

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

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Mailed: October 10, 2012

Opposition No. 91200575

Hershey Chocolate &
Confectionery Corporation and
The Hershey Company

v.

Kenneth B. Wiesen

Yong Oh (Richard) Kim, Interlocutory Attorney:

On October 4, 2012, the Board held a telephone conference to hear argument and rule on applicant's motion (filed September 4, 2012) to extend his time to respond to opposers' motion (filed August 9, 2012) to strike. Paul C. Llewellyn, Esq., appeared as counsel for opposers and Kenneth B. Wiesen, Esq., appeared *pro se* as the party defendant in this matter.

On May 30, 2012, opposers filed a consented motion to extend the remaining dates in this proceeding. Under the parties' newly proposed schedule, expert disclosures were due on July 9, 2012, and discovery was set to close on August 9, 2012. Both parties served their expert disclosures on July 9, 2012. On August 9, 2012, opposers

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filed a motion to strike applicant's expert disclosure citing various deficiencies. Opposers served the motion on applicant by e-mail and first class mail on August 9, 2012.

On September 4, 2012, applicant filed a one-page motion to extend his time to respond to the motion to strike. In support of his motion, applicant notes that he is "a sole practitioner and I have been out of the state." Applicant further states that opposers have declined to consent to an extension notwithstanding that "[o]n all prior occasions [applicant has] consented to additional time for opponent."

Pursuant to Trademark Rule 2.127(a), a brief in response to a motion is due within fifteen days of service of the motion unless another time is specified by the Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. For motions served via first-class mail, "Express Mail," or overnight courier, the responding party is allowed an additional five days to respond. Trademark Rule 2.119(c). As opposers' motion to strike was served on August 9, 2012, applicant's response was due no later than August 29, 2012. However, applicant filed his motion to extend on September 4, 2012. Since applicant's motion was made after the close of applicant's

time to respond, applicant's request is more properly viewed as one seeking to reopen time as opposed to extending it and has been construed as such. See *Vital Pharmaceuticals, Inc. v. Kronholm*, 99 USPQ2d 1708, 17010 n.10 (TTAB 2011).

Under Fed. R. Civ. P. 6(b)(1)(B), in order to reopen his now-expired time to respond to opposers' motion, applicant must establish that his failure to timely respond was due to "excusable neglect." See *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."). As the Board stated in *Baron Philippe*:

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, 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.

As noted by the Board during the telephone conference, applicant has failed to provide any reason for his delay in responding to the motion that would qualify as good cause let alone excusable neglect. While applicant made much during the conference of being "strung along" by opposers in discovery and being falsely led to believe that opposers were being cooperative in the discovery process, such contentions, even if true, have no bearing on applicant's failure to timely respond to the outstanding motion or to otherwise preserve his right to respond. Indeed, opposers note that applicant only contacted opposers seeking an extension after the deadline had already passed. *Opposer's Response*, p. 2. While applicant is *pro se*, he is also a practicing attorney. As such, applicant should be aware of the dates that have been set in this proceeding and their import. In view thereof, applicant's motion for an extension of time to respond to opposers' motion to strike is hereby **DENIED**.

Turning then to opposers' motion to strike applicant's expert disclosure, opposers contend that the report is deficient because it was neither prepared nor signed by the

expert witness as required under Fed. R. Civ. P. 26(a)(2)(B) and fails to specify the witness's expert qualifications. Opposers further contend that applicant's proposed expert "never even saw the purported expert disclosure that [applicant] prepared and signed [and therefore] the disclosure cannot be viewed as expressing [the witness's] opinions, nor the facts or data that [the witness] considered." *Id.*, pp. 4-5. Finally, opposers contend that they informed applicant of these deficiencies in a July 23, 2012, e-mail to applicant to which applicant failed to respond.

Trademark Rule 2.120(a)(2) provides that the disclosure of expert testimony "must occur in the manner and sequence provided in Federal Rule of Civil Procedure 26(a)(2)" which in turn provides as follows:

(B) *Witnesses Who Must Provide a Written Report.* Unless otherwise stipulated or ordered by the court, this disclosure must be accompanied by a written report - prepared and signed by the witness - if the witness is one retained or specially employed to provide expert testimony in the case or one whose duties as the party's employee regularly involve giving expert testimony. The report must contain:

(i) a complete statement of all opinions the witness will express and the basis and reasons for them;

(ii) the facts or data considered by the witness in forming them;

(iii) any exhibits that will be used to summarize or support them;

(iv) the witness's qualifications, including a list of all publications authored in the previous 10 years;

(v) a list of all other cases in which, during the previous 4 years, the witness testified as an expert at trial or by deposition; and

(vi) a statement of the compensation to be paid for the study and testimony in the case.

