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

MBA

Mailed: February 4, 2008

Opposition No. 91179798

Medquest Global Marketing Research, Inc.

v.

Medquest Research, LLC

Michael B. Adlin, Interlocutory Attorney:

This case now comes up for consideration of applicant's motion for a 45 day extension of time to respond to opposer's first set of interrogatories and first set of requests for production. Although applicant's responses to opposer's discovery requests were due November 29, 2007, applicant did not file its motion until December 3, 2007.

In its motion, applicant argues that it "is a small business, and its principal officer, Dr. Susan Newlin, has been traveling extensively on business since Opposer's discovery requests were served." Applicant claims that it has been working on responses to the discovery requests, but was not able to timely complete them, and therefore requested that opposer stipulate to an extension of time.

Although this proceeding was less than two months old when applicant made its request in the middle of the holiday season, and applicant had not requested any previous extensions of time for any purpose, opposer did not unconditionally grant the requested extension. Instead, opposer indicated that it would agree to the requested extension only if applicant would "agree that for any deposition taken in the Opposition, whether during the discovery or testimony period, may be taken (sic) and attended via video conference and/or telephone and that personal appearance will not be required by any party, witness or counsel."[1] Applicant informed opposer that it did not understand the parameters of opposer's "ambiguous" conditions and therefore filed its motion rather than agree to opposer's terms.

In its response to applicant's motion, opposer points out that if the motion is granted, applicant will have "over eighty (80) days to respond to discovery which should have been responded to in thirty-five (35) days and which simply includes 15 Interrogatories and 36 Document Requests." Opposer claims that applicant's "conclusory statements" about its size and the travel schedule of its principal officer are unsupported and do not establish that applicant's failure to respond to the discovery requests was

[1] Suffice it to say, this case is not off to a healthy start.

excusable. Opposer also argues, in conclusory fashion, that applicant "must have" certain relevant information because it sent a cease and desist letter to Opposer on March 15, 2007, "claiming priority in the MEDQUEST mark."[2] Therefore, according to opposer, "it seems unlikely that Applicant could not provide responses to interrogatories and document requests to at least those relevant to the issue of priority and provide supplemental response where necessary." Opposer "requests the Board deny [applicant's motion] … and instead order response to be hand-delivered within five (5) business days of the Board's order."

Because applicant waited until after its responses to the discovery requests were due to move for an extension, it must show that its failure to respond to the discovery requests was the result of "excusable neglect." Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co., 55 USPQ2d 1848, 1852 (TTAB 2000) ("Pursuant to Fed. R. Civ. P. 6(b)[(1)(B)], the requisite showing for reopening an expired period is that of excusable neglect.").

> In Pioneer Investment Services Company v. Brunswick Associates Limited Partnership, 507 U.S. 380, 395 (1993), the Supreme Court set forth four factors to be considered in determining excusable neglect. Those factors are: (1) the danger of prejudice to the non-moving party; (2) the length of delay and its potential impact on judicial proceedings; (3) the reason for the delay,

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[2] The parties will likely benefit by better supporting claims made in any future motions, by declaration or otherwise.

> including whether it was within the reasonable control of the moving party; and, (4) whether the moving party has acted in good faith. In subsequent applications of this test by the Circuit Courts of Appeal, several courts have stated that the third factor may be considered the most important factor in a particular case. See Pumpkin Ltd v. The Seed Corps, 43 USPQ2d 1582, 1586 at fn. 7 (TTAB 1997).

Id., at 1852.

Taking the third and most important factor first, we find that the reason for applicant's delay supports a finding of excusable neglect. Applicant's "principal officer" was occupied with business travel, but nevertheless "prepared a partial draft response," and timely requested an extension of time from opposer to complete its responses. While it appears that applicant wrongly assumed that standard professional courtesies would be extended on its first request for extension in a less than two month old case, its assumption was not unreasonable given the way Board cases are generally litigated. Furthermore, once its timely request was denied, applicant promptly filed its motion two business days later. While Dr. Newlin's travel schedule was within her control, and applicant must give due attention to responding to opposer's discovery requests, all in all this factor weighs in favor of a finding of excusable neglect.

Turning next to the other, less important, factors, the requested extension is relatively short, will not

meaningfully impact this proceeding and any resulting prejudice to opposer is minimal at most. Indeed, even if there are no more extensions or suspensions in this proceeding, it will still take over two years to proceed through trial if it is not disposed of beforehand, and the requested 45 day extension of time would not make a real difference. Significantly, opposer does not argue otherwise. Finally, because applicant first requested an extension from opposer before its responses were due, and promptly requested an extension from the Board after opposer refused to provide consent, we find that applicant has acted in good faith.

Weighing all of the factors together, we find that applicant has established excusable neglect, and accordingly its motion is hereby **GRANTED**. However, because applicant has already had a significant amount of time to respond to opposer's discovery requests, it is only allowed until **TWENTY DAYS** from the mailing date of this order to serve its responses and objections to opposer's discovery requests. Discovery and trial dates remain as previously set.

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

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