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

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Mailed: December 29, 2010

Cancellation No. 92044697

ACM Enterprises, Inc.

v.

Jeanette Martello

Before Zervas, Walsh, and Cataldo, Administrative Trademark Judges:

By the Board:

This case comes before the Board on petitioner's motion, filed July 7, 2010, to reopen its testimony period, and respondent's cross motion to dismiss pursuant to Trademark Rule 2.132. The motion is contested. The delay in acting upon this matter is regretted.

On July 1, 2005, ACM Enterprises, Inc. filed a petition to cancel Registration No. 2932593 for the mark SKIN DEEP for "medical services; healthspa services, namely cosmetic body care services; cosmetician services; physician services" on the grounds of priority and likelihood of confusion, nonuse, and fraud. Respondent filed an answer denying the salient allegations of the petition to cancel.

On March 12, 2010, the Board denied respondent's motion for summary judgment, allowed petitioner time to file an amended fraud claim, and reset dates, with petitioner's testimony period reset to close June 15, 2010.

On April 11, 2010, petitioner filed an amended petition to cancel with an amended fraud claim and on May 11, 2010, respondent filed an answer denying the salient allegations of the amended petition to cancel. On May 14, 2010, new counsel for respondent filed an appearance and change of address. On May 19, 2010, new counsel for petitioner filed an appearance and change of address. Petitioner filed no testimony or evidence of any kind during its testimony period.

Petitioner's motion to reopen its testimony period must demonstrate that petitioner's failure to take testimony or introduce admissible evidence within the prescribed testimony period was a result of excusable neglect, as required by Fed. R. Civ. P. 6(b)(2). The Board's "excusable neglect" standard was discussed in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), which followed the test set out by the Supreme Court in *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993).

In *Pioneer*, the 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 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*, at footnote 7 and cases cited therein.

In support of its position that its failure to submit testimony was due to excusable neglect, petitioner submits the declaration of attorney Marc Hankin and attached email communications. Mr. Hankin avers that on May 19, 2010, he requested a meeting with counsel for respondent Thomas Daly on May 21, 2010 and was told that Mr. Daly was unavailable on that date but was willing to meet the following week. Mr. Hankin informed Mr. Daly that he needed to start taking testimony the next week but would also be willing to re-open settlement talks. Mr. Daly noted that he was aware of no notice of testimony but remained willing to talk the following week. On May 24, 2010, counsel for respondent

requested a meeting with Mr. Hankin. On May 30, 2010, Mr. Hankin responded "I am sorry, but this past week just got away from me. Let's speak on Tuesday." There was no further communication between the parties during petitioner's testimony period. On June 16, 2010, after petitioner's testimony period closed, Mr. Hankin made two settlements offers to counsel for respondent which were rejected. Petitioner contends that when Mr. Daly was unavailable to meet as proposed, "out of courtesy" counsel for petitioner cancelled plans to take the testimony of petitioner the following week, that petitioner believed the case was likely to settle, and that petitioner should not now be barred from presenting its case on the merits.

In support of its opposition to any reopening or finding of excusable neglect, respondent submits the declaration of attorney Thomas Daly averring that he was unable to meet with Mr. Hankin on the day requested; that he proposed alternate dates and sent a follow-up email indicating his availability; that he received a subsequent email from Mr. Hankin suggesting that they talk June 1, 2010; that despite Mr. Hankin's announced plans to take testimony the week of May 24, 2010, Mr. Daly received no further communication until after the close of petitioner's testimony period.

In applying the *Pioneer* factors, the Board notes that there is no disagreement about what transpired between the parties. Respondent does not contend that petitioner's failure to submit evidence during its trial period poses any prejudice, other than mere delay and the expense associated with briefing the motion, so this factor favors petitioner. The motion was filed three weeks after petitioner's testimony period closed, and it has taken the Board five months to act upon the motion, so there has been a substantial delay to this proceeding, and this factor favors respondent. Respondent does not allege bad faith by petitioner, so this factor is neutral. However, we find that the third *Pioneer* factor heavily favors respondent. Petitioner was not asked to delay its plans to take testimony, did not inform counsel of its decision to do so, and took no timely action to reschedule testimony depositions, to extend its testimony period, or to suspend this proceeding for settlement discussions. In these circumstances we find that petitioner is solely responsible for its failure to submit evidence during its trial period. Considering all relevant *Pioneer* factors, petitioner has not demonstrated excusable neglect. *Polyjohn Enterprises Corporation v. 1-800-TOILETS, Inc.*, 61 USPQ2d 1860 (TTAB 2002)(Board found no excusable neglect for petitioner's failure to present its case where the record did not

indicate that respondent shared petitioner's understanding that discovery and, ultimately, trial had been suspended). Inasmuch as petitioner has failed to make the requisite showing of excusable neglect, the request to reopen the testimony period is denied, and judgment is entered for respondent. Fed. R. Civ. P. 6(b) and Trademark Rule 2.132(a).

Accordingly, the petition to cancel is dismissed with prejudice.

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