

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

EJW

Mailed: December 20, 2013

Opposition No. 91205076

Mr. Winston A. Rosa

v.

Rafael Robert Vargas

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

This case now comes up for consideration of applicant's fully briefed¹ combined motion (filed September 27, 2013) to reopen the discovery and trial periods, and to strike opposer's testimony deposition.

For purposes of this order, the Board presumes the parties' familiarity with the subject motion and the parties' arguments with respect thereto.

Motion to Reopen

As last reset in the Board's order mailed August 27, 2012, the discovery period closed on April 25, 2013, applicant's pre-trial disclosures were due on August 8, 2013, and applicant's testimony period closed on

¹ Opposer's sur-reply filed on November 6, 2013, will not be considered. See Trademark Rule 2.127(a) (The Board will consider no further papers in support of or in opposition to a motion.).

September 22, 2013. On September 27, 2013, applicant filed his motion to reopen the discovery and trial periods, as well as to reset pre-trial disclosure due dates, arguing that his failure to act during the foregoing periods was the result of excusable neglect. Inasmuch as applicant's motion was filed after the deadline for each period sought to be reopened, the appropriate standard for considering applicant's motion is whether applicant has shown excusable neglect. See Fed. R. Civ. P. 6(b) (When an act is to be done within a specified time, the Court may "upon motion made after the expiration of the specified period permit the act to be done where the failure to act was the result of excusable neglect").

In *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), the Supreme Court stated that a determination of excusable neglect is at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include ... (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. *Pioneer*, 507 U.S. at 395. In view thereof, the Board must balance the reason for the delay with the factors

enumerated by the Supreme Court in *Pioneer*, taking into account all of the relevant circumstances in determining whether the movant's actions constitute a sufficient showing of excusable neglect. See, e.g., *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1588 (TTAB 1997).

However, in *Pumpkin*, the Board noted that several courts have held that the third *Pioneer* factor, i.e. "the reason for the delay, including whether it was within the reasonable control of the movant," may be deemed to be the most important of the *Pioneer* factors in a particular case. See also *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1296 (TTAB 1997). Therefore, in some cases, a determination that there is no excusable neglect may be reached by finding that the third *Pioneer* factor weighs so heavily against the movant when compared to the other *Pioneer* factors, that the motion at issue cannot be granted. See, e.g., *Atlanta-Fulton County Zoo Inc. v. DePalma*, 45 USPQ2d 1858, 1860 (TTAB 1998) (finding inexcusable neglect in view of opposer's inattention to the set schedule governing the proceeding, albeit inadvertent, as "clearly the most dominant factor in opposer's failure to timely present its case"). In any event, the four factors for determining excusable neglect do not carry equal weight. See *FirstHealth of the Carolinas Inc. v. CareFirst of Maryland Inc.*, 479 F.3d 825, 81 USPQ2d 1919 (Fed. Cir. 2007)

(finding of no excusable neglect affirmed based on second and third factors, with third weighted heavily in the analysis).

Applying the four *Pioneer* factors to the case at bar, the Board finds that applicant has not shown excusable neglect such that the reopening of the discovery and trial periods is warranted. In the first instance, with respect to any prejudice to the non-movant, opposer has explained that his witness is a 73-year old man who is not in the best of health and who would have some difficulty in participating in another testimonial deposition (response at 2, ¶3). Applicant's offer to "work out any number of reasonable methods to conduct [his] deposition" (reply at 3) does not alleviate the prejudice to opposer insofar as it is unclear from the record whether the witness will be able to appear for another deposition. In view thereof, this factor weighs in favor of opposer.

Regarding the second *Pioneer* factor, namely, the length of the delay and its potential impact on judicial proceedings, the Board must evaluate the total length of the delay incurred as a result of applicant's failure to participate in discovery and/or in his own testimony period, as well as the time for the Board to consider the instant motion. See, e.g., *Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1702-1703 (TTAB 2002);

and *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860, 1862 (TTAB 2002). In short, the Board must consider the potential impact of applicant's delay on the proceeding. Here, applicant requests that the entire discovery period be reopened, as well as the pre-trial disclosure due dates, and both parties' trial periods. Together, these periods (including opposer's rebuttal trial period) total to over one year. In addition, over two months have passed since applicant filed the instant motion. In view thereof, the Board finds that the delay to the proceeding caused by applicant's delay in acting during his discovery and testimony periods is significant. Thus, this factor also weighs against applicant.

