UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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WINTER

Mailed: August 21, 2014

Opposition No. 91207216

Nathan Aweida

v.

Pure Glass Distribution, Inc.

Before Bucher, Wolfson, and Gorowitz,
Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of Applicant's motion (filed May 2, 2014) for involuntary dismissal of this proceeding under Trademark Rule 2.132(a) and Opposer's cross-motion (filed May 22, 2014) to suspend this proceeding pending the disposition of a civil action between the parties. The motions are fully briefed.

Opposer's Late-Filed Response and Cross-Motion to Suspend

Applicant has objected to Opposer's brief as having been untimely filed. As last reset in the Board's order mailed on December 2, 2013, Opposer's testimony period was set to close on May 1, 2014. As noted, Applicant filed the instant motion on May 2, 2014.[1] Thus, Opposer's response was due no

[1] In view thereof, the filing of Applicant's motion was timely. *See* Trademark Rule 2.132(c).

later than fifteen days from the date of service of the motion, *i.e.,* on May 17, 2014. *See* Trademark Rule 2.132(a), 37 C.F.R. § 2.132(a) ("The party in the position of plaintiff shall have fifteen days from the date of service of the motion to show cause why judgment should not be rendered against him."). Opposer's responsive brief and cross-motion to suspend were filed on May 22, 2014. In view thereof, Opposer's brief is untimely. Nonetheless, insofar as Applicant's motion is potentially dispositive and Opposer's submission was only five days late, we exercise our discretion to consider Opposer's response and cross-motion. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.,* 60 USPQ2d 1733, 1734 n.2 (TTAB 2001) (exercising discretion and considering untimely response and cross-motion for summary judgment in view of the potentially dispositive nature of both the Opposer's motion and Applicant's cross-motion on the affirmative defense); *Trek Bicycle Corp. v. Fier,* 56 USPQ2d 1527, 1528 (TTAB 2000) (considering untimely cross-motion and response for summary judgment in view of Board policy to resolve cases on their merits as well as minimal delay in filing response to motion).

Applicant's Motion for Involuntary Dismissal

Applicant requests that the Board dismiss the opposition because "Opposer's testimony has expired, and Opposer has not taken any testimony, offered any evidence, or otherwise prosecuted this case, nor [has Opposer] shown cause for the lack thereof" (motion at 1). In response, Opposer, *inter alia*, moves to suspend the proceeding pending the final resolution of a civil

action pending between the parties[2] or, alternatively, argues that there is "good and sufficient cause" to deny Applicant's motion. In reply, Applicant argues that the Board should not consider the motion to suspend before considering its motion to dismiss, that Opposer's motion to suspend is essentially an attempt to "escape judgment," and that certain facts mitigate against a finding of excusable neglect. Insofar as Opposer seeks, in the alternative, to amend its notice of opposition and proceed with respect to part of the applied-for mark,[3] we construe Opposer's response as also comprising an alternative request to reopen his testimony period.

- *Applicant's Motion Considered First*

If at the time the question of suspension of proceedings before the Board is raised a motion which is potentially dispositive of the case is pending, the

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[2] Case No. 2:14-cv-00757 in the United States District Court, Western District of Washington, captioned *Aweida Arts, Inc. v. Pure Glass Distribution, Inc.* A copy of the filed complaint is attached to Opposer's responsive brief.

[3] Opposer's suggestion that Applicant amend its mark to delete the design portion is not well-taken. *See* Trademark Rule 2.133(a), 37 C.F.R. § 2.133(a). Such an amendment would effectuate a material alteration of the mark as filed. *See, e.g., In re Dillard Department Stores, Inc.,* 33 USPQ2d 1052 (Comm'r Pats. 1993) (proposed deletion of highly stylized display features of mark "IN•VEST•MENTS" held to be a material alteration of a registered mark); *In re Meditech Int'l Corp.,* 25 USPQ2d 1159, 1160 (TTAB 1990) ("[a] drawing consisting of a single blue star, as well as a drawing consisting of a number of blue stars, would both be considered material alterations vis-à-vis a drawing consisting of the typed words 'DESIGN OF A BLUE STAR'"); *In re The Wine Society of America Inc.,* 12 USPQ2d 1139 (TTAB 1989) (proposed amendment to replace typed drawing of "THE WINE SOCIETY OF AMERICA" with a special form drawing including those words with a crown design and a banner design bearing the words "IN VINO VERITAS" held to be a material alteration). *See generally* TMEP § 807.14(a) (April 2014). In view thereof, *the notice of opposition filed on September 26, 2012, remains Opposer's operative pleading in this matter.*

