

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

Baxley

Mailed: December 19, 2011

Opposition No. 91200535

Sanford J. Asman

v.

Integrated Imaging, LLC

**Andrew P. Baxley, Interlocutory Attorney:**

On December 7, 2011, opposer filed a combined motion to reset dates herein and to suspend this proceeding pending disposition of a civil action styled *Sanford J. Asman v. Integrated Imaging, LLC*, Case No. 1:11-cv-04206-RWS, filed in the United States District Court for the Northern District of Georgia. In the interest of resolving such motion without undue delay, the Board determined that a telephone conference was warranted. See Trademark Rule 2.120(i)(1); TBMP Section 502.06(a) (3d ed. 2011). On December 16, 2011, such conference was held between opposer Sanford J. Asman, applicant's attorneys Charles S. Sara and Joseph A. Ranney, and Board attorney Andrew P. Baxley. Opposer confirmed during the telephone conference that his motion to reset dates is actually one to reopen his time in which to serve discovery responses.

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Turning to the motion to suspend, the Board's general practice is to suspend proceedings before it when any party to a pending Board proceeding is involved in a civil action which may have a bearing on the Board case. See Trademark Rule 2.117(a). Although the USPTO has expertise in determining trademark registrability, such determinations are is not within the USPTO's exclusive jurisdiction. See *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn. 1986). To the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding, the district court's findings are binding on the Board, whereas the Board's findings are merely advisory to the district court. See *id.*; TBMP Section 510.02(a) (3d ed. 2011).

In the above-captioned opposition proceeding, opposer has opposed registration of applicant's involved mark under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). In the civil action, opposer's claims include trademark infringement and false designation of origin. The civil action is not necessarily dispositive of this proceeding. See, e.g., *Jet Inc. v. Sewage Aeration Systems*, 223 F3d 1360, 55 USPQ2d 1854, 1857 (Fed. Cir. 2000) (civil actions for trademark infringement and cancellation proceedings involve different transactional facts). Nonetheless, the district court's findings with regard to opposer's claims

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therein may have a bearing upon opposer's Section 2(d) claim in this proceeding and would be binding upon the Board.<sup>1</sup>

Accordingly, in the interests of judicial economy and of avoiding potentially inconsistent results, the Board finds that the civil action may have a bearing upon this proceeding and that suspension of this case pending final disposition, including any appeals or remands, of Case No. 1:11-cv-04206-RWS is warranted, and applicant's motion to suspend is granted. Proceedings are suspended pending final determination, including any appeals or remands, of Case No. 1:11-cv-04206-RWS.<sup>2</sup>

The Board will make annual inquiry as to the status of Case No. 1:11-cv-04206-RWS. Within twenty days after the final determination thereof, applicant should notify the Board so that this case may be called up for appropriate action. During the suspension period, the Board should be

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<sup>1</sup> In addition, opposer asks in its complaint in the civil action for the "cancellation" of applicant's involved application. Although not expressly stated in the complaint, opposer apparently seeks therein refusal of registration of applicant's involved in the civil action under Trademark Act Section 37, 15 U.S.C. Section 1119. Section 37 states as follows: "In any action involving a **registered mark** the court may determine the right to registration, order the cancellation of registrations, in whole or in part, restore cancelled registrations, and otherwise rectify the register with respect to the registrations of any party to the action." "[A] Section 37 claim must involve an existing 'registered mark,' not one that may come into existence in the future." *Dunn Computer Corp. v. Loudcloud Inc.*, 57 USPQ2d 1626, 1633 (E.D. Va. 2001). See also *Johnny Blastoff Inc. v. Los Angeles Rams Football Co.*, 51 USPQ2d 1920 (7th Cir. 1999).

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notified of any address changes for the parties or their attorneys.

