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

Proceeding	91183140
Party	Defendant Whale Wash, LLC
Correspondence Address	Jose Martinez Martinez Law 76 Ninth Avenue, Suite 1110 New York, NY 10011 UNITED STATES jose@martinezlawpllc.com
Submission	Motion to Reopen
Filer's Name	Shana Fried
Filer's e-mail	Shana@martinezlawpllc.com
Signature	/shanafried/
Date	02/02/2009
Attachments	Mobys v. Whale Wash - MTR DISCOVERY 2 Feb 09.pdf (8 pages)(322656 bytes)

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

In the matter of trademark application Serial No. 77205602

Filed By WHALE WASH, LLC on June 13, 2007

For the mark WHALE WASH

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MOBY'S AUTOSPA, INC.,

Opposer,

Opposition No.:
91183140

- against -

WHALE WASH, LLC.,

Applicant.

-----X

APPLICANT'S MOTION TO REOPEN DISCOVERY

Applicant, WHALE WASH, LLC., hereby moves for an order reopening discovery in the above-identified case.

On June 13, 2007, Applicant filed an application for registration of the above referenced mark, WHALE WASH. On March 24, 2008, Opposer, Moby's Auto Spa, Inc., filed a notice of opposition to Applicant's mark on the basis of priority and likelihood of confusion pursuant to Trademark Act section 2(d). Applicant filed his answer on May 5, 2008 and his initial disclosures on July 3, 2008. Opposer filed its initial disclosures on July 28, 2008. Thereafter the parties began the process of discovery.

On December 1, 2008, both Applicant and Opposer filed their respective First Request for Production of Documents and their First Set of Interrogatories. Both Applicant and Opposer filed their respective Responses to the First Request for Production and First Set of Interrogatories on January 5, 2009.

Opposer filed his Pretrial Disclosures on January 14, 2009.

Discovery demands and responses have extended beyond the date given by the Trademark Trial and Appeal Board Order dated March 25, 2008.

**NEWLY DISCOVERED EVIDENCE REQUIRES DISCOVERY TO BE
REOPENED**

Applicant now moves the court to grant an extension and re-opening of discovery due to the documents produced in response to the parties' discovery demands, which raise new issues bearing directly on the instant suit. Such issues include:

1. Whether Opposer uses other equipment and materials inclusive of manufacturers with any model numbers or product specifications that are unique to their trademark.
2. Whether Opposer has or intends to seek action against any other companies for infringement of use of any of the unique equipment and materials listed previously.
3. Whether Opposer can provide documentation or evidence (including specific dates when the facts were first established) referencing all areas in which their trademark is associated with the cleaning and maintenance of oversized vehicles.
4. Whether Opposer can provide evidence of when he was first made aware of Applicant's mark and how it was brought to Opposer's attention.

5. Whether Opposer can provide a list of all witnesses and/or customers that they are aware of and are not party to this litigation, which can testify to having had any degree of confusion between the respective trademarks in commercial use.

6. Whether Opposer can provide an estimate of damages incurred for the alleged infringement to date along with any supporting documentation to justify the estimate.

7. Whether Opposer can provide documentation of any future plans, blue prints or business forecasts (including dates with supporting documentation when each was established) for which it intends the allegedly infringed upon trademark to be used outside of the state county, country in which it is currently being used or in any area closely aligned with Applicant's consumer base.

8. Whether Opposer can provide a list of any parties for which they have licensed their trademark, of who have requested to license their trademark and under what terms and conditions the license exists.

The Trademark Board Manual of Procedure (TBMP) §509.01(b)(2) (2d ed. rev. 2004) provides that:

If a party files a motion to reopen its testimony period to introduce newly discovered evidence, the moving party must show not only that the proposed evidence has been newly discovered, but also that the evidence could not have been discovered earlier through the exercise of reasonable diligence. However, even if a sufficient showing of due diligence has been made, the Board will not automatically reopen a party's testimony period for introduction of new evidence. The Board must also consider

such factors as the nature and purpose of the evidence sought to be brought in, the stage of the proceeding, and prejudice to the nonmoving party.

Opposer's responses to Applicant's first set of discovery demands were vague and open-ended. Further, Opposer's responses enlightened Applicant to new facts that may affect the Mark, however Applicant was not provided details regarding the extent and status of Opposer's use of the Mark. Because Applicant was made aware of newly discoverable evidence as a result of Opposer's responses to its first set of discovery demands, Applicant now wishes to inquire further based on information provided by Opposer. Opposer's responses warrant further exploration and Applicant would be prejudiced if not given the opportunity to demand more specific and detailed information from Opposer in light of the information recently provided to it.

Accordingly, Applicant will require further discovery with respect to these new issues.

