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

Proceeding	91209816
Party	Defendant Solomon Berman
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**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Quantum Test Prep,)	
)	Opposition No. 91209816
)	Serial No. 85804808
v.)	Mark: QUANTUM PREP
)	
Mr. Solomon Berman,)	
)	
Applicant.)	
)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

**Mr. Solomon Berman’s Opposition to Quantum Test Prep’s
Request for Reconsideration**

Mr. Solomon Berman (“Applicant”) hereby opposes Quantum Test Prep’s (“Opposer”) Request for Reconsideration (Docket #31), and respectfully requests that this Honorable Board to deny the Opposer’s motion and uphold its October 29, 2014 decision (Docket #28) in its entirety. In support thereof, Applicant submits the following legal standards and arguments:

I. Facts and Procedural Background

Opposer’s pretrial disclosures were due on July 10, 2014, the same day in which Opposer’s previous counsel filed his motion to withdraw. On July 16th, Opposer engaged new counsel, but waited until August 28th to file their notice of appearance and a motion to extend the trial testimony deadlines. (Docket #25) The Opposer’s motion to extend, albeit incorrectly, also requested an extension of time to produce their pretrial disclosures, which were long overdue.¹ Opposer’s motion was denied, and the proceeding was

¹ A motion to reopen, not an extension of time, was proper.

dismissed with prejudice because the Opposer, presumably assuming their motion to extend would be granted, failed to submit any evidence during its testimony period.

The only motions available to a party once a decision has been rendered are Motions for Reconsideration or Relief from Final Judgment. (TBMP § 518, 543, 544; 37 CFR § 2.129(c); Fed. R. Civ. P. 60(b); 37 CFR § 2.127(b)). Despite the post procedure avenues for action being very clearly laid out by the TBMP on October 31st Opposer incorrectly filed a Motion to Reopen the Trial Testimony Period (Docket #29). Even though the Opposer's filing was clearly improper the Applicant opposed the motion (Docket #30). The Opposer's Motion to Reopen the Trial Testimony Period is still pending. Now, despite already filing one post judgment motion, which the Board has not ruled on, Opposer has filed the instant motion in another attempt to save themselves from their own mistakes and failure to prosecute.

II. Legal Standard

A motion for reconsideration, modification or, clarification under 37 CFR § 2.127(b) must demonstrate that, with the facts and law before it in the original motion, the Board erred in reaching the order or decision it issued. *Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005) (reconsideration denied because Board did not err in considering disputed evidence). The motion for reconsideration may not be used to introduce new or additional evidence, nor should it be devoted to a reargument of the points presented in a brief on the original motion. Rather, the motion should be limited to a demonstration that based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change. See TBMP § 543; *Amoco Oil Co. v. Amerco, Inc.*,

201 USPQ 126, 127-28 (TTAB 1978) (motion for reconsideration requesting introduction of survey evidence available during movant's testimony period denied).

The only question that the Board need consider is whether the Board erred in reaching its conclusions based on the evidence that was properly placed on the record at the time it considered the motion, and any applicable law, and, if the Board did err, what the appropriate remedy of that error ought to be.

III. Argument

At its core, Opposer's argument in their Motion is that the Board, following their August 1, 2014 Order (Docket #23), did not expressly reinstate and reset the proceeding deadlines, which the Opposer assumed would happen. To properly put the August 1st Order in context an examination of the recent docket is required. Procedurally, six events occurred which gave rise to the Board's October 29th Order, which are reiterated here for convenience:

1. The Opposer's pretrial disclosures were due on July 10, 2014 (Docket #20).
2. Opposer's attorney, Douglas Burda, requested to withdraw his representation of the Opposer on July 10, 2014, the same day that the pretrial disclosures were due (Docket #21)
3. On July 16th Opposer engaged new counsel, and Opposer's new counsel emailed Applicant's counsel to inform him of this engagement. (Docket #26 Ex. 1)
4. On August 1st the Board accepted Burda's request to withdraw, and suspended the proceedings for 30 days to allow for Opposer, "...to appoint

new counsel, or to file a paper stating that oppose chooses to represent itself.” (Docket #23)

5. Opposer’s new counsel filed his Notice of Appearance on August 28, 2014 (Docket #24).
6. Opposer’s filed a Motion to Extend Time to file their PreTrial Disclosures (which were already seven (7) weeks past due), and the Trial Testimony Period on August 28, 2014. (Docket #25)

A. The Board was Correct in Viewing the August 28, 2014 Motion as a Motion to Reopen

The Board stated in its October 29, 2014 decision that

“As a threshold matter, insofar as the Opposer’s motion was filed after the deadline for serving its pretrial disclosures, namely, July 10, 2014, the Board treats Opposer’s motion as one seeking to reopen, rather than extend, the period to serve its pretrial disclosures.” (Docket #28, pgs. 2 – 3).

