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

Proceeding	91192099
Party	Defendant McSweet, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of:
Application Serial No. 77/722,272
Published in the *Official Gazette*
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McDONALD's CORPORATION,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91192099
)	
McSWEET, LLC,)	
)	
Applicant.)	

APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR AN EXTENSION OF TIME TO SERVE RESPONSES TO APPLICANT'S FIRST SET OF REQUESTS FOR ADMISSION TO OPPOSER

Applicant, McSWEET, LLC, respectfully submits this opposition to Opposer's Motion for an Extension of Time to Serve Responses to Applicant's First Set of Requests for Admission to Opposer submitted the day Opposer's responses to Applicant's First Set of Requests for Admission to Opposer were due.

Ordinarily, Applicant would not oppose a motion for a one-day extension of time to file discovery responses and it is loathe to burden the interlocutory attorney with this seemingly unnecessary motion practice; however, as will be more thoroughly addressed, *infra*, three issues in combination inveigh against such ordinary flexibility: 1) it is clear in Fed. R. Civ. P. 36(a) and TBMP § 407.03(a)¹ that timely responses to requests for admission is mandatory or the requests will stand admitted; 2) in its motion, Opposer misrepresented Applicant's response to its initial, informal request for a stipulated extension to a degree that is objectionable; and 3)

¹ Trademark Trial and Appeal Board Manual of Procedure (TBMP) Second Edition, June 2003, Revision 1, March 2004.

Opposer thereafter proceeded to provide written responses to the subject requests that are, to a significant extent, so egregiously inadequate as to be no responses at all.

I. Pertinent Facts.

On August 30, 2010, Applicant served Opposer with Applicant's First Set of Requests for Admission to Opposer. Affidavit of Katherine Hendricks in Support of Applicant's Opposition to Opposer's Motion for an Extension of Time to Serve Responses to Applicant's First Set of Requests for Admission ("Hendricks Aff.") ¶ 2, Exh. 1.

On October 4, 2010, the date Opposer's responses to Applicant's First Set of Requests for Admissions to Opposer were due, Lawrence James, Jr., ("Mr. James") one of the attorneys for Opposer, left a voicemail message for Katherine Hendricks ("Ms. Hendricks"), one of the attorneys for Applicant, requesting an extension of time of one day for Opposer's responses to Applicant's Requests for Admission because he represented that his client was at a conference the prior week and was therefore unable to review the responses. Hendricks Aff. ¶ 4, Exh. 2.

Mr. James thereafter sent a follow-up email to Ms. Hendricks and Caitlin A. Bellum ("Mrs. Bellum"), another attorney for Applicant, requesting Hendricks & Lewis' consent for a one-day extension as well as a response by 5:00 CST. Hendricks Aff. ¶ 5. Both Ms. Hendricks and Mrs. Bellum were out of the office on October 4, 2010, and did not receive either the voice mail messages or the emails. Hendricks Aff. ¶ 3; Affidavit of Mark Washburn in Support of Applicant's Opposition to Opposer's Motion for an Extension of Time to Serve Responses to Applicant's First Set of Requests for Admission ("Washburn Aff.") ¶ 3.

Mr. James called Hendricks & Lewis and spoke with paralegal Mark Washburn ("Mr. Washburn"), who notified Mr. James that Ms. Hendricks was out of the office for the day and Mrs. Bellum was out of the office for the week. Washburn Aff. ¶ 3; Hendricks Aff. ¶ 3.

On October 4, 2010, Opposer filed its Motion for an Extension of Time to Serve Responses to Applicant's First Set of Requests for Admissions to Opposer. DN 22.

On October 5, 2010, Opposer served on Applicant its Responses to Applicant's First Set of Requests for Admissions to Opposer. Hendricks Aff. ¶ 6, Exh. 3.

