

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

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Mailed: February 25, 2011

Cancellation No. 92052234 (parent)  
92052251

Bose Corporation

v.

jWin Electronics Corp.

**Yong Oh (Richard) Kim, Interlocutory Attorney:**

On February 17, 2011, the Board held a telephone conference to hear argument and rule on respondent's motion (filed February 1, 2011) to reopen discovery. Cynthia Johnson Walden, Esq., appeared as counsel for petitioner and Hyunjung Kim, Esq., appeared as counsel for respondent.

As background, this proceeding was consolidated with Cancellation No. 92052251 on August 23, 2010, and dates in the consolidated proceeding were set in accordance with the schedule in the child case. Per the schedule, discovery closed on November 30, 2010. On February 1, 2011, respondent filed a motion to reopen discovery and petitioner filed its opposition to the motion on February 3, 2011.

To begin the conference, the Board afforded each party an opportunity to present their respective arguments concerning the motion to reopen. Respondent's counsel argued that prior to the close of discovery, the parties were engaged in settlement discussions and that it was respondent's belief that the parties would likely reach an agreement before the close of discovery. Based on its belief in the likelihood of settlement, respondent asserts that the parties agreed to refrain from conducting any additional discovery during their negotiations. Respondent also adds that its failure to propound discovery requests on petitioner was inadvertent and due to "the press of a heavy caseload and other matters that needed immediate attention," which "other matters" respondent failed to elaborate either in its motion or during the oral hearing.

In response, petitioner argues that no such agreement to refrain from conducting further discovery was in place and that, in any event, respondent's motion to reopen fails to demonstrate the "excusable neglect" required to reopen discovery.

Under Fed. R. Civ. P. 6(b)(1)(B), in order to reopen its now-expired time for taking discovery, respondent must establish that its failure to take such discovery was due to "excusable neglect." See *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1852 (TTAB

Cancellation No. 92052234 (parent) and 92052251

2000) ("Pursuant to Fed. R. Civ. P. 6(b)[(1)(B)], the requisite showing for reopening an expired period is that of excusable neglect."). As the Board stated in *Baron Philippe*:

In *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380, 395 (1993), the Supreme Court set forth four factors to be considered in determining excusable neglect. Those factors are: (1) the danger of prejudice to the non-moving party; (2) the length of 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 has acted in good faith. In subsequent applications of this test by the Circuit Courts of Appeal, several courts 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 1582, 1586 at fn. 7 (TTAB 1997).

*Id.*, at 1852.

In looking first at the third factor, all of the reasons provided by respondent for its delay were entirely within its reasonable control. Regardless of whether respondent believed that settlement was imminent and/or the parties agreed to refrain from conducting further discovery, there was nothing to prevent respondent from, at the very least, preserving its right to take discovery by filing, prior to the expiration of the discovery period, a motion to suspend proceedings for purposes of settlement or to extend

Cancellation No. 92052234 (parent) and 92052251

its time to take discovery. The mere existence of settlement negotiations does not justify respondent's inaction or delay. See *Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858 (TTAB 1998). Indeed, in view of the parties' failure to reach a settlement prior to the expiration of the discovery period, petitioner preserved its rights to discovery by propounding its discovery requests prior to the expiration of said period. Additionally, the press of a heavy caseload is a circumstance that is wholly within counsel's control. See *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d at 1851; see, also, *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL*, 59 USPQ2d 1383, 1383-84 (TTAB 2001) (press of other litigation insufficient to make showing of excusable neglect). As respondent does not contend that it was unaware of the discovery deadline or was in any way prevented from taking action, the third factor weighs heavily against a finding of excusable neglect.

As to the remaining factors, there is nothing to suggest that respondent's failure to take timely action resulted in prejudice to petitioner's ability to litigate the case. Petitioner has not made any showing, let alone made any arguments, of lost evidence or unavailable witnesses. Therefore, this factor weighs slightly in favor

Cancellation No. 92052234 (parent) and 92052251

of respondent. As to the length of the delay, respondent's motion was made approximately two months after the close of discovery with no explanation as to why it waited two months after it was served with discovery to focus on its own discovery needs. Thus, this factor does not favor respondent. Finally, as there is no indication in the record whether respondent acted in bad faith or in good faith, this factor is neutral.

Weighing all of the factors together, the Board finds that respondent has failed to make a showing of excusable neglect. Therefore, respondent's motion to reopen discovery is hereby **DENIED**.

Shortly after this teleconference, respondent filed (on February 18, 2011) a response to petitioner's pending motion to compel discovery asserting that it is "in the process of finalizing the engagement of outside trademark counsel to assist in responding to these discovery requests and in defense of this cancellation proceeding" and agreeing "to provide responses to Plaintiff's outstanding discovery requests." In view thereof, petitioner's motion to compel discovery is **MOOT** and will be given no further consideration. Respondent's discovery responses are due by **March 20, 2011**. Upon retention of new counsel, the Board should be notified. Proceedings are otherwise **SUSPENDED** and

Cancellation No. 92052234 (parent) and 92052251

remaining dates are reset in accordance with the following schedule:

Respondent's Discovery Responses Due	3/20/2011
Proceedings Resume	3/21/2011
Plaintiff's 30-day Trial Period Ends	4/29/2011
Defendant's Pretrial Disclosures Due	5/14/2011
Defendant's 30-day Trial Period Ends	6/28/2011
Plaintiff's Rebuttal Disclosures Due	7/13/2011
Plaintiff's 15-day Rebuttal Period Ends	8/12/2011

**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.

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