Given that not only was the Motion to Extend Time filed after the deadline, but also nearly two months after the deadline, the Board acted correctly in viewing the motion as a Motion to Reopen.

B. The Board’s Excusable Neglect Analysis was the Correct Analysis

As the Board has stated in many decisions, including this case, a Motion to Reopen is evaluated by the excusable neglect standard. The inquiry of that standard is done pursuant to *Pioneer Investment Services Co. v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), and *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997).

The Supreme Court, in *Pioneer*, articulated that the inquiry as to whether a party’s neglect is excusable is:

“...at bottom is 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.

This Board, in *Pumpkin*, 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)).

The Board, in its October 29, 2014 decision, went further to articulate that:

“...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 opposer’s neglect inexcusable in view of its 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”)” (Docket #28, pg. 3 – 4)

Once the Board acknowledged that the Opposer’s motion was, in actually, a motion to reopen given the motion’s filing date with respect to the pretrial disclosure due date, the Board correctly applied its analysis of the excusable neglect standard to Opposer’s August 28, 2014 motion.

C. Opposer Continues to Fail to Explain Why the Pretrial Disclosures Were Not Submitted, Nor the Egregious Delay in Filing its Motion to Reopen

Much of Opposer’s current argument rests on what its current attorney did or did not do. Regardless of whomever Opposer’s elects as counsel, it is Opposer’s responsibility to meet all deadlines prescribed by the Board in all orders.

“[Under] our system of representative litigation, a party must be held accountable for the acts and omissions of its chosen counsel, such that, for purposes of making the “excusable neglect” determination, it is irrelevant that the failure to take the required action was the result of the party’s counsel’s neglect and not the neglect of the party itself. *Pioneer Investment Services Co. v. Brunswick Associates Limited Partnership*, 507 U. S. 380, 113 S. Ct. 1489, 123 L. Ed. 2d 74 (1993) (citing *Link v Wabash R. Co.*, 370 US 626 (1962) and *United States v. Boyle*, 469 US 241 (1985))

In its request to withdraw as attorney Opposer stated that, “Burda has given due notice to Quantum [sic],” that, “Burda has allowed time for employment of another practitioner,” and that, “Burda has communicated to Quantum [sic] the seriousness of the matter and the *respective due dates for which responses(s) must be submitted.*” (Docket #22, emphasis added). The Board, in October 29, 2014 decision, clearly stated that:

“...Opposer has failed to explain why previous counsel did not adhere to the pretrial disclosure deadline; nor has Opposer explained why it waited six weeks after its retention of new counsel to file the instant motion, when new counsel was retained six days after the pretrial disclosure deadline.” (Board’s October 29, 2014 decision, pg. 6)

In Opposer’s current motion, and in Opposer’s October 31st² and August 28th³ motion, Opposer has continued to ignore the fundamental question as to why previous counsel did not adhere to the pretrial disclosure deadline, or why Opposer waited six weeks after its retention of new counsel to file a motion to reopen and extend the deadlines. *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (applicant’s motion to extend discovery denied when counsel knew of unavailability of witness a month before, yet delayed until last day to seek an agreement on an extension of time)

² See Docket entry #29

³ See Docket entry #24

The Board was precisely correct in its observation with respect to the third Pioneer Standard:

“Clearly, the decision to wait to file any motion before the Board was in the reasonable control of Opposer. In view of the foregoing, the Board finds that the third Pioneer factor weighs heavily against Opposer.” (Docket #28, page 6)

Therefore, Opposer still has not overcome the most important third *Pioneer* factor and provided any reason to find excusable neglect.

D. A Board Issued Notice That The Proceedings Suspension Was Concluded Was Unnecessary And Not To Be Expected

In Opposer’s instant motion, Opposer notes that the Board suspended the proceedings as of August 1, 2014, and argues, *inter alia*, that Opposer elected not to proceed with the opposition until the Board explicitly lifted the suspension and provided a new scheduling order. There is no such requirement on the Board. As stated in the TBMP,

“If proceedings have been suspended in order to allow a party, whose attorney or other authorized representative has withdrawn, a period of time in which to ...appoint new counsel...,the Board will resume proceedings, and go forward with the party proceeding...with newly-appointed counsel representing the party.” (TMBP § 510.03(b), *Pro-Cuts v Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993))

Therefore, it is not surprising that the Board did not explicitly provide the parties’ an order stating that the suspension was lifted or that any future deadlines were changed as a result of the Opposer’s August 28th Notice of Appearance

Additionally, simply because the Opposer filed a motion for extension of time, does not mean there is any change to the current deadlines, or any suspension of the proceedings. In fact, the Board has previously held, numerous times, that if a motion to extend time is denied, the time for taking such action remains as previously set. *National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008) (in view of the denial of

opposer's motion to extend discovery, "discovery dates remain as originally set and as a result, the discovery period is closed"); *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.*, 61 USPQ2d 1542, 1544 (TTAB 2001) (petitioner's testimony period consequently expired where motion to extend testimony period was denied and dates were left as originally set). Therefore, no change to the previous trial testimony period deadlines was warranted, and Opposer had no reason to expect any change.

