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

Faint

Mailed: March 26, 2014

Opposition No. 91204122

Empire State Building Company L.L.C.

v.

Michael Liang

Before Kuhlke, Wellington and Gorowitz, Administrative Trademark Judges.

By the Board:

This case now comes up on the following motions:

1. Opposer's motion, filed September 11, 2013, for sanctions in the form of judgment for applicant's failure to comply with the Board's August 6, 2013 order compelling applicant's discovery responses; and
2. Applicant's motion, filed October 8, 2013, to reopen the discovery period.

Background

Opposer filed its notice of opposition on March 1, 2012, alleging false suggestion of a connection, priority and likelihood of confusion, and dilution. The Board's institution order issued the same date, setting applicant's time to answer as April 10, 2012. Applicant's counsel filed his first motion for a sixty-day extension of time to answer on that date, stating he was a sole practitioner who was "very busy in the 2011 tax season as a tax counsel" and that he

would be out of the country for ten days in May 2012. The Board granted the motion, extending applicant's time to answer until June 11, 2012. On that date, applicant's counsel filed his second motion to extend time to answer for one day, and filed the answer the next day on June 12, 2012.

On June 20, 2012, opposer's counsel filed a consented motion to suspend for settlement negotiations, which the Board granted, setting August 20, 2012 as the date for proceedings to resume and setting September 19, 2012 as the due date for initial disclosures. On September 19, 2012, opposer filed a "Notice of Waiver of Initial Disclosures," stipulated to by the parties, which the Board acknowledged by its order of October 10, 2012. Also in its October 10, 2012 order, the Board stated that the dates remained as previously set, with discovery set to close on February 16, 2013,[1] and the due date for opposer's pretrial disclosures as April 2, 2013.

On March 27, 2013, opposer filed the parties' consented motion for an extension of time, stating opposer had granted applicant a sixty-day extension of time to respond to opposer's discovery requests served February 19, 2013. The Board granted the motion the same day, setting opposer's date for pretrial disclosures as July 1, 2013.

[1] February 16, 2013 was a Saturday, and February 18, 2013 was a Federal holiday in the District of Columbia, namely President's Day.

On June 6, 2013, opposer filed its motion to compel discovery responses. The Board granted the motion as conceded by its order of August 6, 2013, in which it compelled applicant's discovery responses without objection on the merits by September 5, 2013. On September 6, 2013, applicant filed copies of its discovery responses, and responses to requests for admission, with the Board. On September 11, 2013, opposer filed its motion for sanctions. Applicant did not file a response to the motion for sanctions, which response would have been due October 1, 2013. On October 8, 2013, applicant filed a motion to reopen discovery.

Motion to Reopen Discovery

Turning first to applicant's motion to reopen discovery, applicant's counsel argues that he is a sole practitioner and that "extraordinary and unusual" personal family matters which have been occurring "since the end of June 2012" have prevented him from responding in a timely manner to opposer's discovery requests and complying with the Board's scheduling orders. Counsel supports his motion with a declaration.[2]

[2] Applicant's counsel alleges he submitted an account of the highly personal and confidential matters under seal "for the Board's eyes only" via U.S. Post Office first class mail. In response, opposer argues any "confidential" communication applicant may have filed with the Board was not served on opposer, and the Board should disregard any such ex parte communication. The Board's mailroom has no record of receiving a confidential document from applicant's counsel. Thus the Board has never considered the alleged communication.

Applicant argues that this personal matter constitutes excusable neglect for applicant's failure to timely act before the close of the discovery period and asks the Board to reopen the discovery period.

Opposer argues applicant's counsel has not provided any reason for his delay, and it is "difficult to imagine" any set of circumstances that would make counsel wholly unable to seek to extend or reopen discovery during a period that spans nearly one and one-half years. Opposer argues that during this period of "personal matters," while applicant's counsel was able to communicate with opposer's counsel on several occasions concerning settlement, extensions of time to respond to discovery requests, and waiver of initial disclosures, and to prepare his untimely discovery responses, at no time did applicant's counsel request an extension of the discovery deadline or indicate his inability to adhere to the Board's schedule. Moreover, applicant did not serve any discovery requests on opposer.