The Board turns now to the third *Pioneer* factor, namely, the reason for the delay, including whether it was within the reasonable control of applicant.

Applicant explains, in relevant part, that before he was represented by counsel, he was unsure how to conduct discovery, including whether he should produce documents unprompted by the Board or by opposer, or whether he should wait until opposer or the Board requested documents regarding ownership of the applied-for mark ("affirmation" of Jon Jekielek, ¶12). Similarly, applicant was unsure as to whether he was allowed to request discovery from opposer, and "ultimately did not understand the rules of procedure

utilized by the TTAB and which governed this dispute" (*Id.*, ¶13; see also declaration of Rafael Robert Vargas, ¶17). Applicant also explains that he sought to retain two different attorneys during the progress of this matter, but, for financial reasons, was unable to do so; and that he retained his current counsel in late August, 2013.²

It is well-established that misunderstanding of the rules applicable to Board proceedings does not constitute excusable neglect. *See, e.g., Luster Products Inc. v. Van Zandt*, 104 USPQ2d 1877, 1880 (TTAB 2012), *citing PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860 (TTAB 2002); and *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848 (TTAB 2000). Further, while the Board is sympathetic to applicant's inability to retain counsel earlier in this proceeding, the Board is entitled to enforce its deadlines. *Cf. Hewlett-Packard v. Olympus*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) ("While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines."). Moreover, applicant has failed to provide any rationale as to why applicant's newly-appointed counsel did not file a motion to extend

² Counsel's appearance on behalf of applicant entered on August 29, 2013, is noted.

applicant's testimony period prior to the close of that period. Clearly, the decision to wait to file any motion before the Board was in the reasonable control of applicant. In view of the foregoing, the Board finds that the third *Pioneer* factor weighs heavily against applicant.

Finally, with respect to the fourth *Pioneer* factor, there is no evidence of bad faith on the part of applicant; therefore, this factor weighs in favor of applicant.

After careful consideration of the *Pioneer* factors and the relevant circumstances in this case, in view of the clear prejudice to opposer, the significant delay to this proceeding, and the circumstances which caused applicant's delay in submitting the instant motion to the Board, the Board, in its discretion, finds in balancing the four factors set forth in *Pioneer* that applicant has not shown excusable neglect in support of its motion to reopen the discovery period, testimony periods and related disclosure due dates. Accordingly, applicant's motion to reopen is **denied**. See Fed. R. Civ. P. 6(b); Trademark Rule 2.116(a).

Request to Strike Testimony

Buried in the "affirmation" of applicant's counsel (¶¶ 10-11) and in applicant's motion to reopen (motion at 6), applicant requests that the Board strike opposer's testimony deposition (with leave for opposer to refile should the testimony periods be reopened) on the grounds that opposer

did not serve his initial disclosures (thus, no discovery was allowed) and the testimony should have been taken during the discovery period.

To the extent applicant's request could be considered to be a motion, said motion is not well taken. Simply put, applicant has confused discovery depositions with testimony depositions, which are the method by which trial is conducted at the Board. See TBMP § 404.09 (3d ed. rev.2 2013) (discovery depositions compared to testimony depositions). The conduct of opposer's testimony deposition on July 9, 2013, that is, during his testimony period was timely. See Trademark Rules 2.121 and 2.123. Likewise, opposer's submission of the testimony transcript on July 31, 2013, was timely.³ See Trademark Rules 2.125 and 2.196. In view of the foregoing, applicant's motion to strike opposer's testimony deposition on the grounds of untimeliness is **denied**.

Proceeding Resumed

This proceeding is deemed to have been suspended since the filing date of applicant's motion to reopen. In view thereof, and because applicant did not submit any evidence during his testimony period, no rebuttal period for opposer is required. Accordingly, this proceeding resumes with the

³ To the extent applicant suggests other reasons why opposer's testimony should be stricken, said argument in his reply brief constitutes improper rebuttal.

period for briefing in accordance with the following schedule:

Brief for party in position of plaintiff shall be due:	February 3, 2014
Brief (if any) for party in position of defendant shall be due:	March 5, 2014
Reply brief (if any) for party in position of plaintiff shall be due:	March 20, 2014

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

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