Notwithstanding the foregoing, the Board will decide opposer's motion to reopen time in which to serve discovery responses. Applicant served its discovery requests by mail on October 15, 2011, thus making November 19, 2011 the due date for responses thereto.<sup>3</sup> See Trademark Rules 2.119(c) and 2.120(a)(3); TBMP Section 403.03. Thus, for the Board to grant the motion to reopen, opposer must establish that his failure to act prior to the expiration of his time in which to serve such responses was caused by excusable neglect. See Fed. R. Civ. P. 6(b)(1)(B); TBMP Section 509.01(b).

In *Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), the Supreme Court clarified the meaning and scope of "excusable neglect," as used in the Federal Rules of Civil Procedure and elsewhere. The Court held that the determination of whether a party's neglect is excusable is:

at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include. . . [1] the

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<sup>2</sup> If the district court orders suspension of Case No. 1:11-cv-04206-RWS to allow the above-captioned opposition to go forward, the Board will entertain a motion to resume this proceeding.

<sup>3</sup> Because November 19, 2011 was a Saturday, opposer could have timely served discovery responses on November 21, 2011.

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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 Co. v. Brunswick Associates L.P.*, 507 U.S. at 395. In subsequent applications of this test, several courts have stated that the third *Pioneer* factor, namely the reason for the delay and whether it was within the reasonable control of the movant, might be considered the most important factor in a particular case. See *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d at 1586, fn.7 and cases cited therein.

Turning initially to the third *Pioneer* factor, opposer states that he is a sole practitioner representing himself and with no associate attorneys and that he was out of his office between mid-October and November 30, 2011 due to an illness that he described in detail in his motion.<sup>4</sup> Thus, the Board finds that opposer's failure to timely respond to discovery requests was caused by his illness and that such illness was beyond his control. Cf. *HKG Industries Inc. v.*

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<sup>4</sup> Although the Board noted that Board records indicate that opposer filed documents on behalf of clients on October 12, 14, and 18, 2011, he explained in the conference that he so filed only on an "emergent basis." Although applicant's attorney notes in a December 2, 2011 letter to opposer that opposer did not include "a doctor's excuse or similar evidence" in a November 30, 2011 letter regarding opposer's illness, the Board notes that opposer filed his motion pursuant to Patent and Trademark Office Rule 11.18(b). Further, the Board expects parties to cooperate in the discovery process. See TBMP Section 408.01.

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*Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (1997) (no excusable neglect found where movant provided no factual details as to the date of counsel's death in relation to its testimony period or as to why other lawyers in deceased counsel's firm could not have assumed responsibility for the case). Accordingly, the Board finds that this factor weighs in favor of a finding of excusable neglect.

With regard to the second *Pioneer* factor, the Board notes that opposer sent to a letter to applicant's attorney on his first day back to work, eight days after his discovery responses became past due, and that he filed his combined motion to suspend and reopen a week after that, with more than three months remaining in the discovery period. Thus, the Board finds that the delay caused by opposer's failure to timely respond to discovery, and the impact of that delay upon this proceeding, is insignificant.

Further, with regard to the first *Pioneer* factor, there is no indication of any prejudice to applicant beyond its loss of the tactical advantage of having its requests for admissions deemed admitted by operation of law.<sup>5</sup> See Fed. R. Civ. P. 36(a)(3); *Pratt v. Philbrook*, 109 F.3d 18 (1st

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<sup>5</sup> A party that fails to timely respond to interrogatories and document requests does not by operation of applicable rules automatically forfeit the right to object on the merits thereto. Rather, such forfeiture may only be found upon motion to compel filed by the propounding party. See *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000); TBMP Section 403.03.

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Cir. 1997). In addition, with regard to the fourth *Pioneer* factor, there is no indication that opposer acted in bad faith. Based on the foregoing, the Board finds that opposer's failure to timely respond to applicant's discovery requests was caused by excusable neglect.

Accordingly, opposer's motion to reopen time to serve discovery responses is granted. If necessary, opposer's time to serve his discovery responses will be reset upon resumption of this proceeding. Proceedings are otherwise suspended in accordance with the foregoing.