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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91204897
Party	Plaintiff John G. Marino
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Attachments	Marino Response to Motion to Dismiss.pdf(114570 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In the matter of trademark application Serial No. 85411955
For the mark LAGUNA LAKES Published in the Official Gazette on
February 28, 2012**

Consolidated Opposition No:91204897

91204941

JOHN GERARD MARINO

v.

LAGUNA LAKES COMMUNITY ASSOCIATION, INC.

**JOHN GERARD MARINO'S
RESPONSE TO MOTION TO DISMISS
FOR LACK OF PROSECUTION**

John Gerard Marino (“Marino”) hereby responds to the Motion to Dismiss for Lack of Prosecution in this matter as follows:

1. Marino has been actively prosecuting his TTAB Complaints against the Laguna Lakes Community Association, Inc. (“LLCA”) over the above-styled trademarks Laguna Lakes’ trademark applications.

2. Marino’s TTAB Opposition to Serial No. 85411955 is primarily based upon his prior use of the mark and the geographic descriptiveness of the mark.

3. Marino’s testimony period was originally scheduled to end May 30, 2014. During Marino’s testimony period, Marino intended to simply submit his own Declaration and to file a Notice of Reliance including deposition

transcripts of previous depositions taken of the LLCA Board. Counsel for the LLCA took the deposition of Marino and was present for the depositions of the LLCA Board Members. At no time did Marino plan on calling, as part of his case, any surprise witnesses or exhibits.

4. During Marino's testimony period, and specifically during the week of May 19, 2014, the undersigned counsel was special set to start a jury trial in the case of *David Hopkins v. GelTech Solutions, Inc. et. al.*, Palm Beach Circuit Court Case No: 2008-CA-017955. In the weeks leading up to this special set trial, the undersigned was extremely busy, preparing for that special set trial. As a result of this trial preparation, the undersigned counsel did not actively work to get Marino's declaration submitted to get the discovery depositions of the LLCA Board submitted to the TTAB during Marino's testimony period.

5. On May 30, 2014, in order to allow additional time to prepare Marino's Declaration, the undersigned counsel requested an additional seven days to file the subject Declaration and offered to give LLCA counsel the same extension. The undersigned counsel also sought a similar extension of time to file a Notice of Reliance upon certain documents.

6. LLCA counsel opposed such extension. Since that time Marino's Declaration and Notice of Reliance have been prepared and finalized for immediate filing with this Tribunal. The failure to get together the subject Declaration and Notice of Reliance prior to May 30, 2014, was the fault of the

undersigned counsel, due to trial preparation, and was no fault of Opposer.

7. It is well settled that this Board and all courts in this country favor determinations of matters on their merits. “The law favors determination of cases on merits; and when circumstances dictate that a judgment by way of default or dismissal for failure to prosecute should be set aside, the Board will exercise its discretion under Fed. R. Civ. P. 60(b) to reopen the case.” *CTRL Systems, Inc. v. Ultraphonics of North America, Inc.*, 1999 TTAB LEXIS 468 (Trademark Trial & App. Bd. August 17, 1999); *See also, Florists’ Transworld Delivery, Inc. v. McAfee*, 1999 TTAB LEXIS 582 (Trademark Trial & App. Bd. October 6, 1999)(“we are mindful of the importance of resolving actions on their merits whenever possible, rather than on procedural technicalities.”).

8. One of the cases cited by LLCA, cites to the standard for reopening a testimony period before this Board. In the case of *Pumpkin, Ltd d/b/a Pumpkin Masters v. The Seed Corps*, 1997 TTAB LEXIS 24 (Trademark Trial & App. Bld. July 7, 1997), this Board held that the factors that should be considered by this Board include: excusable neglect, the danger of prejudice to the nonmovant, the length of the delay and its potential impact on judicial proceedings, the reason for the delay, including whether it was in the control of the movant, and whether the movant acted in good faith. *Id.*

9. Based upon the foregoing factors, it is clear that each of them mitigate in favor of Marino to deny the pending Motion to Dismiss. First, the

delay in getting the Declaration of Marino and Notice of Reliance filed in this matter was based upon the trial preparation of the undersigned counsel and was not due to any actions of Marino. In fact, Marino, is ready willing and able to file his Declaration and is awaiting a ruling on this pending Motion in order to file his Declaration which is ready to be submitted. As to the second factor, the length of delay and its impact on judicial proceedings, this factor clearly weighs in favor of Marino. Marino only sought a very brief extension of the trial deadlines to file testimony and documents that were already disclosed in discovery in this matter. Marino did not seek to introduce testimony of any new witnesses or documents and Marino filed a timely Motion for Extension of Time to accomplish this task. Moreover if this matter is not considered on its merits, Marino would suffer severe prejudice including, an expectation that LLCA will attempt to stop Marino from doing business as Mr. Laguna Lakes, under which he has been doing business since 2004 and an expectation that LLCA may attempt to bring lawsuits against Marino and/or seek to have him removed as a resident of LLCA (Marino has resided in Laguna Lakes since 2004). Significantly, there would be absolutely no prejudice to LLCA based upon this brief seven (7) day extension. Thus, the prejudice Marino would face as a consequence of undersigned's counsel inadvertent failure to meet the Tribunal's deadline strongly favors a brief seven (7) day extension to file the Declaration and Notice of Reliance, and for the board to deny Applicant's

Motion to Dismiss. As to the remaining factors, while the requested extension was not due to any fault of the moving party, its certainly does not seem that LLCA's actions are in good faith where short extensions of time are routinely agreed to between the parties, rather than attempt to have a hotly contested matter decided upon a technicality.

WHEREFORE, based upon the foregoing, Marino requests that this Board deny the Motion to Dismiss for Lack of Prosecution, allow Marino to file his Declaration and Notice of Reliance forthwith and for any other relief this Board deems just and proper.

I HEREBY CERTIFY that a true and correct copy of the foregoing was furnished by electronic mail on this 17 day of June 2014 to: Donna M. Flammang, Esq., Brennan Manna & Diamond, P.L., 3301 Bonita Beach Road, Suite 100, Bonita Springs, FL 34134.

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