potentially dispositive motion may be decided before the question of suspension is considered. *See* Trademark Rule 2.117(b), 37 C.F.R. § 2.117(b). *See also Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2018-19 (TTAB 2003) ("The Board's discretion to consider a dispositive motion pending at the same time as a motion to suspend … developed 'to prevent a party served with a potentially dispositive motion from escaping the motion by filing a civil action and then moving to suspend before the Board has decided the potentially dispositive motion.'"). Here, and given that Opposer did not file his complaint in the civil action until after Applicant filed its motion for involuntary dismissal, we find it appropriate to consider Applicant's motion first.

- *Decision*

Pursuant to Trademark Rule 2.132(a), if the time for taking testimony by the party in the position of plaintiff has expired and that party has not taken testimony or offered any other evidence (in accordance with Trademark Rules 2.122 and 2.123), the defending party may move for dismissal on the ground of the failure of the plaintiff to prosecute. In the absence of a showing of good and sufficient cause, the notice of opposition will be dismissed with prejudice. *See Hewlett Packard v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860, 1862 (TTAB 2002). The "good and sufficient cause" standard, in the context of a motion filed under Trademark Rule 2.132(a), is equivalent to the

standard required to reopen plaintiff's trial period under Fed. R. Civ. P. 6(b), made applicable by Trademark Rule 2.116(a), that is, "excusable neglect." *See Hewlett Packard*, 18 USPQ2d at 1711-12. *See also HKG Industries Inc. v. Perma-Pipe, Inc.*, 49 USPQ2d 1156, 1157 (TTAB 1998); and *Grobet File Co. of America Inc. v. Associated Distributors Inc.*, 12 USPQ2d 1649, 1651 (TTAB 1989).

The standard for determining whether a party's conduct constitutes excusable neglect is set forth in *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), wherein 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 factors 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. 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).

Applying the first *Pioneer* factor, there does not appear to be any measurable prejudice to Applicant should the Board deny Applicant's motion

and reopen Opposer's testimony period. Mere passage of time is not considered prejudicial, and Applicant has made no showing that it would be prejudiced as a result of lost evidence or unavailable witnesses. *See Pratt v. Philbrook*, 109 F.3d 18, 22 (1st Cir. 1997); and *Paolo's Associates Ltd. Partnership v. Paolo Bodo*, 21 USPQ2d 1899, 1904 (Comm'r 1990). In view thereof, we find that the first *Pioneer* factor weighs in favor of Opposer.

As to the second *Pioneer* factor, we must evaluate the total length of the delay incurred as a result of Opposer's failure to submit evidence during his testimony period. Specifically, we consider the time between the close of the testimony period and the filing of Opposer's response and cross-motion to suspend the proceeding, and the time for the reopened testimony periods, if the proceeding is not suspended. *See, e.g., Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1702-03 (TTAB 2002); and *PolyJohn Enterprises* 61 USPQ2d at 1862. We must also consider the overall impact of the delay on the proceeding, including the additional delay required to brief and decide the subject motions. *See Pumpkin,* 43 USPQ2d at 1587-88.

Here, we note that Opposer filed his response and cross-motion to suspend only twenty-one days after the close of his own testimony period. Briefing for the parties' respective motions was not complete until June 6, 2014, thus, at the outset, Opposer's failure to present his testimony during the designated time period caused a delay of approximately five weeks. Further, if we were to grant Opposer's construed motion to reset his testimony period, including

time to serve his pretrial disclosures, the trial periods in this proceeding would close no earlier than late February 2015, rather than August 2014. Thus, Opposer's delay in prosecuting this case is somewhat significant. In view of the foregoing, we find that the second *Pioneer* factor weighs in favor of Applicant.

