

ESTTA Tracking number: **ESTTA250903**

Filing date: **11/24/2008**

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

Proceeding	92047013
Party	Plaintiff NeTrack, Inc.
Correspondence Address	Carl Oppedahl Oppedahl Patent Law Firm LLC P.O. Box 4850 Frisco, CO 80443-4850 UNITED STATES docket-oppedahl@oppedahl.com
Submission	Opposition/Response to Motion
Filer's Name	Carl Oppedahl
Filer's e-mail	docket-oppedahl@oppedahl.com
Signature	/s/
Date	11/24/2008
Attachments	20081124-opposition-to-motion-to-suspend.pdf ( 7 pages )(98543 bytes )



For such an issue to be raised half way through trial is exceptional.

Registrant's first strategic decision on this point was **not to conduct discovery at all**. Registrant, advised by counsel, permitted the discovery cutoff date of August 20, 2007 to pass without taking any discovery whatsoever. Registrant did not seek a consent to suspend the proceedings and was on notice that the case was proceeding as scheduled.

The safest course of action for a party in pursuit of settlement is to seek the adverse party's permission to file a consented motion to suspend. See *Instruments SA, Inc. v. ASI Instruments, Inc.*, 53 USPQ2d 1925 (TTAB 1999). All motions to suspend, regardless of circumstances and even with the adverse party's consent, are subject to the "good cause" standard. See Trademark Rule 2.117(c). In the absence of consent, the party seeking suspension is also expected to comply with its responsibilities. For a plaintiff in a Board proceeding, that means not only shouldering the burden of proof at trial but also the responsibility for moving the case forward on the prescribed schedule.

(Emphasis added.) *National Football League, NFL Properties LLC v. DNH Management, LLC*, Opposition No. 91176569 at Note 8 (TTAB 2008).

In addition, to the extent that a party can obtain relief from the Board based on "excusable neglect", Registrant cannot qualify for said relief because Registrant had reasonable control of its actions and decisions and was aware, or should have been aware, that the case was proceeding according to the set trial schedule absent a suspension order from the Board. See e.g., *E. & J. Gallo Winery v. Fine Spirits Distribution, LLC*, Opposition No. 91175854 at 3-4 (TTAB 2008) (Non-Precedential) ("Accordingly, we turn to the third factor and find that applicant's failure to respond to the motion for summary judgment was caused by its complete failure to act and to monitor the time periods in this proceeding. Such action was wholly within the reasonable control of applicant," applying factors for "excusable neglect" in *Pioneer Investment Services*

*Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380, 395 (1993), and as discussed by the Board in *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997)).

Registrant's second strategic decision on this point was **to ask the TTAB to reopen discovery**. Registrant, still advised by counsel, filed a motion to reopen discovery on August 30, 2007 (paper number 6), justifying its request to reopen based on Registrant's assertion that it was trying to negotiate a settlement with Petitioner. Notably, merely asserting that settlement negotiations were ongoing does not rise to the level of excusable neglect such that discovery should be reopened. *Id.* at 6-7 (ruling against opposers' request to reopen discovery based on the excuse that settlement negotiations were ongoing, finding that opposers knew or should have known that settlement or even legitimate talk of settlement was highly unlikely, and that opposers could not have reasonably concluded that they need not move forward and serve requests for discovery. "Indeed, after receiving no response to the multiple attempts to contact applicant to discuss settlement . . . , opposers still had ample time remaining to serve discovery.")

Registrant's third strategic decision on this point was unilaterally **to withdraw its motion to reopen discovery**. Registrant, still advised by counsel, filed a motion to withdraw its motion to reopen discovery. This was on November 30, 2007 (paper number 13).

Trial was set to commence on October 1, 2008. With five days left before trial was due to commence, Registrant's fourth strategic decision was yet again **to ask the TTAB to reopen discovery**. Registrant, still advised by counsel, filed this second motion to reopen discovery on September 25, 2008 (paper number 20).