Opposer's counsel argues he and applicant's counsel had telephone conversations and exchanged email communications after the February 16, 2013 close of discovery concerning applicant's failure to respond to discovery and a possible settlement, and applicant's counsel did not request that discovery be reopened, but only requested an extension of time

to respond to opposer's discovery requests, to which opposer agreed.

Opposer contends applicant's motion to reopen is an attempt to make an untimely response to opposer's motion for sanctions. Opposer argues that applicant's delay in filing the motion to reopen is significant, and that applicant's utter disregard for the Board's orders regarding deadlines evidence applicant's bad faith. Opposer's response is supported by a declaration of opposer's counsel.

The standard for reopening a prescribed period of time is "excusable neglect." Fed. R. Civ. P. 6(b). Such a determination is an equitable one that must take into account 1) the 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. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997)(*citing Pioneer Investment Services Co. v. Brunswick Associates Ltd. Partnership,* 507 U.S. 380 (1993)).

The kind of prejudice to be considered is that such as the unavailability of witnesses or the loss of evidence because of the delay. There is no such allegation here. Therefore this is not a significant factor.

The length of the delay in this proceeding is measured by the length of time between the close of discovery on February 16, 2013, and the filing of the first motion to reopen on October 8, 2013, a period of over eight months. We find the delay is significant, and that this factor favors opposer.

Opposer argues applicant has acted in bad faith by disregarding the rules and the Board's orders. Applicant's counsel has alleged "personal matters" have affected his ability to follow the Board's orders. While counsel's failure to timely respond to the Board's orders, or to respond to discovery requests and motions, or to file appropriate motions for extension or suspension at the appropriate times, indicates an inattention to its obligations and the orderly prosecution of this case, we find this factor to be neutral.

The reason for the delay and whether it was in the reasonable control of the movant, might be considered the most important factor in a particular case. *Atlanta-Fulton County Zoo Inc. v. DePalma*, 45 USPQ2d 1858, 1859 (TTAB 1998). The reason offered in this case, that applicant's counsel's "personal matters" prevented him from acting timely, is unsupported by any specific facts. Nor has applicant's counsel offered any explanation for why these matters might span the time period from June 2012 through October 2013. The Board credits opposer's counsel's statements that there were

several phone calls and email communications between counsel over the course of this case, including the period in question, and that applicant's counsel never sought to extend or suspend times for response. While applicant's counsel claims that he sought an extension from opposer's counsel and was refused, opposer's counsel states in his declaration,

> At no time in September 2012 or during the discovery period which ended February 16, 2013, did Applicant's counsel ask me or the Board to suspend or extend the discovery period, or indicate in any manner that he believed he would be unable to comply with the Board's deadlines.

In essence, the Board finds applicant's counsel has given no reason for the delay in this case, nor why he never filed any motions, even unconsented ones, requesting suspension or extension.

On balance, we find applicant's inattention to the schedule governing this proceeding is clearly the most dominant factor in applicant's failure to timely present its case and that such inattention has had an adverse impact on the orderly administration of this case. Accordingly, even under the liberal interpretation of "excusable neglect" articulated by the *Pioneer* Court and adopted by the Board, such neglect can be neither overlooked nor excused.

In view thereof, applicant's motion to reopen the discovery period is **denied**.

Motion for Sanctions

Opposer argues applicant's discovery responses were served one day after the date set in the Board's order compelling discovery with improper general objections, and objections on the merits to every discovery request. Further, opposer argues, applicant's objections make it unclear what information, if any, has been withheld on the basis of the improperly raised objections.

