

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

WINTER

Mailed: July 3, 2008

Opposition No. 91178943

Corporacion Cimex S.A.

v.

DM Enterprises &
Distributors, Inc.

Rogers, Administrative Trademark Judge:

This case now comes up for consideration of applicant's motion (filed April 22, 2008) for "enlargement of" the discovery, testimony and briefing periods. The motion is fully briefed. Additionally, the Board notes the filing of opposer's motion for summary judgment (filed June 6, 2008) and of applicant's responsive brief and cross-motion for summary judgment (filed June 30, 2008).

As a preliminary matter, the Board notes that each of applicant's two requests for extension of the deadline for filing its answer were technically requests to reopen that deadline. Although applicant signed, dated and served each request on the extant due date for the answer, the requests were not filed by ESTTA, the Board's electronic filing system, on the signing dates, and were not filed with a

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certificate of mailing. Thus, each request was "filed" as of the date of its receipt by the Office. See Trademark Rule 2.197(a), 37 C.F.R. § 2.197(a); and TBMP § 110 (2d ed. rev. 2004). Because the two requests were consented to by opposer, the technically late requests to extend carried no negative ramifications for applicant. Further, applicant's answer also was signed and dated on the due date, but not filed that day through ESTTA or filed with a certificate of mailing. Thus, the answer, too was not timely and applicant was in default when it was filed (received) by the Board. However, applicant's technical default is hereby discharged, as opposer did not object to it and the law prefers cases to be decided on their merits. Applicant is reminded, however, that the timeliness of future filings with the Board is dependent on applicant's compliance with the Trademark Rules of Practice, and filing through ESTTA (no later than the due date or deadline for a filing) or deposit of the filing in the mail with a proper certificate of mailing.

Turning to applicant's motion to "enlarge" the discovery period, as last reset (pursuant to the Board's scheduling order mailed December 7, 2007) that period was set to close on April 12, 2008. Inasmuch as the subject motion to extend was filed subsequent to the close of the discovery period, the motion must be treated as one to reopen discovery and reset subsequent periods. The showing

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that must be made to reopen a prescribed time under the Federal Rules of Civil Procedure is set forth at Rule 6(b), made applicable to Board proceedings by Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a). Rule 6(b) provides for an enlargement of time after the expiration of the specified time period, "where the failure to act was the result of excusable neglect." See also TBMP § 509.01(b) (2d ed. rev. 2004). The relevant case which addresses the excusable neglect standard is *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997).

In *Pioneer*, the Supreme Court stated that the determination of excusable neglect 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*, 507 U.S. at 395. The Board has also noted that several courts have held that the third *Pioneer* factor, *i.e.* "the reason for the delay, including whether it was within the reasonable control of the movant," may be deemed to be the most important of the

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Pioneer factors in a particular case. *Pumpkin Ltd. v. The Seed Corps, supra*, 43 USPQ2d at 1586 n.7. See also *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1296 (TTAB 1997).

Applicant contends that "this enlargement is sought to allow Applicant to pursue discovery and other issues, and is not for delay," and that "Applicant has received discovery requests [*sic*] from Opposer, which alleges new information, not known to the Applicant, and further discovery is needed." However, applicant has offered no explanation whatsoever as to why it failed to act within the prescribed time frame, *i.e.*, soon after it was served with opposer's discovery responses and prior to the close of the discovery period.¹ For this reason, and because applicant has previously filed documents in the proceeding with insufficient regard to the relevant time period or deadline, the Board finds that applicant has failed to meet its burden of showing that its failure to complete discovery during the discovery period, or to request an extension of time to take additional discovery, was the result of excusable neglect. See, *e.g.*, *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860, 1862 (TTAB 2002) (excusable neglect not found

¹ The Board notes that applicant was served with opposer's responses to applicant's discovery requests on March 26, 2008 (opposer's brief, ¶5), but did not file the subject motion until April 22, 2008, twenty-seven days later.

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where motion to reopen was filed nearly one month after close of testimony period and was based on mistaken belief that extension of time to respond to discovery extended testimony period); and *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (counsel's press of other business, docketing errors and misreading of relevant rule are circumstances wholly within counsel's control).

Moreover, to the extent applicant's receipt of discovery responses from opposer late in the discovery period is a consequence of delayed service of discovery requests, the Board has held that a party that delays in commencing discovery activities will not be found to have even good cause for an extension. See *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) ("mere delay in initiating discovery does not constitute good cause for an extension of the discovery period"). A showing of excusable neglect sufficient to obtain a reopening of discovery likewise cannot be made when the requesting party needs the reopening because it delayed in seeking discovery. In view thereof, applicant's motion to reopen the discovery period is **denied**.

Further, in view of the filing of the parties' cross motions for summary judgment, to the extent applicant seeks

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by its motion to extend the testimony and briefing periods, said motion is moot.

This proceeding is **SUSPENDED** pending disposition of opposer's motion (filed June 8, 2008) for summary judgment, and applicant's cross-motion. Any paper filed during the pendency of this motion which is not relevant to these motions will be given no consideration. See Trademark Rule 2.127(d), 37 C.F.R. § 2.127(d).



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>