This adds up to too many flip-flops in Registrant's strategy. First, Registrant does not want to do discovery. Then, Registrant wants to do discovery. Then, Registrant does not want to do discovery. Then, again, Registrant wants to do discovery. Throughout these flip-flops, Petitioner was forced to spend its limited resources responding to each and every "gamesmanship" move by Registrant, gamesmanship upon which the Board has already frowned (paper 19 at page 2). If the Board is serious about its concern about the filing of excessive motions that reflect "gamesmanship", then Registrant's present motion to suspend should not be rewarded.

Registrant, advised by counsel, surely knew that its second motion to reopen discovery could not possibly be ruled upon by the TTAB with only five days remaining before the commencement of trial. (Indeed due to the lateness with which the motion was filed, the motion could not even be fully briefed until *after all of Petitioner's evidence* had been presented at trial.) If there had been a correct time for a motion to suspend, it would have been *prior* to the start of the trial. A suspension granted at that point would have postponed not only Registrant's part of the trial but also Petitioner's part of the trial.

For Registrant to wait until after Petitioner's evidence has been presented, and indeed to wait until after Petitioner has revealed its entire case, and only then to move to suspend, is disingenuous at best, and violates any sense of a fair trial. It would be unfair (to state it mildly), and contrary to the administration of justice, if after seeing Petitioner's trial evidence, Registrant were to be permitted a suspension and a reopening of discovery.

The lack of fairness in Registrant's actions can, perhaps, also be seen in the manner in which Registrant served the present Motion. Registrant filed its Motion with the TTAB on November

14, 2008. Registrant did not, however, serve its Motion upon Petitioner in any fast way. Instead Registrant merely dropped the Motion into the mail. The Motion did not arrive in Petitioner's office until today, November 24, 2008. The first time that Registrant even mentioned its Motion to Petitioner was in a chance telephone call on November 18, 2008, four days later. These events all present themselves against a backdrop of a trial in progress with a testimony period to open just a week from now.

Had Registrant had the courtesy to communicate the filing of this supposedly urgent Motion to the Petitioner by fax or email or telephone, the unfairness might be less. But Registrant's chosen way to communicate the filing of this supposedly urgent Motion was simply to lick a stamp and drop it into a mailbox.

The same no-hurry conduct presents itself with regard to Registrant's Request for Telephonic Hearing (TTAB paper number 39). This paper, supposedly presenting an urgent need for an *inter partes* telephone conference, was e-filed with the TTAB on November 14. But did Registrant communicate this supposedly urgent need to Petitioner on that day, or the next day, or the day after that? No. Registrant dropped the service copy in the mail and it was delivered today, November 24. The first that Registrant communicated anything to Petitioner about this Request was on November 18, 2008 (four days later), *after* Registrant had already carried out *ex parte* communications with the TTAB. Registrant's conduct, in serving this paper by the slowest possible means, belies any claim that the matter was actually so urgent as was intimated.

Conclusion:

Petitioner's interests will be greatly prejudiced in terms of the conduct of the present proceeding

as well as in terms of additional costs and the unjustified delay in bringing the present case to closure, if any course of action is taken other than having the trial proceed as scheduled.

The trial is half over, and now it is time for the other half. The trial should proceed as scheduled.

WHEREFORE, Petitioner respectfully requests that the Board DENY Registrant's Motion to Suspend.

Respectfully submitted,

Oppedahl Patent Law Firm, LLC

By: \_\_\_\_\_/s/\_\_\_\_\_

PTO Reg. No. 32746  
Carl Oppedahl  
Oppedahl Patent Law Firm, LLC  
P O Box 4850  
Frisco, CO 80443-4850

Tel: + 1 970 468-8600  
Fax: +1 970 468-5432  
[www.oppedahl.com](http://www.oppedahl.com)

Certificate of Service

I hereby certify that a true and accurate copy of the foregoing paper is being deposited on November 24, 2008 with the United States Post Office, First Class postage prepaid, and addressed to the Registrant's Correspondent as follows:

SUSAN E. HOLLANDER & BRITT L. ANDERSON  
MANATT, PHELPS & PHILLIPS, LLP  
1001 PAGE MILL ROAD, BLDG. 2  
PALO ALTO, CA 94304

/s/

Carl Oppedahl