

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

Mailed: November 28, 2008

Cancellation No. 92047013

NeTrack, Inc.

v.

Internet FX, Inc. and
NetTrack Lead Manager
Solutions, Ltd.¹

**M. Catherine Faint,
Interlocutory Attorney:**

Before the Board are the following fully-briefed motions:

- 1) respondent's motion to reopen discovery and reset testimony periods, filed September 25, 2008; 2) petitioner's motion to strike portions of respondent's motion to reopen and the accompanying declaration, filed October 14, 2008;
- 3) respondent's motion to strike Exhibits H and J through Y to petitioner's Notice of Reliance, filed November 6, 2008;
- 4) respondent's motion to strike the Dijker deposition submitted with petitioner's Notice of Reliance, filed November 6, 2008;
- 5) respondent's motion to suspend proceedings for consideration of the motion to reopen discovery, filed November 14, 2008; and
- 6) respondent's motion for a teleconference for consideration of the motion to reopen discovery, filed November 14, 2008.

On November 25, 2008 the Board held a telephone conference involving Carl Oppedahl, counsel for NeTrack, Inc., Britt Anderson, counsel for NetTrack Lead Manager Solutions, Ltd., and Interlocutory attorney Catherine Faint, Board attorney responsible for resolving interlocutory matters in this case. The Board assumes the parties familiarity with the motions and arguments in the pending motions and does not repeat them here.

Joinder

Petitioner has repeatedly noted in its motions and responses that an assignment of Registration No. 3064820, the registration that is the subject of this cancellation proceeding, has been filed with the Assignments Division of the USPTO at reel/frame nos. 3569/0515 and 3640/0542. A review of the assignments database shows assignment of the entire interest and goodwill in the subject registration to NetTrack Lead Manager Solutions, Ltd. on March 23, 2007. This assignment occurred after the filing of the petition to cancel. It is the practice of the Board to join, rather than substitute, an assignee when the assignment occurred after the commencement of the proceeding in order to facilitate discovery. See TBMP § 512 (2d ed. rev. 2004). As the assignment was after the institution of this proceeding,

¹ NetTrack Lead Manager Solutions, Ltd. has been joined as a party defendant as discussed below.

NetTrack Lead Manager Solutions, Ltd. is joined as a party defendant.

Motion to Suspend

Respondent's motion to suspend is granted to the extent that these proceedings are considered suspended as of the filing date of the motion.²

Motion for Teleconference

Respondent's motion for a teleconference is granted. However, the Board in its discretion has extended the teleconference to all pending motions currently in this proceeding.

Petitioner's Motion to Strike Portions of Respondent's Motion to Reopen

Turning next to petitioner's motion to strike portions of respondent's motion to reopen and the accompanying declaration, and petitioner's renewal of its previously filed motion to strike,³ petitioner argues that respondent has included confidential settlement information in both its current and previous motions to reopen discovery by recounting the details of settlement negotiations between the parties. By including this information in the motions and supporting declarations, petitioner argues that respondent has violated Fed. R. Evid.

² It is noted that petitioner's opposition to the motion to suspend, while filed on November 24, 2008 did not appear in the electronic file until this teleconference had commenced.

³On August 30, 2007, respondent filed a motion to reopen discovery, and petitioner filed a motion to strike on substantially the same grounds as those reiterated in the current motion. As noted in the Board's order of August 28, 2008, respondent withdrew the motion to reopen, and thus petitioner's motion to strike was deemed moot.

401 and 403, and violated the public policy behind Fed. R. Evid. 408.⁴ Respondent argues that the statements are relevant to the reasons behind its request for a reopening of discovery, are not prejudicial and fall within the exceptions to Fed. R. Evid. 408, which involve evidence directed to bias, prejudice, undue delay, and the like.

We agree that the information offered by respondent is not offered to prove liability or the invalidity of petitioner's claim, it is not irrelevant and it is not prejudicial. What respondent has offered is a timeline and the status of settlement negotiations to support its arguments regarding excusable neglect. If, for instance, these proceedings had been suspended for settlement negotiations, and the parties sought further extensions, the Board would have required information such as that presented by respondent to report the status of settlement negotiations before granting further suspensions. There is no inappropriate or confidential information offered by respondent in its motions and declarations.

To the extent petitioner argues that this information somehow violated an agreement between the parties, the Board

⁴ Fed. R. Evid. 401 requires that evidence submitted must be relevant. Fed. R. Evid. 403 excludes relevant evidence where its probative value is substantially outweighed by the danger of unfair prejudice, confusion of the issues, misleading the jury, and similar reasons. Fed. R. Evid. 408 prohibits evidence of settlement offers where the information is offered to prove liability for, or the invalidity of a claim.

disagrees. While it appears the parties have agreed that nothing in the settlement discussions are admissible as evidence, mention of the fact of settlement negotiations is not clearly circumscribed. And it is petitioner, rather than respondent who has offered an actual communication, in the form of the October 1, 2007 email communication, into evidence.

