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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
Submission	Opposition/Response to Motion
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Attachments	20070919_FinalResponseWcert.pdf (12 pages)(98541 bytes)

and things, and/or requests for admission will not be heard to complain, when it receives responses thereto after the close of the discovery period, that it needs an extension of the discovery period in order to take "follow-up" discovery.

(TTAB Manual §403.04.) As mere delay in initiating discovery does not constitute good cause for an extension of the discovery period, it certainly should not constitute good cause for reopening the discovery period.

The following facts leading up to Registrant's request illustrate mere delay in initiating discovery and do not justify reopening the discovery period.

- Registrant opted not to conduct any discovery during the established six-month discovery period.
- Although settlement discussions occurred during the discovery period, the case did not settle before the discovery period ended.
- Registrant gambled that the case would settle prior to the end of the discovery period, a gamble that did not pan out.
- Registrant was aware of the approaching date for the end of the discovery period.
- As the end of the discovery period approached without a "meeting of the minds" resulting in a signed settlement agreement, Petitioner did what any reasonable practitioner would do when faced with similar situation, put aside other work and hastily prepared and sent discovery requests to Registrant prior to the deadline.

Registrant deliberately chose to disregard the approaching date that ended the discovery period.

It would be unfair to Petitioner to reopen discovery, as Petitioner, faced with the same deadline

and lack of a signed settlement agreement, did in fact prepare discovery requests prior to the deadline.

Registrant fails to show “excusable neglect,” as required under Federal Rules of Civil Procedure §6(b), as well as §509.01(b) of the TTAB Manual to reopen the discovery period.

In order to “reopen” the discovery period, the Registrant must show that its failure to conduct any discovery during the six month period was the result of “excusable neglect”. (See TTAB Manual §509.01(b) Motions to Reopen Time and Fed. R. Civ. P. 6(b)).

The factors for determining whether “excusable neglect” was shown by the Registrant are set forth by the Supreme Court in *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993), adopted by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997). The excusable neglect determination must take into account all relevant circumstances surrounding the party’s omission or delay, including:

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.

(TTAB Manual §509.01(b))

1. Reopening the discovery period will be prejudicial to Petitioner. Petitioner and Registrant were similarly situated as the end of the discovery period approached. As with most cases involving competent practitioners looking out for their client's best interests, settlement was being discussed. However, the parties had not yet officially reached agreement on what it would take to settle the case. Out of the abundance of caution, Petitioner prepared and mailed discovery requests to the Registrant prior to the discovery deadline.¹ A substantial amount of time, effort, and money was invested in the last-minute preparation of Petitioner's discovery requests in order to meet the deadline. This is money that no longer will be available to the Petitioner as a resource as the case progresses. Registrant's claim on page 6 of its motion that: "petitioner can only gain by reopening the discovery period," is simply not true. By reopening discovery, Petitioner will in a sense be punished for "turning in its homework on time." Registrant will be allowed to conduct discovery that it had previously purposely chose not expend resources on. The new time period will also allow Registrant to prepare its discovery requests for the first time in a much less rushed situation than Petitioner's last minute preparations to meet the deadline. While Petitioner will also have the opportunity to conduct additional discovery, doing so will cause Petitioner to incur additional expenses that may not have been necessary if Registrant had

¹At the time the discovery requests were served, Petitioner was unsure whether to serve the papers directly on Registrant or on Manatt, Phelps & Phillips, LLP. The reason for the confusion is that upon review of the case file at the TTAB, there was nothing to indicate officially that Registrant was being represented by counsel. Specifically, the answer to the Petition to Cancel was signed by Chris Graver, the President of Internet FX, Inc. Thus, out of the abundance of caution, Petitioner sent copies of the discovery requests to both Registrant and to Manatt, Phelps & Phillips, LLP. Petitioner took the further step of including a cover letter with the discovery requests which explained that both Registrant and Manatt, Phelps & Phillips, LLP were sent copies of the discovery requests and why Petitioner made the decision to do so. A copy of the discovery cover letter is attached as Exhibit A.

conducted discovery during the original specified time period.

Registrant claims that it would “be greatly prejudiced by the inability to take discovery”. (See page 6 of Registrant’s Motion). Registrant had the exact same opportunity to take discovery as Petitioner and yet deliberately chose not to. On information and belief, there was never a time during the six-month discovery period that Registrant had an “inability to take discovery”, thus there would be no prejudice towards the Registrant because Registrant was entitled to the same original discovery period as the Petitioner. If the board reopens the discovery period, the board will be rewarding Registrant for choosing not to comply with the discovery rules. This would be incredibly prejudicial to the Petitioner who instead elected to follow the rules.

2. Granting Registrant’s motion to reopen discovery will delay judicial proceedings by at least three additional months. Registrant attempts explain that the judicial proceedings will not be significantly delayed because Registrant’s request was made only two days after discovery closed. (See page 7 of Registrant’s Motion to Reopen Discovery Period and Reset Testimony and Trial Periods (“Registrant’s Motion”)). Registrant then cites *Champagne Louis Roederer v. J. Garcia Carrion*, S.A. 2004 TTAM LEXIS 235 (T.T.A.B 2004), a case that granted a request to reopen the discovery period because the movant acted “swiftly”.² In addition, the additional time period for discovery requested by the movant in the non-citable case was only 30 days, one third of that requested by Respondent in the present case.