1. Opposer has failed to show good cause necessary to grant its motion to extend.

A motion to extend time must set forth, with particularity, the facts said to constitute good cause for the requested extension. See Fed. R. Civ. P. 6(b); 37 CFR § 20127(a); TBMP § 509.01(a). Mere conclusory allegations lacking in factual detail are not sufficient. *Instruments SA Inc. v. ASI Instruments Inc.*, 53 U.S.P.Q.2d 1925, 1927 (TTAB 1999) (conclusory allegations not supported by the record did not constitute a showing a good cause); *HKG Industries, Inc. v. Perma-Pipe, Inc.*, 49 U.S.P.Q.2d 1156, 1158 (TTAB 1998) (motion to reopen denied because movant failed to provide detailed evidence and factual information in support of requested relief); and *Johnson Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 U.S.P.Q.2d 1719, 1720 n. 3 (TTAB 1989) ("The presentation of one's argument and authority should be presented thoroughly in the motion or the opposition brief thereto."). The Board will "scrutinize carefully" any motion to extend time to determine whether or not requisite good cause has been shown. *Luemme, Inc. v. D. B. Plus Inc.*, 53 U.S.P.Q.2d 1758 (TTAB 1999); See *Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 63 FR at 48086 (1998), 1214 TMOG at 149 (September 29, 2998).

Opposer has failed to plead particular facts showing good cause to support its request to extend time to respond to Applicant's Requests for Admission. In fact, Opposer did not offer any facts as to why an extension was needed. Opposer offers only the assertion that Applicant will not be prejudiced by the extension. However, such a statement is merely conclusory and

lacks sufficient factual details required under the standard.

To the extent Opposer seeks to extend its time to respond the very day such responses were due and without providing explanation as to why the extension is needed is insufficient to establish good cause.

2. Opposer's request for the extension of time was necessitated by its own lack of diligence.

A party moving to extend time must demonstrate that the requested extension of time is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefore. *See Luemme, Inc. v. D. B. Plus Inc.*, 53 U.S.P.Q.2d at *3 (diligence not shown when discovery requests to extend were not served until the last day of the discovery period); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 U.S.P.Q.2d 1848, 1851 (TTAB 2000) (applicant's motion to extend discovery was denied when counsel knew of unavailability of witness a month before, yet delayed until the last day to seek an extension of time).

As required under TBMP § 407.03(a), Opposer had thirty days, including five extra days if service is made by first-class mail or overnight courier, in which to respond to Applicant's Requests for Admission. However, it wasn't until two o'clock on the afternoon of October 4, 2010, the day the responses were due, that Opposer elected to contact Applicant's counsel to request an extension of time. *Hendricks Aff.* ¶¶ 4-5; *Washburn Aff.* ¶ 3. Opposer's counsel's message explained that a one-day extension was needed because Opposer had been in a conference the prior week and did not have time to review the responses to Applicant's requests. *Hendricks Aff.* ¶ 4, Exh. 1. Opposer's explanation was never pleaded within Opposer's motion, but even if it were, such explanation clearly illustrates that the extension was necessary only because Opposer and Opposer's counsel failed to be reasonably diligent in prioritizing TTAB

deadlines.

Opposer's counsel had four weeks to communicate with Opposer, but, without good cause, delayed until the afternoon of the last day to seek an extension.

Opposer's assertion that it sought Applicant's consent for the extension but that Applicant did not respond is misleading. Opposer sought Applicant's consent for this extension at approximately 2:00 PM PST (or 5:00 PM EST), the actual time responses were due. Hendricks Aff. ¶¶ 4-5. Both Ms. Hendricks and Mrs. Bellum were then out of the office and not expected to return and Opposer's counsel was informed of their absence and status by Mr. Washburn, the firm's paralegal. Hendricks Aff. ¶ 3; Washburn Aff. ¶ 3. It was not that Applicant failed to respond but that Opposer never gave Applicant a reasonable opportunity to respond.

3. Opposer should not receive an extension of time to produce unwarranted, insufficient and inappropriate responses to Applicant's First Set of Requests for Admission.

