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

Proceeding	92048732
Party	Defendant Ronald Beckenfeld
Correspondence Address	MICHAEL L LOVITZ BOWEN HAYES & KREISBERG 10350 SANTA MONICA BLVD, STE 350 LOS ANGELES, CA 90025 UNITED STATES trademarks@bowenhayes.com, trademarks@lovitziplaw.com
Submission	Motion to Reopen
Filer's Name	Michael L. Lovitz
Filer's e-mail	trademarks@bowenhayes.com
Signature	/michael l lovitz/
Date	03/24/2014
Attachments	Motion to Re-Open Discovery.pdf(446378 bytes)

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

ALTVATER GESSLER – J.A.	:	Cancellation 92048732
BACZEWSKI	:	
INTERNATIONAL (USA) INC. and	:	
ALTVATER GESSLER – J.A.	:	
BACZEWSKI GMBH,	:	
	:	
Petitioners,	:	Registration No.: 2,731,948
	:	
v.	:	
	:	
RONALD BECKENFELD,	:	
	:	
Respondent	:	Attorney Docket No. B1001-9001

RESPONDENT’S MOTION TO RE-OPEN DISCOVERY

Respondent, Ronald Beckenfeld, hereby moves to re-open the discovery period for not less than ninety (90) days after the Board rules on this Motion to permit Respondent the opportunity to properly and fully investigate the allegations contained in Petitioners’ First Amended Petition for Cancellation. Additional time for discovery was previously requested by Respondent in Respondent’s Opposition to Petitioners’ Motion for Leave to Amend the Petition for Cancellation, is required based on the introduction in the Amended Petition of new factual allegations supporting Petitioners’ requested in good faith, and would not prejudice Petitioners.

A. BACKGROUND

The instant proceeding was initiated on January 14, 2008. After a number of stipulations for extensions of time, discovery in the proceeding closed on February 3, 2013. Following the close of discovery, Respondent filed a Motion for Summary Judgment on March 18, 2013. Petitioners, in addition to responding to the Motion for Summary Judgment, sought to amend the Petition to Cancel on May 31, 2013; however, as the Motion for Summary Judgment was at that time pending,

and the Board suspended the proceedings on April 13, 2013, the Motion to Amend was not considered.

Following the Board's denial of the Motion for Summary Judgment, Petitioners re-filed their Motion to Amend on October 24, 2013. The original Petition for Cancellation contained twenty-two numbered paragraphs and a single cause of action, namely that Petitioners are the true owners of the MONOPOLOWA trademark. The Amended Petition for Cancellation contained fifty-four (54) additional paragraphs of allegations and delineated four (4) additional causes of action. See Declaration of Michael L. Lovitz ("Lovitz Dec."), attached hereto as Exhibit 1, at ¶3. Among the additional paragraphs were allegations pertaining to financial distress, assignments of trademark rights in the MONOPOLOWA mark between entities prior to the assignment to Mutual Wholesale Liquor ("Mutual"), and transference of ownership in at least one of the Petitioners to "a third party" who goes unnamed in the pleading. Lovitz Dec. at ¶¶4-5. None of these new allegations or causes of action had previously been referenced in either the original Petition to Cancel or in Petitioners' Initial Disclosures. Lovitz Dec. at ¶6.

Respondent objected to the Motion to Amend, on the grounds that it introduced new allegations for which the only persons who had direct knowledge had previously died, and so it would be impossible to obtain proof of (or against) certain of the allegations and statements of fact now being relied upon by the Petitioners in support of their claims, prejudicing Respondent. As an alternative to denial of the Motion to Amend, Respondent requested in the Conclusion section of its Opposition to the Motion that Respondent's discovery period be reopened to allow Respondent the opportunity to seek out relevant information with respect to the new allegations contained in the amended pleading. See Respondent's Opposition to Petitioners' Motion for Leave to Amend the Petition for Cancellation (Document #83) at page 7.

On December 20, 2013, the Board issued its ruling permitting the filing of the Amended Petition, although indicating that the claim of abandonment (as written in the First Amended Petition) failed adequately to state a claim of abandonment. However, the Board granted Petitioners twenty (20) days to file an amended pleading so as to properly state a claim of abandonment, which was done and filed by Petitioners on January 9, 2014. Respondent's Answer to the Second Amended Petition was filed on February 9, 2014. On February 24, 2014, the Board resumed proceedings in its order denying Petitioners' Motion to Compel.