Thus, since the thirty (30) day suspension automatically lifted on August 31st, and the Board denied Opposer's Motion to Extend, the Board was proper in determining that Opposer failed to submit any evidence during its set testimony period and has therefore failed to prosecute its claims. It is of no consequence that Opposer now argues that they intend to prosecute their claims. Opposer had ample time and opportunity to do so, but failed to take any steps to submit evidence during their prescribed trial period. Instead Opposer simply prayed that the Board would give them additional time, and risked the clear consequence of losing their opportunity to prosecute if the Board did not grant their extension request.⁴

IV. Appeal Deadline

Typically, the appeal date of a Board ruling is two months from the final judgment. TMBP 902.02; Trademark Act § 21(a)(2); 15 U.S.C. § 1071(a)(2). However, if party *properly* files a motion for reconsideration, which is then denied, the losing party's appeal date is two months from the denial of said motion. Opposer, undoubtedly, has failed to file a proper motion for reconsideration, therefore, they should not be able to benefit from the

⁴ As has been set forth fully in Applicant's opposition to Opposer's Motion to Extend the Deadlines, Opposer has repeatedly ignored and neglected the deadlines set forth by this Board, and the Federal Rules of Civil Procedure; this is just another instance of Opposer's neglect and failure to prosecute. (Docket #26)

extra time afforded to parties who properly comply with the rules and take the correct procedural steps. Applicant requests that the Board maintain the Opposer's current appeal date.

V. Further Filings and Motions

Opposer filed a motion on October 31, 2014, to which the Applicant has, for the benefit of the Board, and in concert with good practice, prepared and filed a response. Before the Board has issued a decision on Opposer's first motion, a second motion has now been filed, which, again, necessitated the Applicant to spend valuable time and resources to prepare and file this response. It is burdensome to the point of vexatious for the Applicant to continuously devote time and resources to a proceeding, where the motions that are now being filed are, in the opinion of the Applicant, and argued above, improper, and where the case has been adjudicated. Opposer has various appropriate options available to it under the rules for post-judgment relief, of which the constant filing of motions, mandating a response from the Applicant, is not one. Thus, the Applicant requests that the Opposer should be ordered to seek permission from the Board before filing and further papers with the Board and, in the absence of obtaining such permission, the Board should strike the paper as improperly filed.

Conclusion

Opposer failed to provide any evidence or explanation in its August 28, 2014 motion in order to meet the excusable neglect standard needed to reopen any tolled period. With a denial of Opposer's motion, all dates remained as set in the May 13, 2014 and August 1, 2014 Orders. Opposer failed to provide pretrial disclosures, failed to submit any testimony or evidence during its testimony period, and did not demonstrate any excusable

neglect as to why they did neither. Under the rules, Opposer was allowed ample opportunity to provide each, and pursue the merits of its claim, and did not. Applicant continues to deny Opposer's claim that it has the senior mark, as well as all other salient allegations in the Notice of Opposition, therefore, the Board's dismissal with prejudice was correct, and should stand.

Wherefore, Applicant respectfully requests this Board to:

- A. DENY Quantum Test Prep's Motion to Reconsider;
- B. ALLOW the Board's October 29, 2014 Order to remain undisturbed;
- C. Keep the dates of the appeal period set as is;
- D. ORDER Quantum Test Prep to seek permission of this Honorable Board before filing further motions relative to this proceeding; and,
- E. Grant any further relief that this Board sees fit.

Dated: December 10, 2014

Respectfully submitted,

Solomon Berman
By its Attorneys,
Lambert & Associates

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CERTIFICATE OF ELECTRONIC FILING

I HEREBY CERTIFY that this OPPOSITION TO QUANTUM TEST PREP'S REQUEST FOR RECONSIDERATION was filed electronically with the Trademark Trial and Appeal Board on December 10, 2014.

/s/ Brendan M. Shortell

Brendan M. Shortell

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of this OPPOSITION TO QUANTUM TEST PREP'S REQUEST FOR RECONSIDERATION was sent via email and first class mail on this day of December 10, 2014 to the Applicant's counsel of record at the following address:

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/s/ Brendan M. Shortell

Brendan M. Shortell