Opposer's responses to Applicant's Requests for Admission Nos. 1, 2, 10, 11, 16, 17, 60-64, 66-70, 72-76, 78-82, 84-88, 90-94, 96-100, and 103 are unreasonable and not propounded in good faith pursuant to FED. R. CIV. P. 36(a). Such unwarranted and inappropriate answers to the requests at issue do nothing to advance Opposer's legitimate interests or this matter. In fact, this approach simply unnecessarily drives up expenses of discovery. "Each party has a duty . . . to make a good faith effort to satisfy the discovery needs of its adversary . . ." TBMP § 402.01. Opposer's glib responses are a conspicuous effort to frustrate the discovery process and, as an unfortunate result, warrant this opposition.

Applicant served requests for admission because it properly seeks to narrow the scope of triable issues and streamline the *inter partes* proceeding that results from such discovery. To that end, and in defense of its application, Applicant is entitled to frame discovery requests that

delineate and distinguish the very different channels of trade that exist for Applicant's pickled asparagus product in contrast with those of McDonald's fast-food restaurant products and services.

For example, Applicant requested in Request for Admission No. 1 that Opposer: "Admit that Opposer does not promote, offer, and distribute goods under its Marks to liquor stores." "Liquor store" was defined for purposes of the requests as "means a store that specializes in the sale of alcoholic beverages." Hendricks Aff. ¶ 3, Exh. 1, p. 5 ¶ 10. After objections, Opposer responded: ". . . McDonald's states that it promotes, offers and distribute goods to all classes of consumers including proprietors, owners, and employees of liquor stores, and therefore denies that it does not promote, offer and distribute goods under its marks to liquor stores." Hendricks Aff. ¶ 6. Exh. 3, pp. 3-4.

Similarly, Applicant asked Opposer to admit that it does not sell McGriddles breakfast sandwiches to liquor stores. Opposer responded, in relevant part, that it "admits that it does not sell products under its McGRIDDLES mark in liquor stores. McDonald's further answers that it sells McGRIDDLES branded products to all classes of consumers, including proprietors, owners, and employees of liquor stores, and therefore denies that it does not sell McGRIDDLES branded products to liquor stores" Hendricks Aff. ¶ 6. Exh. 3, p. 35.

Pursuant to FED. R. CIV. P. 36(a)(4) "[a] denial must fairly respond to the substance of the matter; and when good faith request that a party qualify an answer or deny only a part of a matter, the answer must *specify* the part admitted and qualify or deny the rest." (emphasis included). By Opposer's reasoning, whoever walks into a McDonald's fast-food restaurant and thereafter returns to work—whether to a machine shop, an accounting office, a laundromat or a tire service center—that work place spontaneously becomes an establishment to which

McDonald's sells McGriddle breakfast sandwiches. The fact that McDonald's seeks an extension of time only to provide disingenuous responses is a glimpse into the arrogance of McDonald's conduct in *inter partes* proceedings. Opposer gives largely similar responses to Applicant's request regarding whether it sells its McMuffin, McChicken, McDouble and McRib sandwiches, its McSkillet burrito, its McCafe coffee drink and its McFlurry candy and ice cream dessert to liquor stores, bars, specialty stores, gourmet stores or grocery stores. Hendricks Aff. ¶ 6. Exh. 3, pp. 20-43.

Thus, Opposer should not receive an extension of time to make such inappropriate responses to Applicant's requests.

WHEREFORE, Applicant respectfully requests that the Board enter an Order denying Opposer's Motion for an Extension of Time to Serve Responses to Applicant's First Set of Requests for Admission to Opposer.

Respectfully submitted,

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Dated: October 25, 2010

CERTIFICATE OF SERVICE

I hereby certify that on October 25, 2010, I served a true and complete copy of the foregoing APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR AN EXTENSION OF TIME TO SERVE RESPONSES TO APPLICANT'S FIRST SET OF REQUESTS FOR ADMISSIONS TO OPPOSER via email and First Class U.S. Mail, postage pre-paid, upon:

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