We turn now to consider the third *Pioneer* factor, namely, the reason for the delay, including whether it was within the reasonable control of Opposer. Based on the confidential information provided by Opposer, we find that the illness of the mother of Opposer's counsel and resulting circumstances[4] outside of counsel's control greatly impacted the ability of Opposer's counsel to meet deadlines set by the Board and that the foregoing conditions weigh heavily in favor of a finding of excusable neglect. *See S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1296 (TTAB 1997) ("the Board is persuaded that respondent's counsel was not solely responsible for the delay").

Regarding the fourth *Pioneer* factor, there is no evidence of record that Opposer's failure to take the appropriate steps during his assigned trial period was the result of bad faith, thus, the fourth factor also weighs in favor of Opposer.

Taking into account the four factors enumerated by the Supreme Court in *Pioneer* and all of the relevant circumstances, the Board finds that Opposer

[4] We shall not identify further details insofar as the information provided is confidential and was submitted under seal.

has shown excusable neglect. In view thereof, there exists good and sufficient cause for denying Applicant's motion for involuntary dismissal. *See* Trademark Rule 2.132(a), 37 C.F.R. § 2.132(a). Accordingly, Applicant's motion is **denied** and, upon resumption of this proceeding, the due date for Opposer's pretrial disclosures, as well as his testimony period and subsequent trial dates, shall be reset.[5]

Opposer's Motion to Suspend

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action that may be dispositive of or have a bearing on the Board case. *See General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992); and Trademark Rules 2.127(a) and 2.117(a), 37 C.F.R. §§ 2.127(a) and 2.117(a). *See also* TBMP § 510.02 (2014). Moreover, to the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, whereas a determination by the Board as to a defendant's right to obtain or retain a registration would not be binding or *res judicata* in respect to the proceeding pending before the court. *See Whopper-Burger, Inc. v. Burger King Corp.,* 171 USPQ 805, 807 (TTAB 1971), *cited in New Orleans Louisiana Saints LLC and NFL*

[5] Nonetheless, Opposer's counsel is warned that any further non-compliance with the Trademark Rules or deadlines set by the Board may constitute grounds for sanctions, including dismissal of the opposition. *Cf. Atlanta-Fulton v. DePalma*, 45 USPQ2d 1858, 1860 (TTAB 1998) ("Opposer brought this case and, in so doing, took responsibility for moving forward on the established schedule.").

Properties LLC v. Who Dat?, Inc., 99 USPQ2d 1550, 1552 (TTAB 2011). Additionally, the Board will suspend or maintain the suspension of a proceeding until the civil action at issue is considered to have been finally determined, that is, when a decision on the merits of the case has been rendered, and no appeal has been filed in regard thereto, or all appeals filed have been decided. *See* TBMP § 510.02(b) (2014).

Here, there is no question that the civil action between the parties will have a bearing on the Board proceeding. Plaintiff in the civil action, Aweida Arts, Inc., alleges that it is the corporate entity founded by Opposer,[6] and defendant in the civil action is Applicant herein. In the civil action, Aweida Arts, Inc. claims unfair competition, alleging that defendant's use of Aweida Arts' "SwissPerc" mark or a variant thereof is likely to cause confusion, mistake, and to deceive consumers (complaint, ¶¶ 15-16). Similarly, one of Opposer's grounds herein is likelihood of confusion. Thus, insofar as some of the issues to be addressed in the civil action are similar, if not identical, to the issues to be resolved in this case, the outcome of the civil action will likely have a bearing on this proceeding. In view thereof, Opposer's motion to suspend pending the outcome of the civil action is **granted**. Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a).

Accordingly, proceedings remain **SUSPENDED** pending final disposition of the civil action between the parties.

[6] Complaint, ¶7.

Within *twenty days* after the final determination of the civil action, the parties shall so notify the Board and the Board will call this case up for any appropriate action. During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

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