**APPLICANT'S SHOWING OF EXCUSABLE NEGLIGENCE IS SUFFICIENT TO
WARRANT A REOPENING OF DISCOVERY**

Pursuant to the Trademark Trial and Appeal Board Manual of Procedure §509.01(b) (governing Motions to Reopen Time), where the time for taking required action, as originally set or as previously reset, has expired, a party desiring to take the required action must file a motion to reopen the time for taking that action. The movant must show that its failure to act during the time previously allotted therefor was the result of excusable neglect. See Fed. R. Civ. P. 6(b).

The analysis to be used in determining whether a party has shown excusable neglect was set forth by the Supreme Court in *Pioneer Investment Services Company v.*

Brunswick Associates Ltd. Partnership, 507 U.S. 380 (1993), adopted by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997). These cases hold that the excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay, including (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 Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380, 395 (1993)

The "prejudice to the nonmovant" contemplated under the first Pioneer factor must be more than the mere inconvenience and delay caused by the movant's previous failure to take timely action, and more than the nonmovant's loss of any tactical advantage which it otherwise would enjoy as a result of the movant's delay or omission. Rather, "prejudice to the nonmovant" is prejudice to the nonmovant's ability to litigate the case, e.g., where the movant's delay has resulted in a loss or unavailability of evidence or witnesses which otherwise would have been available to the nonmovant. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 at fn. 7 (TTAB 1997). It has been 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 Pioneer factors in a particular case. *Pumpkin Ltd. v. The Seed Corps*, supra at n.7 and cases cited therein. See also *Baron Philippe de Rothschild S.A. v. Styl-Rite OpticalMfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000)

The application of this standard under which a motion to reopen shall be determined to the facts of this particular case establish that Applicant's motion should be

granted to allow for additional discovery of several issues that weigh heavily on the outcome of the case. The situation between the Applicant and the Opposer has been one of delay on both parties. Both Applicant and Opposer were unable to adhere to the discovery timeline initially due to an uncontrollable delay in obtaining discovery documents. Both Applicant as well as Opposer were both only able to serve discovery requests on December 1, 2008, which resulted in the discovery exchange of requests and responses being pushed back past the deadline for discovery pursuant to Trademark Rule 2.126. As such, the danger of prejudice to the non-moving party is not at issue. In fact, the reopening of discovery will benefit both parties as Applicant has heretofore received email correspondence from Opposer's attorney inquiring as to details of Applicant's responses. Applicant believes it only fair that these inquiries be dealt with in the realm of discovery.

The length of delay that would result in the reopening in discovery is only slight. Applicant requests an additional sixty (60) days to conduct further discovery. If both parties are allowed to conduct additional discovery or merely finish the discovery that is still in progress, not only is there a chance that the case could settle but this will allow the following trial phases to proceed smoothly.

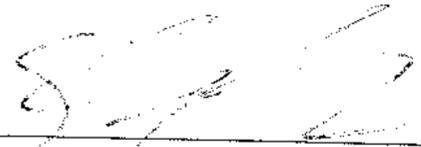
The reason for the delay in this case was not within reasonable control of the movant and movant has proceeded in good faith. Applicant was only made aware of the need for additional discovery upon receipt of Opposer's responses to its discovery demands. Had Opposer sent its responses prior to the deadline for discovery, Applicant may have had time to draft supplemental demands.

Applicant has acted in good faith throughout this entire proceeding and merely wishes to conduct a fair evaluation of all facts necessary to help provide a reasonable outcome to this matter.

For the foregoing reasons, Applicant respectfully requests that discovery be reopened.

Dated: New York, New York
February 2, 2009

Respectfully submitted,



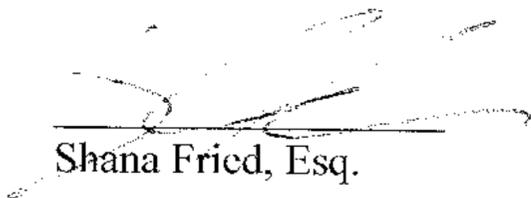
Shana Fried, Esq.
MARTINEZ LAW
Attorneys for Applicant
WHALE WASH, LLC.
76 Ninth Avenue, Suite 1110
New York, New York 10011
(212) 566-4500
(212) 566-4542 (fax)

CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing First Request For Production of Documents to be served upon:

James F. Keenan, Jr., Esq.
John G. Osborn, Esq.
BERNSTEIN, SHUR, SAWYER & NELSON
100 Middle Street
Portland, ME 04104

by placing same in an envelope, properly sealed and addressed, with postage prepaid and depositing same with the United States Postal Service on this 2nd day of February, 2009.


Shana Fried, Esq.