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 24, 2013

Opposition Nos. **91203277 (parent)**
91203279

3D International, LLC

v.

Palm Beach Motoring
Accessories, Inc.

Yong Oh (Richard) Kim, Interlocutory Attorney:

This matter comes up on opposer's motion (filed May 27, 2013) seeking 1) to compel applicant's responses to opposer's discovery requests, 2) to find applicant's responses to interrogatories and document requests as untimely and, therefore, deem applicant to have waived its objections, 3) to deem applicant's responses to admission requests as untimely and, therefore, admitted as put, and 4) to extend discovery for an additional ten months. The motion is fully briefed.

As an initial matter, opposer acknowledges in its reply brief that it has received applicant's responses to opposer's outstanding discovery requests and states that its motion to compel such responses "is now moot." *Opposer's Reply*, p. 2. Accordingly, to the extent that opposer's

motion seeks to compel applicant's discovery responses, the motion will be given no further consideration.[1]

The Board now turns to the central issue at hand, i.e., the timeliness of applicant's responses to interrogatories, document requests and requests for admission. By way of background, opposer served its first set of discovery requests consisting of interrogatories, document requests and requests for admission on August 10, 2012.[2] On August 27, 2012, the parties agreed to allow applicant an additional thirty days to respond to opposer's discovery requests therefore resetting applicant's discovery response deadline to October 14, 2012.[3] *See* Trademark Rules 2.119(c) and 2.120(a)(3). On October 3, 2012, opposer served its second set of discovery requests also consisting of interrogatories, document requests and requests for admission. On October 15, 2012, applicant served and filed a motion for summary judgment. No discovery responses were provided. On November 8, 2012, opposer filed a consented

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[1] The Board notes, however, that the timing of opposer's motion to compel vis-à-vis applicant's responses to discovery undermine any certification of a good faith effort made by opposer to obtain discovery responses prior to the filing of its motion to compel per Trademark Rule 2.120(e).

[2] At the time, discovery, as reset on June 6, 2012, was scheduled to close on December 11, 2012.

[3] Opposer also filed on August 27, 2012, a consented motion to extend all remaining dates by thirty days, citing, as grounds therefor, settlement discussions and the parties' desire to allow additional time to respond to discovery.

motion to extend its time to respond to applicant's motion for summary judgment. The Board suspended proceedings on December 12, 2012, pending disposition of the summary judgment motion. The motion was decided on April 16, 2013, with leave granted to opposer to replead its fraud claim within twenty days of the Board's order. Applicant was allowed thirty days from the date of service of any amended pleading to serve and file its answer. Opposer served and filed an amended notice of opposition on May 3, 2013. By May 17, 2013, applicant served its responses to opposer's first and second sets of admission requests. On May 27, 2013, opposer served and filed its motion to compel. On May 28, 2013, applicant served the remainder of its discovery responses.

Notwithstanding, it is opposer's contention that applicant's discovery responses are untimely in that applicant's filing of its motion for summary judgment did not automatically suspend proceedings and, therefore, applicant remained obligated to respond to discovery until the Board formally suspended proceedings.

Decision

While it is true that the filing of a motion for summary judgment does not, in and of itself, automatically suspend proceedings in a case, *see Super Bakery Inc. v. Benedict*, 96 USPQ2d 1134, 1135 (TTAB 2010), such a filing

may provide a party with good cause for deferring or otherwise not complying with an outstanding obligation such as responding to discovery requests. *Cf. Leeds Technologies Limited v. Topaz Communications Ltd.*, 65 USPQ2d 1303, 1305-06 (TTAB 2002). In reviewing the record and the circumstances surrounding opposer's motion to compel, the Board does not find applicant's discovery responses to be untimely.

First, it is noted that October 14, 2012, fell on a Sunday. As such, applicant's responses to opposer's first set of discovery requests were due on October 15, 2012. *See* Trademark Rule 2.196. Since applicant served its motion for summary judgment on October 15, 2012, and since opposer did not serve its second set of discovery requests until October 3, 2012, it cannot be said that applicant's discovery responses were effectively due prior to the day on which applicant filed its motion.

