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

wbc

Mailed: August 13, 2014

Cancellation No. 92048732

Altvater Gessler – J.A. Baczewski International (USA) Inc. and Altvater Gessler – J.A. Baczewski GmbH

v.

Ronald Beckenfeld

Wendy Boldt Cohen, Interlocutory Attorney:

This case now comes up before the Board on Respondent's motion to reopen discovery[1] (filed March 24, 2014) based on Petitioner's amended petition to cancel (first considered by the Board October 24, 2013 with another amended petition to cancel filed on January 9, 2014 pursuant to the Board's December 20, 2013 order). The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion, and

[1] Respondent notes that it sought a reopening of the discovery period in its responses to the Petitioner's ameded pleadings, each entitled "Respondent's Opposition to Petitioner's Motion for Leave to Amend the Petition for Cancellation." "In general, all motions should be filed separately, or at least be captioned separately, to ensure they receive attention." TBMP § 502.02. Inasmuch as Respondent embedded this language in its response to Petitioner's motion to amend its pleadings, captioned its filing only as a response and not a motion to reopen (indeed, Petitioner failed to address the factors related to reopening discovery), the language in those responses will not receive any further consideration.

does not recount the facts or arguments here, except as necessary to explain the decision.

As made applicable by Trademark Rule 2.116(a), the relevant provisions of Fed.R.Civ.P. 6(b) permit the Board in its discretion to reopen the discovery period where the failure to act is shown to be due to excusable neglect. *See* Fed. R. Civ. P. 6(b)(1)(B); TBMP § 509.01(b)(1). In *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership et al* ., 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," finding that "excusable neglect" under Rule 6(b) "is a somewhat 'elastic concept' and is not limited strictly to omissions caused by circumstances beyond the control of the movant." *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1157 (TTAB 1998) (*quoting Pioneer*, 507 U.S. at 392).[2]

Further, the Board may, in its discretion, reopen discovery to allow the adverse party to take discovery on the matters raised in an amended pleading. However, as noted in the Board's December 20, 2013 order, exercise of such

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[2] 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 Investment Services Co., 507 U.S. at 395.

discretion may not be necessary when the proposed additional claim or allegation concerns a subject on which the non-moving party can be expected to have relevant information in hand. TBMP § 507.02(a). "This is especially true when the factual basis for the motion to amend was obtained by the moving party through discovery taken from the non-moving party" as was the case with Petitioner's motion to amend. *Id*. As discussed in the Board's order, the claims sought to be added were, fraud and abandonment due to naked licensing[3] and amplifying the already pleaded claims that Respondent was not the rightful owner of the mark. The Board found that "petitioner's additional allegations of fraud, abandonment by naked licensing, and the additional allegations in its already-asserted claims regarding ownership involve information in respondent's control." *See Board's December 20, 2014 Order*, p. 5; *see also* TBMP § 507.02(a). Respondent does not dispute that these claims involve information within its control. Rather, Respondent argues that it needs to conduct discovery on these new claims but does so in a conclusory fashion stating that discovery is needed to avoid prejudice to Respondent. TBMP § 509.01(b)(1) ("A party moving to reopen its time to take required action must set forth with particularity the detailed facts upon which its excusable neglect claim is based; mere conclusory statements are insufficient."); *see also Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000) (no specific reasons for former counsel's inaction); *HKG*

[3] In its order, the Board found the claim of abandonment by naked licensing insufficiently pleaded and gave Petitioner time to replead that claim, which it did on January 9, 2014.

Industries Inc. v. Perma-Pipe Inc., 49 USPQ2d 1156, 1158 (TTAB 1998) (no factual details as to the date of counsel's death in relation to plaintiff's testimony period or as to why other lawyers in deceased counsel's firm could not have assumed responsibility for the case).

Specifically, Respondent requests the Board to reopen discovery to "fully and fairly investigate the allegations, claims and legal theories proffered by Petitioners in the Second Amended Petition." S*ee Motion to Reopen*, p. 7. In short, Respondent argues that it needs discovery with regard to Petitioner's newly pleaded claims but does not explain with particularity why it needs such discovery.

While under *Pioneer* Respondent may have acted in good faith, the lack of explanation as to the specific reason for seeking discovery on claims which the Board has already indicated relate to information already in Respondent's control, is significant. *See Gaylord Entertainment Co.*, 59 USPQ2d at 1373.

After careful consideration of the *Pioneer* factors and the relevant circumstances in this case, and in the exercise of the Board's discretion, inasmuch as Respondent fails to provide with particularity the facts upon which its excusable neglect claim is based, indeed, it has failed to address the Board's prior finding that additional discovery does not appear to be necessary, the motion to reopen discovery is **denied**.

Proceedings are resumed. The Board treats the filing of the motion to reopen as tolling the dates herein. Dates are reset as follows:

Plaintiff's 30-day Trial Period Ends	**9/5/2014**
Defendant's Pretrial Disclosures	**9/20/2014**
Defendant's 30-day Trial Period Ends	**11/4/2014**
Plaintiff's Rebuttal Disclosures	**11/19/2014**
Plaintiff's 15-day Rebuttal Period Ends	**12/19/2014**

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.l25. Briefs shall be filed in accordance with Trademark Rules 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.