, 1210 (TTAB 2006), *aff'd unpublished opinion*, Appeal Nos. 2006-1366 and 1367 (Fed. Cir. Dec. 6, 2006). Thus, as a matter of law, because plaintiff admits it did not become aware of defendant's registered ALARIS mark until March 2007, the operative date for calculating laches is the registration date of such mark, March 8, 2005. The petition to cancel was filed September 25, 2007, just two and a half years later, including purported settlement attempts between the time plaintiff acknowledges becoming aware of defendant's registration at issue here and the filing of the petition to cancel. The Board has found a delay of three years to be insufficient to establish laches. See *Plymouth Cordage Co. v. Solar Nitrogen Chemicals, Inc.*, 152 USPQ 202 (TTAB 1966).

*Christian Broadcasting Network, Inc. v. ABS-CBN International*, 84 USPQ2d 1560 (TTAB 2007) ("CBN"), relied upon by defendant, is distinguishable. In *CBN*, the delay occasioned in *CBN* was almost five years between the issuance of the registration and the filing of the petition to cancel. Further, the petitioner (through an affiliate) contracted with the

respondent within one year after the registration issued and, thus, was charged with actual knowledge of the respondent's use of its CBN-formative mark approximately three to four years before it sought to cancel the respondent's registration.

In *Teleydyne Technologies, Inc. v. Western Skyways, Inc.*, 78 USPQ2d 1203 (TTAB 2006), also relied upon by defendant, laches was found to exist. The delay occasioned was found to be three years and eight months; the petitioner provided no explanation as to its silence; and economic damage to the respondent was found should its registration be cancelled in view of the evidence submitted regarding the respondent's investment and promotion of its mark.

Here, defendant submitted evidence concerning its expansion, including additional employees, gross revenues, and marketing figures. Plaintiff argues that much of the expansion occurred in the years 2005 and 2006, just before it became aware of defendant's registration.

We find that a genuine issue of material fact exists as to whether laches is applicable in view of plaintiff's delay of only two to two and a half years in light of the evidence of economic damage to defendant. Accordingly, defendant's motion for summary judgment is denied.<sup>17</sup>

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<sup>17</sup> The affirmative defense of laches is not suitable for disposition on summary judgment in this case because the facts presented will require weighing of the evidence.

**Defendant's motion for leave to amend its answer.**

Defendant seeks to amend its answer to add an affirmative defense based on its prior registration,<sup>18</sup> the "Morehouse defense,"<sup>19</sup> and to add a counterclaim to cancel plaintiff's pleaded Registration No. 2279724, for the mark ALARIS, on the grounds of fraud in the procurement and maintenance of the registration. As to the latter proposed amendment, defendant argues that plaintiff has not continuously used its mark on all the goods identified in the registration and that plaintiff never provided discovery responses on this topic.

In response, plaintiff argues that the *Morehouse* defense cannot apply here because defendant's prior mark, THE ALARIS GROUP, INC., is not identical to the registered mark plaintiff now seeks to cancel, ALARIS, or the marks defendant now seeks to register, ALARIS SELECT, ALARIS, ALARIS ADVANTAGE, AND ALARISWARE, and the services identified in the prior registration are not the same or substantially the same as the goods and services identified in the registration and the applications that are the subject matter of these consolidated proceedings.

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<sup>18</sup> Although not expressly pled in the proposed amended answer, there only appears to be one registration, No. 2510667 for the mark THE ALARIS GROUP, INC. for "consulting services in the fields of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry." As mentioned earlier, such registration issued on August 28, 2001, claiming a date of first use anywhere of December 14, 1991 and a date of first use in commerce of January 1, 2000.

<sup>19</sup> *Morehouse Mfg. Corp. v. Strickland & Co.*, 160 USPQ 715 (CCPA) affirming *Morehouse Mfg. Corp. v. Strickland & Co.*, 150 USPQ 688 (TTAB 1966).

As to defendant's proposed counterclaim, plaintiff argues that it has now provided the discovery responses showing its substantial use on the goods and services listed in the registration.