Second, it appears that at the time of the filing of the motion for summary judgment, the parties were engaged in settlement discussions. On the same day as the filing of applicant's motion for summary judgment, opposer transmitted to applicant a settlement proposal and on November 6, 2012, applicant transmitted to opposer a counter-proposal, with opposer's latest proposal transmitted on December 17, 2012, following the Board's formal suspension of proceedings on

December 12, 2012. *See Opposer's Consented Request for Time to Respond to Applicant's Motion for Summary Judgment* (filed November 8, 2012), p. 1 and *Opposer's Motion to Compel*, p. 2. In between the filing of the motion for summary judgment and the Board's suspension on December 12, 2012, there is no indication that opposer raised with applicant the issue of applicant's outstanding discovery responses. Indeed, if opposer did not believe that applicant's motion for summary judgment suspended applicant's discovery obligations, it is not clear why opposer did not raise the issue when the parties were discussing, *inter alia*, the extension of opposer's deadline for responding to the motion. Indeed, opposer did not raise the question of the status of applicant's discovery responses for over five weeks after the latest set of discovery responses would have been due and only after the Board suspended proceedings and extended opposer's time to respond to the motion for summary judgment.

Third, there is nothing to suggest that applicant's failure to provide its discovery responses was in bad faith. Applicant, in good faith, believed that its discovery obligations had been suspended when it filed its motion for summary judgment. Considering that both parties are represented by counsel, the parties are presumed to know that the filing of a potentially dispositive motion will

result in a suspension order thereby providing the parties with good cause to cease or defer activities unrelated to the motion. *See Leeds Technologies Limited*, 65 USPQ2d at 1305-06. This is particularly true where the parties are actively negotiating a settlement. This is not an instance where the party responding to discovery is attempting to avoid its discovery obligations or otherwise frustrate the opposing party's discovery efforts. *See Super Bakery, Inc. v. Benedict*, 96 USPQ2d at 1136.

Accordingly, the Board, in this instance, considers the proceeding, including applicant's time for responding to discovery, suspended retroactive to the date of filing of applicant's motion for summary judgment.

As to the period of time following the disposition of the summary judgment motion, there does not appear to be a clear understanding between the parties as to when applicant's discovery responses would be due, particularly in light of the leave granted opposer to amend its pleading. Absent this understanding and in view of applicant's efforts to fulfill its discovery obligations, the Board sees no basis to find a waiver of objections or to deem the admission requests admitted as put. *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1304 (TTAB 1987) (although discovery responses were late, right to object not waived where there was some confusion regarding time to respond).

In view thereof, opposer's motion as to applicant's waiver of objections and admissions is hereby **DENIED**.

Finally, opposer's motion to extend the close of discovery by an additional ten months is **DENIED** as opposer has failed to demonstrate good cause therefor. Opposer's contention that the alleged delay in these proceedings was "occasioned through [applicant's] failure and refusal to respond" to discovery is not well taken as the Board has determined that applicant's deferral of its discovery obligations was made in good faith. Further, any alleged delay was taken into account by the Board when it extended all remaining dates in its order on the motion for summary judgment. However, that is not to say that discovery has closed. As proceedings herein were again suspended for consideration of opposer's motion to compel filed prior to the close of discovery and applicant has yet to file an answer to opposer's amended pleading, dates are **RESET** as follows:

Time to Answer	**11/27/2013**
Expert Disclosures Due	**12/27/2013**
Discovery Closes	**1/26/2014**
Plaintiff's Pretrial Disclosures Due	**3/12/2014**
Plaintiff's 30-day Trial Period Ends	**4/26/2014**
Defendant's Pretrial Disclosures Due	**5/11/2014**
Defendant's 30-day Trial Period Ends	**6/25/2014**
Plaintiff's Rebuttal Disclosures Due	**7/10/2014**
Plaintiff's 15-day Rebuttal Period Ends	**8/9/2014**

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 taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 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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