Following the Board's ruling, counsel for both parties conferred via e-mail and telephone regarding Respondent's belief that additional discovery was necessary, given the additional allegations and causes of action contained in the Second Amended Petition. Specifically, Respondent seeks to conduct written discovery and/or depositions pertaining to the allegations regarding, *inter alia* (i) Petitioners' claims of financial difficulties faced by Eduard Gessler and Petitioner Altvater Gessler – J.A. Baczewski International GmbH ("AGJAB-Austria"), (ii) Petitioners' claims that AGJAB-Austria did not own the MONOPOLOWA mark when it was assigned to Mutual in 1992, (iii) that Elek Gessler assigned all of his rights in Petitioner Altvater Gessler – J.A. Baczewski International (USA) Inc. ("AGJAB-USA") to a third party in 1991, (iv) that the 1992 assignment was instead an "executory transfer...to be effective only in the event of bankruptcy" and (v) that Mutual could take no rights to the MONOPOLOWA mark from the 1992 assignment and confirmation documents, and requested Petitioners consent to re-opening discovery to permit the same. However, the parties have been unable to reach a mutually satisfactory agreement that could have avoided the filing of the instant motion. Lovitz Dec. at ¶¶8-11.

Because the foregoing allegations and causes of action were not part of, nor referenced in, the original Petition to Cancel, nor identified within Petitioners' Initial Disclosures, it was not possible for Respondent to have included the same in its discovery efforts. Lovitz Dec. at ¶7.

Petitioners have now made it known that they intend to introduce into evidence during their testimony period the testimony of Leonie Gessler concerning, *inter alia*, “the activities and finances of her late husband Elek Gessler”. Lovitz Dec. at ¶12. Not permitting the discovery period to be reopened will prejudice Respondent because he will be denied the opportunity to fully investigate the allegations and claims first raised by Petitioners in the Second Amended Petition, particularly where Petitioners have disclosed their intention to rely on the same, and will be unable to fully and fairly prepare for cross-examination of all of Petitioners’ upcoming testimony witnesses. Lovitz Dec. at ¶13-14.

B. LEGAL STANDARD

The standard for allowing an enlargement of a time period is set out in Fed. R. Civ. P. 6(b), made applicable to Board proceedings by Trademark Rule 2.116(a), and TBMP §509. When a motion for enlargement of time is made after the time (whether as originally set or previously extended) has expired, the moving party must show that its failure to act during the time allowed therefor was the result of excusable neglect. See Fed. R. Civ. P. 6(b)(1). Prior to the filing of the Second Amended Petition, the need for additional discovery did not arise; rather, it was the granting of Petitioners’ motion to amend, and the new allegations and causes of action contained in the Second Amended Petition, that resulted in Respondent’s need for conducting additional discovery. Further, Respondent requested in its filings in opposition to the motion to amend that discovery be reopened. As a result, Respondent submits that any failure to act prior to the close of discovery was due to excusable neglect.

C. ARGUMENT

The Board may, in its discretion, permit a party to reopen an expired time period where the failure to act is due to excusable neglect. See Fed. R. Civ. P. 6(b). Rule 6(b)(1) provides in relevant part as follows:

(1) In General. When an act may or must be done within a specified time, the court may, for good cause, extend the time:

...
(B) on motion made after the time has expired if the party failed to act because of excusable neglect.

In examining what constituted neglect that was “excusable”, the Supreme Court in *Pioneer Invest. Svcs. Co. v. Brunswick Assoc. Ltd. P’shp*, 507 U.S. 380 (1993) held that excusable neglect under Rule 6(b) was a somewhat elastic concept, and could be determined by considering all of the relevant circumstances surrounding the party’s omission, including (1) the danger of prejudice to the non-moving party, (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 moving party, and (4) whether the moving party had acted in good faith. *Pioneer Invest. v. Brunswick*, 507 U.S. at 395. See also *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997) and cases cited therein. Several of the Circuit Courts of Appeal have stated that the third factor may be considered the most important factor in a particular case. See *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d at 1586 at fn. 7; *Baron Philippe de Rothschild, S.A. and Societe Civile de Chateau Lafite-Rothschild v. Styl-Rite Optical Mfg. Co.*, 55 U.S.P.Q.2d 1848 (TTAB 2000).