That applicant's expert disclosure was deficient is apparent. It is also apparent that applicant has failed to supplement his disclosure or otherwise respond to opposers' e-mail highlighting the deficiencies in applicant's disclosure. "If a party fails to provide information or identify a witness as required by Rule 26(a) or (e), the party is not allowed to use that information or witness to supply evidence on a motion, at a hearing, or at a trial, unless the failure was substantially justified or is harmless." Fed. R. Civ. P. 37(c). This rule "provides a self-executing sanction for failure to make a disclosure required by Rule 26(a), without need for a motion under [Fed. R. Civ. P. 37] (a) (2) (A)" so long as such failure was without substantial justification or was harmless. Fed. R. Civ. P. 37 Notes of Advisory Committee on Rules - 1993 Amendment. Applicant bears the burden of demonstrating substantial justification or harmlessness. *See Carr v.*

Deeds, 453 F.3d 593, 602 (4th Cir. 2006). However, in failing to timely respond to opposers' motion, applicant has effectively waived his opportunity to carry his burden. Indeed, applicant recognized as much during the conference and further noted his indifference to the outcome of opposers' motion to strike, focusing instead on whether he would be allowed to pursue a motion to compel discovery from opposers. In view thereof, opposers' motion to strike applicant's expert disclosure is **GRANTED** and applicant is hereby precluded from presenting the expert testimony of Steve Rotterdam.

As alluded to *supra*, applicant is more concerned with obtaining full responses to discovery he had propounded prior to the close of discovery. On the other hand, opposers are opposed to reopening discovery and claim that to do so would unfairly prejudice opposers. As noted during the conference, the parties appear to be arguing different points. On the one hand, applicant is simply seeking leave to file a motion to compel responses to discovery that was already timely propounded. On the other hand, opposers are seeking to foreclose any further discovery related activity by keeping discovery closed. Applicant needs to neither reopen discovery nor obtain leave of the Board to file a motion to compel. A motion to

compel is timely if filed prior to the commencement of the first testimony period as originally set or as reset. Trademark Rule 2.120(e)(1). As last reset, the first testimony period opens on October 9, 2012. Therefore, applicant is free to file a motion to compel after making the requisite good faith effort¹ to resolve the discovery dispute that is the subject of his motion, and is not required to seek the Board's leave in order to do so. Furthermore, discovery need not be reopened for applicant to file a motion to compel discovery.

However, as noted during the conference, proceedings herein are **SUSPENDED until NOVEMBER 19, 2012**, for the sole purpose of affording applicant the opportunity to take discovery limited to opposers' designated expert witness. To be clear, the Board has not reopened general discovery for either party.

Finally, the parties have suggested that they are each considering filing a motion for summary judgment. The parties have also noted their desire to minimize costs and for a speedy resolution of this proceeding. Accordingly,

¹ As discussed during the conference, should applicant choose to file a motion to compel discovery, **any showing of good faith pursuant to Trademark Rule 2.120(e)(1) in support of a motion to compel must include correspondence from applicant to opposers detailing each of the perceived deficiencies in opposers' responses and a good faith meeting between the parties to try to resolve the discovery dispute.**

the parties are encouraged to consider and confer on availing themselves of the Board's Accelerated Case Resolution (ACR) procedure. Detailed information concerning this procedure may be found on the Board's website at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

Dates are **RESET** as follows:

Proceedings Resume	11/20/2012
Plaintiff's Pretrial Disclosures Due	12/20/2012
Plaintiff's 30-day Trial Period Ends	2/3/2013
Defendant's Pretrial Disclosures Due	2/18/2013
Defendant's 30-day Trial Period Ends	4/4/2013
Plaintiff's Rebuttal Disclosures Due	4/19/2013
Plaintiff's 15-day Rebuttal Period Ends	5/19/2013

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **THIRTY DAYS** after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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