It is well settled that when a party fails to comply with an order of the Board relating to discovery, the Board may order appropriate sanctions as provided in Trademark Rule 2.120(g)(1) and Fed. R. Civ. P. 37(b)(2). *MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG*, 59 USPQ2d 1477, 1478 (TTAB 2000). The sanctions which may be entered by the Board pursuant to Rule 2.120(g)(1) include refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party. *See Electronic Industries Association v. Potega*, 50 USPQ2d 1775, 1778 (TTAB 1999) (where applicant, in violation of Board order, served objections to discovery requests, judgment was denied as too harsh but applicant was ordered to provide new and complete responses without objection, and to complete other actions ordered by the

Board). While applicant's vague explanations as to why his discovery responses were served late or why he served them with objections on the merits are not supported by a declaration or other evidence, the Board finds that sanctions in the form of judgment are not appropriate at this juncture. *See HighBeam Marketing, LLC v. Highbeam Research LLC*, 85 USPQ2d 1902, 1905 (TTAB 2008)(where party only partially complied with Board's order compelling discovery responses, Board entered lesser sanctions precluding disobedient party from entering evidence at trial).

In view thereof, opposer's motion for sanctions in the form of judgment is **denied**. However, in view of applicant's failure to serve responses without objection as ordered by the Board, within **TWENTY DAYS** of the mailing date of this order applicant is ordered to serve amended responses to interrogatories and document requests without objections on the merits. Moreover, applicant is estopped from submitting at trial, and relying on as evidence at trial, any information or documents subject to a discovery request which have not been produced in the manner directed by this order. *See MySpace, Inc. v. Mitchell*, 91 USPQ2d 1060, 1061 (TTAB 2009).

Applicant is also reminded that he has a continuing duty to supplement his discovery responses. Accordingly, if any documents, or any information responsive to interrogatories,

come to his attention after he has served the responses as ordered herein, he must provide such to plaintiff as soon as the supplemental documents or information are discovered.

Late-Filed Responses to Requests for Admission

Applicant served its responses to requests for admission with its discovery responses. These admissions are filed over eight months late, and opposer requests the Board "confirm" the admissions are effectively deemed admitted by operation of Fed. R. Civ. P. 36(a)(1)(3).

The Board construes the filing of the late responses to admissions as a motion to withdraw and amend applicant's effective admissions. Under Fed. R. Civ. P. 36(b), admissions can be withdrawn and amended if the Board is persuaded that it would promote the presentation of the action on the merits and that the non-movant will not be prejudiced by allowing withdrawal or amendment of the effective admissions. *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307-09 (TTAB 2007).

The Board notes applicant has denied certain of the admission requests that were deemed admitted, demonstrating that some of the previously admitted facts are indeed disputed. Further, the Board notes that although discovery was closed at the time of service, the amended admissions were served prior to trial, and we do not find prejudice to opposer in this instance. However, applicant did object to every

request, and the Board finds that such objections are untimely and will be given no consideration. In view thereof, it is hereby **ordered** applicant's deemed admissions are withdrawn and his amended admissions are entered without objections on the merits.

Schedule

Proceedings are resumed. Dates are reset as set out below. Applicant has **TWENTY DAYS** from the mailing date of this order to re-serve his responses to interrogatories and document requests without objections on the merits, failing which, opposer may renew its motion for judgment as a sanction. Applicant's amended admissions are entered without objections on the merits.

Discovery Closes	CLOSED
Plaintiff's Pretrial Disclosures Due	5/9/2014
Plaintiff's 30-day Trial Period Ends	6/23/2014
Defendant's Pretrial Disclosures Due	7/8/2014
Defendant's 30-day Trial Period Ends	8/22/2014
Plaintiff's Rebuttal Disclosures Due	9/6/2014
Plaintiff's 15-day Rebuttal Period Ends	10/6/2014

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 the taking of testimony. Trademark Rule 2.l25.

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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