²Petitioner notes that this opinion is specifically identified as “NOT CITABLE AS PRECEDENT OF THE TTAB”.

3. The reason for Registrant's delay in conducting discovery was completely in the reasonable control of the Registrant. According to §509.01(b) of the TTAB Manual, “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 §509.01(b) of the TTAB Manual). In the present case, Registrant purposely chose to not to conduct discovery. Registrant's failure to conduct discovery was intentional and not a mistake. Registrant had six months to conduct discovery during the discovery period and consciously failed to do so.

Registrant's excuse for not conducting discovery was that Registrant had a “good faith belief that it had reached a resolution of this matter with Petitioner in April 2007.” (See page 7 of Registrant's Motion). This statement is puzzling as a signed settlement agreement still did not exist four months later in August 2007. In August 2007, terms were still being discussed and had not yet been agreed upon which further prevented a settlement agreement from being finalized and signed. The TTAB Manual §509.01(b) cites *Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858 (TTAB 1998) which states, “failure to timely move to extend testimony period was due to counsel's oversight and mere existence of settlement negotiations did not justify party's inaction or delay”.

Registrant also claims that it was Petitioner's fault that Registrant did not conduct discovery because Petitioner did not advise Registrant that it intended to serve discovery. Registrant states in its motion, “had Petitioner or its counsel advised Registrant that Petitioner intended to serve

discovery, Registrant would have prepared and served its own discovery requests.” (See page 8 of Registrant’s Motion). Nowhere in the rules for conducting discovery does a party have a positive obligation or duty to inform the other party that they do or do not intend to serve them with discovery requests. The rules simply require that any request must be served within the discovery period. At no time did Petitioner communicate to Registrant that it would not conduct discovery. Petitioner was in the same situation as Registrant. Neither party knew if the other would or would not conduct last minute discovery requests. The discovery period was about to end and settlement had not yet occurred. The fact that Petitioner, being similarly situated to Registrant, did in fact prepare and serve discovery at the last minute, shows that the decision to conduct or not conduct discovery was within both parties’ control. It was completely up to Petitioner to serve or not to serve discovery requests. It had nothing to do with whether or not Registrant had served discovery or threatened to serve discovery on Petitioner. Petitioner deliberately chose not to serve discovery requests even though it was the end of the six-month discovery period and settlement had not yet been reached.

4. A good faith belief that settlement was imminent should not excuse Registrant from meeting discovery deadlines. Petitioner does not assert that Registrant acted in bad faith by failing to conduct discovery during the six month discovery period. Petitioner simply asserts that Registrant exercised bad judgment in assuming that a case was going to settle while allowing the time for discovery to run out.

The discovery period should not be reopened.

Allowing discovery to reopen as requested will unreasonably extend the length of this proceeding by an additional three months. It will be prejudicial to the Petitioner as Petitioner did follow the rules, incurred significant time and expense, and served discovery requests prior to the end of the discovery period. Most importantly, reopening discovery will reward a party who deliberately chose not to initiate discovery during the generous six month discovery period, the six months having been chosen by the rule makers specifically to cut down on extension requests.

Registrant's decision to not conduct discovery was completely within Registrant's control. Therefore, Registrant's failure to serve discovery prior to the close of the discovery period was not the result of excusable neglect. Petitioner should not be made to suffer due to Registrant's poor judgment. Petitioner respectfully requests that the TTAB deny Registrant's motion to reopen discovery.

There is no need to have the testimony and trial periods reset if the discovery period is not reopened.

In the interest of resolving this matter as quickly as possible, if the discovery period is not reset, there is no reason to reset the testimony and trial periods. Registrant respectfully requests that the board does not extend the testimony and trial periods.

For the foregoing reasons, Petitioner respectfully requests that the TTAB deny Registrant's motion to reopen the discovery period and reset the testimony and trial periods in this proceeding.

Respectfully submitted,

Oppedahl Patent Law Firm, LLC

Dated: September 19, 2007

By: /Jessica L. Olson/

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EXHIBIT A

Cancellation No. 92047013
NeTrack, Inc. v. Internet FX, Inc.
Exhibit Offered by NeTrack, Inc.

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August 15, 2007

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Re: Cancellation proceeding No. 92/047013

Dear Conferes:

Enclosed please find three discovery requests in the pending cancellation proceeding.

Our review of the TTAB files did not yield any indication of the registrant being represented by counsel. Thus out of an abundance of caution we are addressing our service of these requests not only to the Manatt, Phelps & Phillips, LLP firm but also to the registrant directly. We welcome your guidance as to whether future service should likewise be addressed to both addresses.

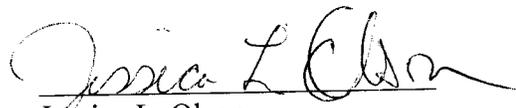
Sincerely,


Carl Oppedahl

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of Petitioner's Response to Motion to Reopen Discovery Period and Reset Testimony and Trial Periods was served this 19th day of September, 2007 by first class mail, upon the attorneys for Registrant:

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