Leave to amend a pleading is freely given when justice so requires and the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. See Fed. R. Civ. P. 15(a); and TBMP §507.02 (2d ed. rev. 2004). If a proposed amendment involves a claim or defense which is obviously insufficient under the law, the Board will deny the request. See TBMP §507.02 (2d ed. rev. 2004). That is, if the amendment would be futile, there is no need to allow the same under Fed. R. Civ. P. 15(a).

1. The Morehouse defense.

The prior registration or *Morehouse* defense is an equitable defense, to the effect that, if a plaintiff cannot be further injured because there already exists an injurious registration, the plaintiff cannot object to an additional registration that does not add to the injury. See *O-M Bread, Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995); and *Morehouse Mfg. v. J. Strickland & Co.*, *supra*. The mark and the goods and/or services in the prior registration must be the same or substantially the same the mark and the goods and/or

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services in the application/registration at issue. See *Jacks-Evans Manufacturing Co. v. Jaybee Manufacturing Corp.*, 481 F.2d 1342, 179 USPQ 81 (CCPA 1973); and *Bausch & Lomb, Inc. v. Leupold & Steven, Inc.*, 1 USPQ2d 1497 (TTAB 1986).

Here, as a matter of law, defendant's software product and franchise services are not the same or essentially the same as the services identified in the prior registration, "consulting services in the fields of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry." The parties dispute whether such services are the same or essentially the same as the services identified in the registration plaintiff now seeks to cancel and some of the applications plaintiff opposes where the recitation above is now prefaced by the term "medical." However, the Board need not make that determination because, as a matter of law, the marks that are the subject matter of this consolidated proceeding are not the same or substantially the same as the mark that is the subject matter of the prior registration. See *O-M Bread, supra*, (the previously registered mark, OLYMPIC, and the applied-for mark, OLYMPIC KIDS, were not "essentially the same" and thus the *Morehouse* defense did not bar an opposition to OLYMPIC KIDS). See also J. Thomas McCarthy, 3 McCarthy on Trademarks and Unfair Competition § 20:38 (4th ed. 2008) and cases referenced therein.

In view thereof, because the proposed amendment to defendant's answer to add a *Morehouse* defense is futile,

defendant's motion to amend its answer to include such defense is denied.

2. The proposed counterclaim.

Defendant moves to add a counterclaim to cancel plaintiff's pleaded Registration No. 2279724, seeking to add averments that, at the time plaintiff filed its Statement of Use, it was not using "the ALARIS mark in commerce for all the products and services listed in the Registration" (paragraph No. 3 of the proposed counterclaim); that, at the time plaintiff filed its combined Sections 8 and 15 declaration, it stated it "is using ... the mark in commerce on or in connection with the goods/services identified ... [t]he mark has been in continuous use in commerce for the five consecutive years after the date of registration ... and is still in use in commerce on or in connection with all the goods and/or services identified ...," but was not using the mark in commerce with all the products and services listed in the registration (paragraph Nos. 4 and 5 of the proposed counterclaim); that plaintiff procured the registration "by false means and/or by knowingly and willfully making false and/or fraudulent declarations and representations to the Trademark Office" (paragraph No. 6 of the proposed counterclaim); and that the "false statements were made with the intent to induce authorized agents of the Trademark Office to grant said registration, and, later, to grant the status of incontestability

to said registration ..." (paragraph No. 7 of the proposed amended counterclaim).

Fraud in the procurement and maintenance of a registration are valid, cognizable grounds for cancellation of a registration. See Trademark Act §14(3); *Torres v. Cantine Torresella S.R.L.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986); and *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321 (TTAB 1992). Fed. R. Civ. P. 9(b) provides that the circumstances constituting the alleged fraud shall be stated with particularity. See also *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801 (CCPA 1981). That is, the time, place and contents of the false representations, the facts misrepresented, and identification of what has been obtained, shall be stated with specificity. See *Saks, Inc. v. Saks & Co.*, 141 USPQ 307 (TTAB 1964).

In view of the numerous medical products listed in the identification of goods, and the recitation of services in two international classes, we find that defendant's counterclaim of fraud in the procurement and in the maintenance of plaintiff's registration is not set forth with particularity because it does not identify the specific goods and services (the facts misrepresented) for which plaintiff purportedly was not using its mark either at the time it filed its Statement of Use or when it filed its combined Sections 8 and 15 declaration. Moreover, defendant's proposed counterclaim is not accompanied by the

requisite fee. See Trademark Rule 2.106(b)(2)(iii) and 2.114(b)(2)(iii); and TBMP §313.02 (2d ed. rev.2004).

