

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

GCP

Mailed: June 21, 2013

Opposition No. 91189169

Natural Couture, Inc.

v.

Xtreme Couture, Inc.

**Before Taylor, Wellington, and Kuczma,  
Administrative Trademark Judges.**

**By the Board:**

Xtreme Couture, Inc. ("applicant") seeks to register the mark XTREME COUTURE, in standard characters, for "vests; sweat bands; wrist bands; sports bra; headbands; rash guards; denim jackets; denims; athletic footwear; footwear; moisture-wicking sports pants; moisture-wicking sports shirts; underarm clothing shields; socks" in International Class 25."<sup>1</sup>

As grounds for the opposition, Natural Couture, Inc. ("opposer") claims priority of use and likelihood of confusion with its previously used and registered mark XTREME COUTURE, in standard characters, for "operation of training centers in the fields of fitness, exercise, and

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<sup>1</sup> Application Serial No. 77464760, filed on May 2, 2008, claiming a *bona fide* intention to use the mark in commerce under Trademark Act § 1(b).

mixed martial arts; providing classes, workshops, and seminars in the fields of fitness, exercise, and mixed martial arts; providing a website featuring information in the fields of fitness, exercise, and mixed martial arts training" in International Class 41.<sup>2</sup> At the time the notice of opposition was filed, opposer also pleaded ownership of pending application Serial No. 77133509 for the mark XTREME COUTURE, in standard characters, for "stickers" in International Class 16;<sup>3</sup> and pending application Serial No. 77133509, in standard characters, for "gym bags" in International Class 18.<sup>4</sup> Both of these pleaded pending applications, however, matured into registrations during the course of this proceeding, i.e., Registration No. 3771998 (issued on April 6, 2012, claiming October 23, 2008 as both the date of first use and the date of first use in commerce) and Registration No. 3592882 (issued on May 17, 2009, claiming March 16, 2007 as the date of first use and May 27, 2007 as the date of first use in commerce), respectively.

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<sup>2</sup> Registration No. 3485724, issued on August 12, 2008, claiming February 2007 as both the date of first use and the date of first use in commerce.

<sup>3</sup> Filed on March 16, 2007, claiming a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act.

<sup>4</sup> Filed March 16, 2007, claiming a bona fide intention to the mark in commerce under Section 1(b) of the Trademark Act.

On July 14, 2009, applicant filed its answer to the notice of opposition denying the salient allegations asserted therein.

On December 28, 2012, the Board sent opposer an order to show cause under Trademark Rule 2.128(a)(3), 37 CFR § 2.128(a)(3), because the time for opposer to file its main brief, which was due on December 8, 2012, had expired and no brief had been filed. Opposer filed a response,<sup>5</sup> and applicant replied thereto. We also note that opposer's testimony period (the time in which opposer was to submit evidence in support of its claim) closed on June 26, 2012, as last reset, and that opposer did not file any evidence or take any testimony during its assigned testimony period, or request an extension of time within which to do so. We further note that opposer did not submit status and title copies of its pleaded registration and pleaded pending applications, or acceptable copies thereof from the Office's electronic databases, as exhibits to its notice of opposition.

In its response to the Board's December 28, 2012 show cause order, opposer maintains that, since the issuance of the show cause order, the parties have held multiple settlement conferences and that the parties continue to be

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<sup>5</sup> Opposer's counsel's change of correspondence address filed on January 28, 2013 is noted. Board records have been updated accordingly.

involved in intensive settlement negotiations which opposer expects to reach fruitful resolution in the near future. In view of such continued settlement negotiations, opposer requests an additional ninety-day suspension of this case and to reset trial dates, beginning with the deadline for the parties' required discovery conference, to allow the parties to pursue discovery and to discuss ongoing settlement.<sup>6</sup>

In its response, applicant states that it is not aware of any settlement discussions that have taken place in this matter for at least the last six months. Accordingly, applicant maintains that since opposer has not been diligent in this matter in that no discussion of settlement has taken place in the past six months with the real party in interest, opposer's request to suspend and to reset trial dates upon resumption should be denied for lack of a showing of good cause. Additionally, applicant requests that the opposition be dismissed for lack of diligent prosecution. In support of its response, applicant has submitted the declaration of Janet Kaufman, applicant's current attorney of record,<sup>7</sup> wherein Ms. Kaufman declares that (1) Michael Bassiri was the former counsel for applicant, an affiliate

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<sup>6</sup> As addressed later in this order, opposer's request is being construed as one to reopen discovery and trial dates, beginning with the deadline for the parties' discovery conference.

