

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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General Contact Number: 571-272-8500

Mailed: September 2, 2014

Opposition No. 91204456

Intrust Financial Corporation

v.

nTrust Corp.

**M. Catherine Faint,
Interlocutory Attorney:**

Opposer filed its notice of opposition on March 19, 2012, opposing applicant's intent-to-use mark, NTRUST,¹ in standard character form for various financial services in Class 36 and financial fraud protection services in Class 45 on the grounds of priority and likelihood of confusion, and dilution, with opposer's 12 registered marks for INTRUST or incorporating this term for various banking and financial services. By its answer, applicant denied the salient allegations of the notice of opposition. The Board granted various stipulated extensions of time in this case, and opposer's trial period

¹ Application Serial No. 85250992, filed Feb. 24, 2011 based on Trademark Act § 1(b) for, "Financial services conducted via electronic communications networks, namely, electronic funds transfer; bill payment services; cashless purchasing services for merchants and consumers whereby purchase monies are held in trust and sent to merchants upon sales to consumers; stored value card services; electronic money issuance and transfer services; direct deposit of funds into customer bank accounts" in Class 36, and "Providing financial fraud protection and prevention" in Class 45.

as last reset, closed March 27, 2014. Opposer submitted evidence during its testimony period. Applicant's testimony period was set to open April 26, 2014.

This case now comes up on opposer's fully-briefed motion, filed April 25, 2014, to reopen its testimony period.

Parties' Arguments

Opposer seeks to reopen its testimony period to submit newly discovered evidence of actual confusion between its mark and applicant's mark, namely, that on April 7, 2014, after the close of opposer's testimony period, opposer received an email from an employee for one of its vendors, FIS Global ("FIS"), inquiring whether the artwork it had received, which apparently display applicant's mark, belonged to opposer. Opposer also seeks to depose witnesses regarding the email, namely Debbie Canfarelli and Geno Reed of FIS and "the other persons identified in Exhibit A."² Opposer has submitted supplemental interrogatory responses regarding this evidence to applicant.

Applicant argues that while the evidence is newly discovered, it is not relevant as a matter of law, because the potentially confused parties were FIS employees, a service vendor for both opposer and applicant, rather than

² It is not clear how many witnesses opposer intends to depose. Opposer refers to Exhibit A, which is a copy of an email chain and shows the names of four people. Applicant states in its response brief that opposer has identified seven total witnesses related to this issue and believes the number of depositions could go higher than four persons.

consumers. Applicant argues that the email, which asks who is the owner of an image file for artwork for the creation of applicant's NTRUST payment cards, does not show consumer confusion as to the services at issue, namely banking services, but is rather merely a clarifying inquiry so FIS could perform services for the correct client.³

Applicant contends it would be prejudiced by a reopening of opposer's testimony period because such a reopening would further delay these proceedings, delaying applicant's launch of its services in the United States, and applicant would incur substantially increased legal costs and expenses by traveling to and attending additional depositions.

In reply, opposer argues the fact that evidence of actual confusion even exists in this case is noteworthy, as it is well-recognized that such evidence is notoriously difficult to come by, and applicant's mark is not in use in the United States. Opposer argues the Federal Circuit has held that evidence of actual confusion by dealers and experts was highly probative on the question of likelihood of confusion. *Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260, 1265 (Fed. Cir. 1995)(citations omitted).

Analysis and Decision

Pursuant to Fed. R. Civ. P. 6(b)(2), the requisite showing for reopening an expired period is that of excusable neglect. Such a determination is an equitable

³ Applicant relies on *Platinum Home Mortgage v. Platinum Financial Group*, 149 F.3d 722, 729 (7th Cir. 1998) arguing that only evidence of actual confusion by the reasonable and prudent consumer is relevant. However, that case was examining whether a mark had acquired secondary meaning in a descriptiveness context.

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)). In addition, the Board has made clear that to reopen testimony for newly discovered evidence, “[t]he moving party must show not only that the evidence is newly discovered, but also that the evidence could not have been discovered earlier through the exercise of reasonable diligence.” *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998), citing, *Canadian Tire Corp. v. Cooper Tire & Rubber Co.*, 40 USPQ2d 1537, 1539 (Comm'r 1996). The determination is committed to the discretion of the Board, however, even if a showing of due diligence has been made, the Board will not automatically reopen a party’s testimony period, but must also consider, among other things: (1) the nature and purpose of the evidence sought to be added, (2) the stage of the proceeding, (3) the adverse party's right to a speedy and inexpensive determination of the proceeding, and (4) the need for closure once the trial period has been completed. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886-1887 (TTAB 2008) quoting TBMP § 509.01(b)(2).

The kind of prejudice to be considered is 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 testimony and the filing of the first motion to reopen, which was relatively short, and applicant's testimony period has not yet opened. Thus we find the delay is not significant, and we are still relatively early in the trial period. There is no allegation of bad faith.

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). Opposer essentially argues that this most important factor, the reason for the delay, was not within its control, because it could not have discovered the evidence earlier. Such an argument requires the Board to weigh opposer's diligence in finding and introducing the evidence, and whether it is newly discovered. In this instance, the Board finds the evidence could not have been discovered earlier by any effort on opposer's part as the email was not sent until after the close of opposer's testimony period. Further, the Board finds, without deciding the ultimate issue, that this is potential evidence of actual confusion which may be relevant to the likelihood of confusion analysis. Respondent argues that this evidence is de minimis, but the Board has found even minimal evidence of actual confusion may be probative. See *Molenaar, Inc. v. Happy Toys Inc.*, 188

USPQ 469 (TTAB 1975)(even a single instance of actual confusion is at least “illustrative of a situation showing how and why confusion is likely”). Any inconvenience or expense to applicant can be minimized by use of alternate means for attending the depositions, if applicant so chooses.

In view thereof, opposer’s motion to reopen its testimony period is **granted for the limited purpose** of entering this newly discovered evidence and conducting testimonial depositions thereon. The testimony period will be reopened on the schedule set out below, and opposer is strongly encouraged to conduct any depositions on the same day to minimize delay and expense. Opposer may schedule depositions⁴ for only the following persons named in Exhibit A:

Deborah R. Canfaralli
Jerry G. Chandler
Jennie M. Githens
Geno Reed

To minimize expense and inconvenience to applicant, the Board will entertain, at applicant’s option, a stipulation that the depositions be conducted via telephone or video conference. The parties may telephone the Interlocutory Attorney to schedule a telephone hearing on such a written stipulation.

Dates are reset as set out below.:

Opposer’s limited testimony period opens	September 22, 2014
and Closes	October 6, 2014
Defendant's Pretrial Disclosures Due	October 21, 2014

⁴ This is not to require that opposer depose all four of these persons, but does limit opposer to only these four.

Defendant's 30-day Trial Period Ends	December 5, 2014
Plaintiff's Rebuttal Disclosures Due	December 20, 2014
Plaintiff's 15-day Rebuttal Period Ends	January 19, 2015

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.
