

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

Baxley

Mailed: February 2, 2005

Cancellation No. 92042132

Diva Deloayza d/b/a Diva
Designs/Bimbo

v.

Troy Dendekker

Andrew P. Baxley, Interlocutory Attorney:

Troy Dendekker ("respondent") is the record owner of a registration for the mark BOY BEATER in typed form for "clothing, namely, shorts, swim wear, shirts, pants, athletic shoes, hats, jackets, tank tops, T-shirts, blouses, underwear, dresses, gloves, thongs, socks, dresses, headbands, wristbands, skirts, tube tops, halter tops and scarfs" in International Class 25.¹

Diva Deloayza d/b/a Diva Designs/Bimbo ("petitioner") filed a petition to cancel respondent's registration on May 30, 2003 on the ground that "the purported mark ... is a generic term in reference to sleeveless t-shirts designed

¹ Registration No. 2554024, issued March 26, 2002, and alleging September 23, 2001 as the date of first use and date of first use in commerce. A document reflecting the assignment of the involved registration from Solid Printing, Inc. to respondent was recorded on February 3, 2003 with the USPTO's Assignment Branch at Reel 2664, Frame 0353.

Cancellation No. 92042132

for and/or worn by women and girls." Following the Board's issuance of a notice instituting this proceeding, respondent filed an answer on July 31, 2003 and served that answer directly upon petitioner, rather than on petitioner's counsel. After the close of the discovery period on January 6, 2004, neither party filed any evidence or took any testimony during their assigned testimony periods.

On October 27, 2004, the Board issued to petitioner an order to show cause by the petition should not be denied under Trademark Rule 2.128(a)(3) because she had not filed a brief on the case herein. In response thereto, petitioner filed a motion to reopen discovery on November 23, 2004. The motion has been fully briefed.²

In support of her motion, petitioner contends that she failed to timely act because she did not receive the Board's notice instituting this proceeding and thus was unaware of any deadlines herein. Petitioner further contends that the first communication that she received from the Board regarding this proceeding was the October 27, 2004 order to show cause; that respondent will not be prejudiced by reopening discovery; that reopening discovery will have no impact on judicial proceedings; and that petitioner is acting in good faith. Accordingly, petitioner contends that

² Because the reply brief clarifies the issues before us, we have, in our discretion, considered it. See Trademark Rule 2.127(a).

Cancellation No. 92042132

she has shown that her failure to act in a timely manner was caused by excusable neglect and asks that the Board reopen discovery herein.³

In opposition thereto, respondent contends that petitioner's failure to act in a timely manner was caused by the failure of petitioner to inquire about the status of this case in any manner for seventeen months after she filed the petition to cancel. In particular, respondent contends that petitioner failed to review the Board's TTABVUE online database, which has been accessible since fall 2003, i.e., prior to the close of the discovery period, or to contact the Board to determine the status of this case. Respondent further contends that he will be prejudiced because two witnesses upon whom he intended to rely for trial testimony have relocated and are "no longer readily available;" and that resolution of the proceeding would be delayed significantly by reopening the discovery period.⁴ Accordingly, respondent asks that the Board deny petitioner's motion and deny the petition to cancel with prejudice under Trademark Rule 2.132(a) due to petitioner's

³ We note the proposed discovery and trial schedule that petitioner included in her motion to reopen. Proposed dates should not be included in an unconsented motion to reopen. The better practice is to request an extension of a specific length to run from the mailing date of the Board's decision thereon. See TBMP Section 509.02 (2d ed. rev. 2004).

⁴ Respondent, however, concedes that there is no evidence of bad faith by petitioner.

Cancellation No. 92042132

failure to take testimony or file evidence during her testimony period.

In reply, petitioner contends that respondent's claim that he will be prejudiced by reopening discovery is conclusory and self-serving because respondent has provided no specific information as to the nature of the testimony of the two relocated witnesses, as to whether others could not provide the same information, and as to why their relocation will prejudice respondent when this proceeding will likely be conducted on paper. Petitioner further contends that respondent is essentially arguing that a plaintiff has a duty to be aware of deadlines in Board proceedings, even in the absence of receiving a scheduling order.

