

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

Mailed: April 22, 2008

Opposition Nos. 91177799 (parent)
91177804

Amerfit, Inc.

v.

George K. Zoorob

**Robert H. Coggins,
Interlocutory Attorney:**

These cases now come up on applicant's motions (filed December 28, 2007 in Opposition No. 91177799) to consolidate Opposition Nos. 91177799 and 91177804, and to extend the discovery period; and opposer's motion (filed April 11, 2008 in both cases) to resume proceedings and to compel discovery responses.¹

Motion to Consolidate

Opposer's motion seeks to consolidate Opposition Nos. 91177799 and 91177804.

Fed. R. Civ. P. 42(a), as made applicable by Trademark Rule 2.116(a), provides with respect to consolidation of

¹ Opposer's change of correspondence address filed January 16, 2008 is noted and entered.

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proceedings that, when actions involve a common question of law or fact, the Board may order a joint hearing or trial of any or all of the matters in issue in the actions; it may order all the actions consolidated; and it may make such orders concerning proceedings therein as may tend to avoid unnecessary costs or delay.

The Board has reviewed the records in Opposition Nos. 91177799 and 91177804 and concludes that both cases involve identical parties, similar marks, identical goods, and common questions of law and fact. It would therefore be appropriate to consolidate these proceedings pursuant to Fed. R. Civ. P. 42(a). Accordingly, applicant's motion is **granted** as conceded² and well-taken.

The above-noted proceedings are hereby consolidated and may be presented on the same record and briefs. *See Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989), and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1432 (TTAB 1993).

The Board file will be maintained in Opposition No. 91177799 as the "parent" case. The parties should no longer file separate papers in connection with each proceeding. Only

² While opposer's brief in opposition to the December 28, 2007 motions argued against an extension of the discovery period, the brief failed to address the motion to consolidate. The motion to consolidate is therefore considered conceded. See Trademark Rule 2.127(a).

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a single copy of each paper should be filed by the parties and each paper should bear the case caption as set forth above.

Motion to Extend Discovery

The standard for allowing an extension of a prescribed period prior to the expiration of that period is good cause. See Fed. R. Civ. P. 6(b)(1) and TBMP Section 509.01 (2d ed. rev. 2004). The party moving for an extension bears the burden of proof, and must "state with particularity the grounds therefor, including detailed facts constituting good cause." *Luemme, Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1760 (TTAB 1999). See also, Trademark Rule 2.127(a); 4B C.A. Wright and A.R. Miller, Fed. Prac. & Proc. Civ.3d §1165 (2007 update); *HKG Industries, Inc. v. Perma-Pipe, Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998); and *Johnston Pump/General Valve Inc. v. Chromally American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989).

In the motion to extend discovery, applicant states that he received opposer's discovery requests on December 28, 2007, and that the deadline for discovery was two days later, December 30, 2007. In his reply brief, applicant states that he cannot be expected to answer and file his discovery responses by December 30, 2007, the close of the discovery period.

Applicant's motion to extend the discovery period appears to be based on a mistaken belief that discovery responses are

due by the close of the discovery period. While discovery requests must be served on or before the closing date of the discovery period as originally set or as reset, the time for providing responses to interrogatories, requests for production of documents and things, and requests for admission runs from the date of service of the requests for discovery, not the deadline for serving those requests. See Trademark Rule 2.120(a).

In the present situation, where opposer's requests for discovery were timely served by U.S. Mail on December 21, 2007, applicant's responses were due by January 25, 2008.³ That is, applicant was permitted thirty-five days in which to respond: thirty days under Trademark Rule 2.120(a) (which provides that responses to discovery requests must be served with thirty days from the date of service of such discovery requests) plus an additional five days under Trademark Rule 2.119(c) (which provides that an additional five days be added to a deadline when a party is required to take some action within a prescribed period after the service of a paper upon the party

³ It is noted that January 25, 2008 is the date on which applicant's discovery responses were originally due. The parties later agreed to extend the due date to February 21, 2008. (See Ex.D to Opp.'s Mot. to Compel.) As explained in more detail later in this order, the February 21, 2008 and all later presumed due dates were tolled by the Board's February 15, 2008 suspension order which reset the due date for discovery responses to June 14, 2008.

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by another party when the paper is served by, *inter alia*, first-class mail).

Inasmuch as applicant's motion fails to allege facts constituting good cause, the motion to extend discovery is **denied**.

Motion to Compel and Resume

Opposer's motion seeks to resume proceedings and to compel applicant's responses, without objection, to opposer's interrogatories and requests for production of documents. The Board exercises its discretion to determine this motion prior to the expiration of applicant's time in which to file a brief in opposition thereto.

1. Motion to Compel

On February 15, 2008, opposer filed (in both Opposition Nos. 91177799 and 91177804) a consented motion to suspend proceedings for ninety days to allow the parties to negotiate settlement. In its February 15, 2008 order granting suspension until May 15, 2008, the Board stated that "[t]he parties are allowed THIRTY DAYS from resumption in which to serve responses to any outstanding discovery requests." (Emphasis original.) The suspension order temporarily suspended all obligations of the parties in these proceedings, including any deadline to respond to outstanding discovery requests.

Although one or both parties may have believed that an obligation to respond to discovery requests continued, all such

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obligations were tolled by the Board's suspension order. The Board clearly addressed the issue of the discovery response period in the February 15, 2008 order. The Board's suspension order effected a suspension of the parties' discovery activities and obligations. Neither opposer's motion to suspend nor the Board's order granting said motion made any exception to the suspension of proceedings; therefore, the period for responding to discovery requests was tolled, and applicant's responses were not due until thirty days after resumption of proceedings. Because the Board granted suspension until May 15, 2008, and the parties were allowed thirty days from this resumption date in which to serve responses to outstanding discovery requests, no discovery requests are currently due or would be due until at least June 14, 2008 under the current suspension order. (However, as noted hereinbelow, that date no longer controls.)

Inasmuch as applicant's discovery responses were not due until June 14, 2008, a date after the filing of opposer's April 11, 2008 motion to compel, the motion to compel is premature. Opposer may not compel responses before they are due. Accordingly, opposer's motion to compel is **denied**, without prejudice, as premature.

2. Motion to Resume

The Board notes that its February 15, 2008 order suspending proceedings was made "...subject to the right of

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either party to request resumption at any time." Inasmuch as opposer now requests resumption, the motion to resume is **granted**.

Proceedings are resumed. The parties are allowed **thirty days** from the mailing date of this order to serve responses to any outstanding discovery requests. Trial dates are reset as follows:

Discovery period to close:	Closed
Responses to outstanding discovery requests due:	Thirty days
30-day testimony period for party in position of plaintiff to close:	7/30/08
30-day testimony period for party in position of defendant to close:	9/28/08
15-day rebuttal testimony period to close:	11/12/08

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

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 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>