Accordingly, for the reasons discussed above, defendant's motion for leave to amend its answer to include a counterclaim is denied.

**Plaintiff's motion to extend its time to respond to written discovery requests**

Plaintiff seeks an extension of time to respond to defendant's second set of interrogatories and requests for production (served December 14, 2007). In support of its motion, plaintiff argues that the requests were served just two weeks before the end-of-year holidays; that many of its personnel, including those who would be assisting in assembling the responses and documents, were out of the office; and that, although plaintiff is working on responses, it is unlikely they will be ready by the due date of January 14, 2008. Plaintiff indicates it sought defendant's consent to a thirty-day extension, but that defendant declined to consent. Plaintiff also asks that proceedings be suspended pending disposition of its motion for an enlargement of time and that, upon resumption, discovery and trial dates be reset.

In response, defendant argues that any delay is of concern because it has little confidence plaintiff will actually provide substantive responses to the discovery requests at issue because, according to defendant, plaintiff's responses to defendant's first set of written discovery request were "woefully deficient."

Defendant points out that its second set of written discovery requests is composed of twenty-two interrogatories and twenty-four documents requests; that plaintiff has not complained that the discovery sought is overly broad or unduly burdensome; and that the reality that the time for responding fell over the end-of-year holidays cannot be a reason for an enlargement of time.

The standard for allowing an extension of a prescribed period prior to the expiration of that period is good cause, and a motion to extend must set forth with particularity the facts said to constitute good cause for the requested extension. See Fed. R. Civ. P. 6(b)(1). See also *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758 (TTAB 1999). The Board will review carefully any such motions in determining whether good cause has been shown, including the diligence of the moving party, and whether the moving party is guilty of negligence or bad faith and whether the privilege of extensions has been abused. *Id.* See also *American Vitamin Products, Inc. v. DowBrands Inc.*, 22 USPQ2d 1316 (TTAB 1992).

In this case, there is no indication that plaintiff is guilty of negligence or bad faith. Often, personnel are out of the office at end-of-year holidays. In addition, the privilege of extension has not been abused. By contacting defendant and seeking an extension prior to the expiration of a due date, plaintiff has acted in a diligent manner.

Accordingly, for good cause shown, plaintiff's motion to extend its time to respond to defendant's second set of written discovery requests is granted. The time for plaintiff to serve responses and discovery and trial dates are reset later in this order. Insofar as proceedings have been suspended pending disposition of defendant's motion for summary judgment, considered *supra*, plaintiff's motion for suspension is granted and is further considered incorporated therein.

**Defendant's motion to compel**

Defendant's motion to compel is premature in view of our granting, *supra*, of plaintiff's request to extend its time to respond to defendant's second set of written discovery requests.<sup>20</sup> Plaintiff now has provided a privilege log and a party-signature attesting to the veracity of its responses to defendant's first set of interrogatories. Consequently, defendant's motion to compel is moot with respect to these matters. Defendant's request for sanctions is also premature insofar as there neither has been an order compelling discovery nor has plaintiff stated it will not respond to the discovery requests in dispute. See Trademark Rule 2.120(g); and TBMP §§527.01(a) and (b) (2d ed. rev. 2004).

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<sup>20</sup> The Board notes in passing that defendant's motion to compel is deficient because it is not supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement. See Trademark Rule 2.120(e)(1); and TBMP §523.02 (2d ed. rev. 2004).

**Proceedings resumed; dates reset**

Proceedings are now resumed. Plaintiff is allowed until **THIRTY DAYS** from the mailing date of this order in which to serve its responses to defendant's second set of written discovery requests. The parties are reminded that, because there is no stipulated protective agreement of record, the Board's standardized protective order is in place for the exchange of confidential information and materials. See Trademark Rule 2.116(g). Discovery and trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	January 10, 2009
30-day testimony period for party in position of plaintiff to close	April 10, 2009
30-day testimony period for party in position of defendant to close:	June 9, 2009
15-day rebuttal testimony period to close:	July 24, 2009

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

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