<sup>7</sup> Applicant's change of correspondence address filed on February 9, 2013 is noted. Board records have been updated accordingly.

company of Affliction Holdings LLC ("Affliction"), (2) Mr. Bassiri left the employment of Affliction in August of 2012, and at that time she was retained to handle trademark and other corporate matters for Affliction and for affiliated companies sharing the same ownership, including applicant herein, and (3) she has not received any communications from opposer's counsel in this matter since being retained by Affliction and has never engaged in any settlement negotiations in this matter.<sup>8</sup>

**The show cause order for failure to file a brief is discharged.**

The purpose of Trademark Rule 2.128(a)(3) is to save the Board the burden of determining a case on the merits where the parties have settled, but have neglected to notify the Board thereof, or where the plaintiff has lost interest in the case. It is not the policy of the Board to enter judgment against a plaintiff for failure to file a main brief on the case if the plaintiff still wishes to obtain an adjudication of the case on the merits. See TBMP § 536 (3d ed. rev. 2012). If a show cause order is issued under Trademark Rule 2.128(a)(3) and the plaintiff files a

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<sup>8</sup> It is unclear from Ms. Kaufman's declaration as to which company applicant is referring to as "the real party" in interest. Notwithstanding, the Board assumes that this party is either Afflictions Holdings LLC, an affiliated company of applicant, or applicant inasmuch as Ms. Kaufman has declared that she represented both entities on trademark and other corporate matters and, in that capacity, did not receive any communications from opposer's counsel regarding settlement since she was retained as counsel.

response indicating that it has not lost interest in the case, the show cause order will be discharged, and judgment will not be entered against the plaintiff for failure to file a main brief.

Here, it is clear that opposer has not lost interest in this case. Accordingly, the order to show cause under Trademark Rule 2.128(a)(3), dated December 28, 2012, is discharged and judgment will not be entered against opposer based on a loss of interest in this case. As discussed below, the fact that an order to show cause for failure to file a brief has been discharged because the plaintiff indicated it has not lost interest in the case does not necessarily result in acceptance of a late-filed brief or in a resetting of the time to file the brief.

**Opposer's motion to suspend this case for settlement and upon resumption reset all trial dates, beginning with the deadline for the parties' required discovery conference, is denied.**

Opposer has asked that the Board suspend this case for ninety days so that the parties may continue with their settlement negotiations and upon resumption to reset all trial dates, beginning with the deadline for the parties' required discovery conference. Broadly construed, opposer asks that discovery, as well as the trial and briefing periods be reopened.

The requisite showing to be made by a party seeking to reopen an expired period, pursuant to Fed. R. Civ. P.

6(b)(1)(B), is that of excusable neglect.<sup>9</sup> See also TBMP §§ 509.01(b)(1), 534 and 536 (3d ed. rev. 2012). Even where a plaintiff has shown that it is still interested in having the Board decide the case on its merits, and the show cause order under Trademark Rule 2.128(a)(3) has been discharged, unless the plaintiff has included with its response a motion to reopen its time for filing its brief, as opposer did here, and has shown the requisite excusable neglect, the plaintiff may not be accorded a second chance to file a brief. See TBMP § 536 (3d ed. rev. 2012).

There are four factors to be considered, within the context of all the relevant circumstances, to determine whether a party's neglect of a matter is excusable. They are: (1) the danger of prejudice to the non-moving party; (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 moving party; and, (4) whether the moving party has acted in good faith. See *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380, 395 (1993). Several courts have stated that the third factor may be considered the most important factor in

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<sup>9</sup> The Board construes a motion to extend an expired time as a motion to reopen such period. See TBMP § 509.01 (3d ed. rev. 2012).

any particular case. See *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 at fn.7 (TTAB 1997).

Applying the *Pioneer* analysis, there does not appear to be measurable prejudice to applicant should the Board reopen discovery, trial dates and/or time to file briefs on the case. That is, there is no showing by applicant of lost evidence or unavailable witnesses, or that applicant would be handicapped at trial. See *Pratt v. Philbrook*, 109 F.3d 18, 22 (1st Cir. 1997); *Paolo Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899, 1904 (Comm'r 1990).