In examining the four enumerated *Pioneer* factors in the instant case, Respondent submits that the any delay would be an excusable one under the circumstances. First, there is no danger of prejudice to the Petitioners, as their testimony period has not yet begun. Additionally, it was the filing by Petitioners in submitting the Second Amended Petition that resulted in the need for additional discovery in this proceeding. Respondent therefore submits that the first *Pioneer* factor favors Respondent.

Regarding the length of delay, proceedings had been suspended pending the Board’s consideration of Petitioners’ Motion to Amend and Motion to Compel, and were only resumed on February 24, 2014, less than thirty days ago. In addition, Respondent had requested in its

opposition to the Motion to Amend that discovery be reopened in the event such motion was granted. Further, it was only on March 23, 2014 that Petitioners disclosed their intention to rely on testimony concerning the newly-added allegations during its testimony period. Respondent therefore submits there has been no lengthy delay, and in fact Respondent has acted swiftly, and that the second factor also favors Respondent in the instant motion. See, e.g., *Champagne Louis Roederer v. J. Garcia Carrion, S.A.*, 2004 TTAB Lexis 235 (TTAB 2004 – Opposition No. 91155105).

As to the reason for the delay, the third *Pioneer* factor, Respondent states that any delay was entirely due to circumstances outside of Respondent's control. The need to re-open discovery was not a result of any act or omission by Respondent. Rather, it was the result of the filing by Petitioners of the Second Amended Petition, containing fifty-four additional new allegations and four new causes of action, and the disclosure that Petitioners intend to rely upon the same during their testimony period. Petitioners' inclusion of new facts, allegations and legal theories, and their intention to rely upon the same in their testimony, has triggered the need for discovery to be re-opened so as to avoid prejudicing Respondent. Because the filing by Petitioners of the Second Amended Petition, as well as that filing's contents, were completely beyond the control of Respondent, the third *Pioneer* factor strongly favors Petitioner.

Finally, Respondent believes it has acted in good faith, seeking only to avoid being prejudiced by the allegations and legal theories promoted in the Second Amended Petition which was filed after the close of discovery. Additionally, Respondent explored with Petitioners whether a compromise could be reached that could avoid the need for filing the instant motion, and made a good-faith effort to resolve with Petitioners the issues presented in this motion; only after a stalemate had been reached has this motion been filed. Respondent therefore submits that the fourth *Pioneer* factor also favors Respondent in the instant motion.

D. CONCLUSION

For the foregoing reasons, Respondent respectfully requests that the Board grant the instant motion to re-open discovery for Respondent for not less than ninety days after the Board rules on this motion in order to permit Respondent to fully and fairly investigate the allegations, claims and legal theories proffered by Petitioners in the Second Amended Petition. Respondent further respectfully requests that the Board suspend this proceeding pending resolution of this motion pursuant to TBMP 523.01; 37 C.F.R. §2.120(e)(2).

Respectfully submitted,

Dated: March 23, 2014

By:


Michael L. Lovitz
BOWEN HAYES & KREISBERG
10350 Santa Monica Blvd., Ste. 350
Los Angeles, CA 90025
(310) 893-0422

Attorneys for Respondent

EXHIBIT 1

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

ALTVATER GESSLER – J.A. BACZEWSKI	:	Cancellation 92048732
INTERNATIONAL (USA) INC. and ALTVATER	:	
GESSLER – J.A. BACZEWSKI GMBH,	:	
	:	
Petitioners,	:	Registration No.: 2,731,948
	:	
v.	:	
	:	
RONALD BECKENFELD,	:	
	:	
Respondent	:	Attorney Docket No. B1001-9001

DECLARATION OF MICHAEL L. LOVITZ

I, Michael L. Lovitz, hereby state as follows:

1. This declaration is made in support of Respondent’s Motion to Re-Open Discovery in the above-captioned matter.

2. I am a partner in the law firm of Bowen Hayes & Kreisberg, legal counsel to Respondent. I have represented Respondent in this matter since February 2008.