Accordingly, petitioner's motion to strike is denied.

Respondent's Motion to Reopen Discovery and Reset Testimony Periods

Considering next respondent's motion to reopen discovery and reset testimony periods, the standard for reopening a prescribed period of time is "excusable neglect." Fed. R. Civ. P. 6(b). Such a determination is an equitable one that must take into account 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. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997) (citing *Pioneer Investment Services Co. v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993)).

The kind of prejudice to be considered is that such as the unavailability of witnesses or the loss of evidence because of the delay. There is no such allegation here. Therefore this is not a significant factor.

The length of the delay in this proceeding is measured by the length of time between the original close of discovery and the filing of the first motion to reopen, which was very short. And more recently, the time period since the Board's August 28, 2008 order. That time also was very short, a period of less than one month. Thus we find the delay is not significant. There is no allegation of bad faith.

The reason for the delay and whether it was in the reasonable control of the movant, might be considered the most important factor in a particular case. *Atlanta-Fulton County Zoo Inc. v. DePalma*, 45 USPQ2d 1858, 1859 (TTAB 1998). The reason offered in this case, that the parties were involved in settlement negotiations is enough where the parties were both actively engaged in those settlement negotiations with some expectations of settlement. This is not a case where there was a one-sided attempt at resolution as in *Atlanta-Fulton*. The parties should note, however, that the more prudent route is to file a motion for suspension during settlement negotiations.

Thus we find on balance that respondent has shown excusable neglect. Accordingly, the motion to reopen discovery is granted to the extent that discovery will reopen on Tuesday, December 2, 2008 for 45 days.

Respondent's Motion to Strike Evidence Offered through Notices of Reliance

We turn finally to respondent's motions to strike Exhibits H and J through Y to petitioner's Notice of Reliance, and the Dijker deposition submitted with petitioner's Notice of Reliance.

Turning first to Exhibit M, it appears that petitioner intended to submit this as a status and title copy of its own registration. The date of the printout is shown as September 7, 2007 and it was submitted on October 14, 2008. Trademark Rule 2.122(d)(2) allows a party to a proceeding to enter a registration it owns into evidence through a notice of reliance, but the copy of the registration submitted must be reasonably contemporaneous with the filing. See TBMP § 703.02(a) (2d ed. rev. 2004). As the copy submitted was over one year old, it is not reasonably contemporaneous and is stricken on that ground.

Exhibits H, J through L, and N through Y appear to be Internet printouts and documents from private database providers that do not consist of printed publications available to the general public. See Trademark Rule 2.122(e). Trademark Rule 2.120(j)(3)(ii) provides, that a party may not introduce into evidence by notice of reliance alone documents produced in response to a request for production of documents and things, except those falling under the purview of Trademark Rule 2.122(e). The Board has held, however, that documents are admissible pursuant to Trademark Rule 2.120(j)(3)(i), if they

are produced for inspection by a party in accordance with Fed. R. Civ. P. 33(c) in lieu of answering interrogatories. See, *Miles Laboratories, Inc. v. Naturally Vitamin Supplements, Inc.*, 1 USPQ2d 1445, 1447 n.9 (TTAB 1986).

There is, however, a caveat to this practice. That is, the party seeking to take advantage of this practice must specify in the notice of reliance that the documents are being introduced pursuant to Trademark Rule 2.120(j)(3)(i), must specify and make of record a copy of the particular interrogatory or interrogatories to which each document was provided in lieu of an interrogatory answer, indicate generally the relevance of the material being offered, and must identify, with some degree of specificity, the nature of each of these documents. Cf. *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 950 (TTAB 1981). It is not sufficient to state in the notice of reliance, as petitioner has done here, that the documents being introduced were produced in response to petitioner's interrogatory request No. 9 and its request for production of documents and things.

Accordingly, the documents are stricken.

As to the Dijker declaration, Trademark Rule 2.123(b) provides the parties must stipulate in writing that affidavits (or declarations) may be submitted as testimony depositions. Respondent argues that no such stipulation was entered into by the parties. Accordingly the Dijker declaration is stricken.

However, petitioner will have an opportunity to cure these deficiencies in its evidence as the trial dates will also be reset as set out below.

No Further Motions May be Filed without First Seeking Leave to File

The parties may file no further pretrial motions without first contacting by telephone the Interlocutory Attorney assigned to this case, and receiving leave to file a motion.

Reset Dates

Dates are reset as set out below.

DISCOVERY PERIOD TO CLOSE: **January 16, 2009**

30-day testimony period for party in position of plaintiff to close: **April 16, 2009**

30-day testimony period for party in position of defendant to close: **June 15, 2009**

15-day rebuttal testimony period for plaintiff to close: **July 30, 2009**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served 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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.