As to the second *Pioneer* factor, a reopening of discovery, which closed approximately ten months prior to opposer's request to reopen, and a reopening of opposer's testimony period, which closed approximately seven months prior to opposer's request to reopen that period, would cause substantial delay to this opposition. A reopening of the time to file a brief, and its potential impact on judicial proceedings, would cause a less significant delay.

With respect to the third *Pioneer* factor, *i.e.* the reason for the delay and whether it was within opposer's control, and opposer's excuse that it sought to settle the proceeding, while attempts at settlement are favored, they do not excuse an opposer's failure to act within the prescribed times. See *Atlanta-Fulton County Zoo Inc. v. DePalma*, 45 USPQ2d 1858, 1859 (TTAB 1998) (the belief in

settlement and/or the existence of settlement negotiations do not justify a party's inaction or delay or excuse it from complying with the deadlines set by the Board or imposed by the rules.) Moreover, in this case, it does not appear that the parties were engaged in any meaningful settlement discussions. In fact, in its response to the Board's January 28, 2012 show cause order, opposer concedes that, although the parties have been engaged in protracted settlement negotiations for many months involving highly complex business disputes, only a small part of such discussions involved the trademarks at issue in this case. See Opposer's January 28, 2013 response, fn 1. Further, applicant, by way of Ms. Kaufman's declaration, has stated that the parties have not engaged in any settlement negotiations in the six months prior to opposer's request to reopen. Additionally, opposer has failed to submit any evidence to substantiate its claim that the parties have been engaged in ongoing settlement negotiations regarding the issues in this proceeding. Under these circumstances, opposer's explanation that its failures to take testimony and file a brief (or obtain an extension of the deadlines for doing so) were due to settlement negotiations is not persuasive. Opposer brought this opposition and, accordingly, has the burden of prosecuting its case. Opposer could, and should, have sought extensions of its

testimony period before the period closed, and opposer could, and should, have sought an extension of its time to file a brief before such time expired. The Board finds that the reasons relied upon by opposer for its failures to act prior to the close of its testimony period, and prior to the expiration of its time to file its main brief, were within opposer's reasonable control. The purported existence of settlement discussions simply did not prevent opposer either from taking testimony during the assigned period or filing a timely brief, or filing timely requests to extend either period prior to the expiration of the period.

As to the fourth *Pioneer* factor, there is no evidence that opposer was acting in bad faith.

After careful consideration of the *Pioneer* factors and the relevant circumstances in this case, the Board finds that opposer's reasons for not actively participating in this case fail to establish excusable neglect, and do not warrant a reopening of this case for taking discovery, the presentation of evidence and/or a reopening of opposer's time to file its main brief. Although the first and fourth *Pioneer* factors do not weigh against opposer, the second and third factors weigh heavily against opposer.

Accordingly, opposer's request to suspend this case for settlement and upon resumption reopen all trial dates,

beginning with the deadline for the parties' required discovery conference, is DENIED.<sup>10</sup>

Because we have denied opposer's motion to reopen in all respects, and because the Board's order to show cause issued prior to the due date for applicant's brief, were there any need to resume this proceeding we would do so by resetting the time for applicant to file its brief.

However, inasmuch as opposer has failed to submit any evidence to support its asserted claim of priority and likelihood of confusion, as well as its standing, there is no need to obtain a brief on the merits from applicant.

Further, since opposer has failed to submit any evidence to support its standing and asserted claim of priority and likelihood of confusion<sup>11</sup> and because there are no material admissions of fact made by applicant, the current record does not establish a *prima facie* case for opposer. That is, opposer has failed to meet its burden of proving its standing, as well as its claim of priority and likelihood of confusion.

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<sup>10</sup> The Board notes that it has previously advised opposer that the Board will not suspend proceedings for settlement until the parties conduct their discovery conference since one of the purposes of the discovery conference is to discuss settlement. See Board orders dated January 3, 2011 and September 14, 2011.

<sup>11</sup> As noted *supra*, opposer did not submit status and title copies of its pleaded registration or pending applications, or acceptable copies thereof from the Office's electronic databases, as exhibits to its notice of opposition.

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Accordingly, judgment is hereby entered against opposer and the opposition is hereby dismissed with prejudice.