3. Petitioners’ Second Amended Petition for Cancellation (the “Second Amended Petition”) substantially expanded upon the original Petition for Cancellation, raising the number of paragraphs of allegations from twenty-two (22) up to seventy-six (76), and raising the number of causes of action from one (1) up to five (5).

4. Primary among the additions contained in the Second Amended Petition were allegations pertaining to: (a) the financial distresses faced by Petitioner Altvater Gessler – J.A. Baczewski International GmbH (“AGJAB-Austria”), and by Eduard Gessler, Elek Gessler; (b) the transfer of ownership in 1983 of all right, title and interest in and to the trademark MONOPOLOWA from AGJAB-Austria to Altvater Gessler – J.A. Baczewski International (USA) Inc. (“AGJAB-USA”); and (c) steps taken by Elek Gessler as a means to mitigate losses in the event

it were necessary to file for personal bankruptcy, including claims that Elek Gessler sought to defraud creditors by signing an executory transfer of the MONOPOLOWA brand name to Mutual Wholesale Liquor (“Mutual”) “only in the event of bankruptcy”.

5. The Second Amended Petition included claims that Elek Gessler transferred all ownership of Petitioner Altvater Gessler – J.A. Baczewski International (USA) Inc. (AGJAB-USA) in 1991 to an unnamed “third party,” implying Elek Gessler had no authority to bind AGJAB-USA or transfer any assets AGJAB-USA may have owned when assigning the MONOPOLOWA trademark to Mutual in 1992.

6. Neither the original Petition to Cancel nor Petitioners’ Initial Disclosures referenced the activities or finances of Elek Gessler, or gave any indication as to how such activities or finances might impact on the question of ownership of the MONOPOLOWA trademark, or the assignment of such trademark to Mutual Wholesale Liquor in 1992.

7. As a result, none of the discovery conducted by Respondent had been directed to such information, issues or questions, even though Petitioners have now disclosed their intention to rely upon testimonial and/or documentary evidence concerning the same.

8. Shortly after filing Respondent’s Answer to the Second Amended Petition, I contacted Peter Sloane, counsel for Petitioners, and advised him of Respondent’s belief that additional discovery directed to the new allegations and claims contained in the Second Amended Petition was warranted, and inquired whether Petitioners continued to object to the same. Attached as **Exhibit A** is an e-mail from myself to Mr. Sloane dated February 21, 2014 addressing this request.

9. Mr. Sloane responded by e-mail on February 27, 2014 that he would confer with his client regarding Respondent’s request for additional discovery. Attached as **Exhibit B** is Mr. Sloane’s February 27, 2014 e-mail response.

10. During subsequent telephone conversations, Mr. Sloane and I discussed further Respondent's request for additional discovery, including the scope and nature of the discovery sought (i.e., written and testimonial), but were not able to reach an agreement as to scope of discovery Petitioners were willing to provide without need for re-opening the discovery period. Among the issues that could not be resolved was Petitioner's request to depose Leonie Gessler.

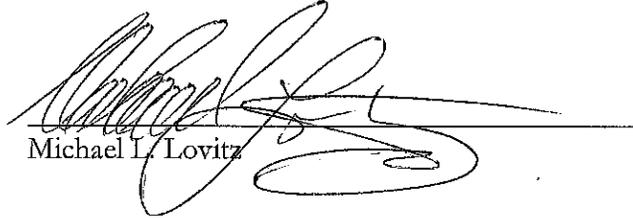
11. Specifically, Mr. Sloane advised me that Petitioners would not agree to permit the deposition of Mrs. Gessler she was identified in Petitioners' Initial Disclosures as a person with knowledge, and so Petitioners had the ability to depose her prior to the close of discovery in 2013. As noted above, however, neither the original Petition for Cancellation nor the Initial Disclosures identified the factual issues surrounding the alleged financial difficulties, the pre-1990 transfers of ownership of the MONOPOLOWA trademark or the alleged 1991 transfer of ownership of Petitioner AGJAB-USA to "a third party".

12. Additionally, Petitioners' Pretrial Disclosures, filed March 23, 2014, identify Petitioners' intention to introduce into evidence during the testimony period, *inter alia*, testimony by Leonie Gessler "on the activities and finances of her late husband Elek Gessler", facts and issues first raised in the Second Amended Petition to Cancel.