Because the discovery, testimony and briefing periods have closed, to reopen the proceeding essentially at its beginning commencing with discovery, petitioner must show that her failure to act in a timely manner was caused by excusable neglect. See Fed. R. Civ. P. 6(b); TBMP Section 509.01(b) (2d ed. rev. 2004). In *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), the Supreme Court clarified the meaning and scope of "excusable neglect," as used in the Federal Rules of Civil

Cancellation No. 92042132

Procedure and elsewhere. The Court held that the determination of whether a party's neglect is excusable 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 subsequent applications of this test, several courts have stated that the third *Pioneer* factor, namely the reason for the delay and whether it was within the reasonable control of the movant, might be considered the most important factor in a particular case. See *Pumpkin*, *supra* at footnote 7 and cases cited therein. Therefore, we turn initially to the third *Pioneer* factor.

After reviewing the parties' arguments carefully, we find that petitioner's failure to timely act was caused both by her failure to receive the Board's notice instituting this proceeding and by respondent's failure to serve properly his answer upon petitioner's attorney and that both of these failures were beyond her reasonable control. Because an attorney filed the petition to cancel and the Board's notice instituting this proceeding set forth the address of that attorney as petitioner's correspondence address, respondent was required to serve his answer upon

Cancellation No. 92042132

petitioner's attorney. See Trademark Rule 2.119(b) ("Service of papers must be on the attorney ... of the party if there be such...").⁵

With regard to the first *Pioneer* factor, we find that respondent has failed to provide sufficient information to show that reopening the discovery period herein will prejudice him. Respondent contends in his brief in opposition to petitioner's motion to reopen discovery that two unnamed witnesses upon whom he intended to rely for testimony have relocated and are "no longer readily available." Brief in opposition at 2. Respondent, however, has provided no specific information to support this contention, such as the nature of the testimony that the two relocated witnesses would provide, how their relocation has adversely affected their availability, and whether others could not provide the same information. Further, with regard to the fourth *Pioneer* factor, respondent has conceded that there is no evidence of bad faith by petitioner.

However, with regard to the second *Pioneer* factor, we find that, because petitioner did not file its motion to reopen the discovery period until more than ten months after

⁵ Nonetheless, we note that petitioner, as the plaintiff herein, has a burden to move this case forward without undue delay. As such, she should have realized sooner that she had not received any communication from the Board with regard to this proceeding and could have either contacted the Board or reviewed the Board's TTABVUE online database to inquire as to the status of this proceeding.

Cancellation No. 92042132

the closing date thereof and because additional time has lapsed due to the time necessary to brief and decide that motion, the length of the delay caused by petitioner's motion to reopen discovery has disrupted the orderly administration of this case. Nonetheless, we find that, on balance, petitioner has adequately shown that her failure to timely act was caused by excusable neglect and that she is entitled to a brief reopening of the discovery period.

In view thereof, petitioner's motion to reopen discovery is hereby granted. Discovery and trial dates are hereby reset as follows.⁶

DISCOVERY PERIOD TO CLOSE:	04/08/05
Plaintiff's 30-day testimony period to close:	07/07/05
Defendant's 30-day testimony period to close:	09/05/05
15-day rebuttal testimony period to close:	10/20/05

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served

⁶ Petitioner is advised, however, that, in view of respondent's objection to the reopening of the discovery period and because the discovery period in this case had first closed more than one year ago, she will be allowed no further extensions in this case without either respondent's consent thereto or a detailed showing of extraordinary circumstances.

We note respondent's statement that two witnesses upon whom he intended to rely are no longer readily available. If respondent requires an extension of his testimony period to obtain the testimony of those witnesses, the Board will be amenable to such a request.

Cancellation No. 92042132

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 Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.