13. On information and belief, Petitioners' refusal to permit Respondent to re-open discovery as requested denies Respondent the opportunity to fully and fairly prepare for Petitioners' upcoming testimony.

14. On information and belief, unless discovery is re-opened, Respondent will be prejudiced because he will have no opportunity to fully investigate the allegations and claims raised by Petitioners in the Second Amended Petition, allegations and claims that Petitioners have already disclosed they intend to rely upon, because Petitioners waited until after the close of discovery to file its request to amend its initial pleading.

The undersigned, being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, declares under penalty of perjury that all statements herein made of my own knowledge are true, and that all statements herein made on information and belief are believed to be true to the best of my knowledge.



Michael L. Lovitz

EXHIBIT A

Michael Lovitz <michael@bowenhayes.com>

February 21, 2014 6:39 PM

To: Peter S. Sloane, Esq.

Altwater Gessler - J.A. Baczewski International (USA) Inc. and Altwater Gessler - J.A. Baczewski GmbH v. Ronald Beckenfeld (Cancellation No. 92048732) (Your Ref.: 4719/606020-000)

Dear Peter -

This has reference to the above-noted TTAB proceeding.

In your Reply to Respondent's Opposition to Petitioner's Motion for Leave to Amend the Petition for Cancellation, you indicated your objection to the reopening of the discovery period so that we may properly investigate the factual allegations contained in the Amended Petition concerning the ownership in 1992 of the MONOPOLOWA trademark as between the various AGJAB entities, including many of the allegations in Paragraphs 7-19. As these claims of transfers between these entities, as well the alleged assignment by Elek Gessler of "all his shares in AGJAB-USA to a third party" (which party is never identified), were not part of the original Petition, we believe further discovery is warranted.

Please advise if you intend to maintain this objection, requiring that we file a motion to reopen discovery, or whether you foresee any circumstances under which Petitioners would consent to further discovery directed to such allegations.

Best regards.

-michael

Michael L. Lovitz, Esq.

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EXHIBIT B

Peter S. Sloane <Sloane@leasonellis.com>

February 27, 2014 12:48 PM

To: Michael Lovitz <michael@bowenhayes.com>

RE: Altvater Gessler - J.A. Baczewski International (USA) Inc. and Altvater Gessler - J.A. Baczewski GmbH v. Ronald Beckenfeld (Cancellation No. 92048732) (Your Ref.: 4719/606020-000)

Hi Michael:

I was away from the office next week. I will confer with my client.

I note that the Board denied our motion to compel, but has given us the opportunity to modify our requests for production. Please let me know whether Ron is willing to produce any of the responsive documents to avoid need for modification.

Best regards,

Peter S. Sloane

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From: Michael Lovitz [mailto:michael@bowenhayes.com]

Sent: Friday, February 21, 2014 9:40 PM

To: Peter S. Sloane

Subject: Altvater Gessler - J.A. Baczewski International (USA) Inc. and Altvater Gessler - J.A. Baczewski GmbH v. Ronald Beckenfeld (Cancellation No. 92048732) (Your Ref.: 4719/606020-000)

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Please advise if you intend to maintain this objection, requiring that we file a motion to reopen discovery, or whether you foresee any circumstances under which Petitioners would consent to further discovery directed to such allegations.

Best regards.

-michael

Michael L. Lovitz, Esq.

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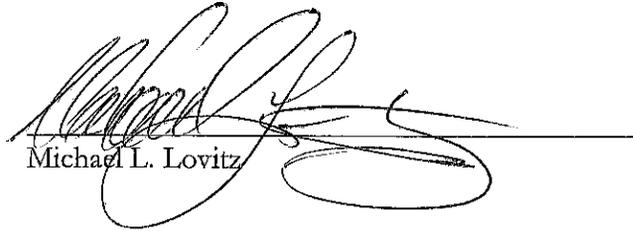
E-Mail: michael@bowenhayes.com

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CERTIFICATE OF SERVICE

I, Michael L. Lovitz, hereby certify on this 23rd day of March, 2014, that a true and correct copy of RESPONDENT'S MOTION TO RE-OPEN DISCOVERY was served upon Petitioners' correspondent of record by First Class Mail, postage prepaid at the following address:

Peter S. Sloane
Leason Ellis LLP
One Barker Avenue, Fifth Floor
White Plains, NY 10601



Michael L. Lovitz