

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

Baxley

Mailed: June 27, 2013

Cancellation No. 92053298

Tyler Perry Studios, LLC

v.

Kimberly Kearney

Andrew P. Baxley, Interlocutory Attorney:

In this proceeding, Tyler Perry Studios, LLC ("petitioner") seeks to cancel Kimberly Kearney's ("respondent") registration for the mark WHAT WOULD JESUS DO in standard character form for "[e]ntertainment services in the nature of an on-going reality based television program" in International Class 41 on the ground of abandonment.¹

Pursuant to the Board's February 24, 2012 order, petitioner's testimony period closed on January 8, 2013. On January 7, 2013, petitioner filed a notice of reliance which includes a copy the requests for admission that it served on respondent by Federal Express on October 10, 2012 (the closing date of the discovery period), to which respondent did not respond. Petitioner indicated in the notice of

¹ Registration No. 3748123, issued February 16, 2010, and alleging November 21, 2007 as the date of first use anywhere and date of first use in commerce.

reliance that it intends to rely upon respondent's admissions in support of its claim in this case.

The following motions are pending before the Board:

(1) respondent's motion (filed January 29, 2013) to reopen her time to respond to petitioner's requests for admission; and (2) petitioner's motion (filed February 15, 2013) to strike respondent's late responses to petitioner's requests for admission, which were filed concurrently with her motion to reopen.

The Board will first consider respondent's motion to reopen time to respond to requests for admissions. In support of that motion, respondent contends that she mistakenly believed that her responses to petitioner's requests for admission were due between January 23, 2013, the due date for her pretrial disclosures, and March 9, 2013, the closing date of her testimony period; that, although she is not represented by an attorney, she is doing her best to follow the applicable rules: and that she does not "want to lose this case, over mistakes that can be avoided like simple deadlines."

In response, petitioner contends that respondent's motion should be denied as untimely and prejudicial; and that because she has consistently represented in her submissions that she was being advised by a "legal team," respondent should have understood the consequences of

failing to respond to the requests for admission. Accordingly, petitioner asks that the Board deny respondent's motion.

Because petitioner served its discovery requests, including requests for admission, by Federal Express on October 10, 2012, respondent's responses thereto were due by November 24, 2012. See Trademark Rules 2.119(c) and 2.120(a)(3). Those requests for admission stand admitted based on respondent's failure to serve timely responses thereto. See Fed. R. Civ. P. 36(a)(3).

To overcome admissions resulting from a failure to timely respond to requests for admissions, a responding party may either move to: (1) reopen its time to serve responses to the outstanding admission requests based on a showing of excusable neglect under Fed. R. Civ. P. 6(b)(1)(B); or (2) withdraw and amend its admissions pursuant to Fed. R. Civ. P. 36(b) based on both the responding party's showing that the presentation of the merits of the proceeding will be subserved by amending the admissions and the propounding party's failure to show that withdrawal or amendment will prejudice said party in maintaining its action or defense on the merits. The timing of a motion to withdraw or amend admissions plays a significant role in the Board's determination of whether

the propounding party will be prejudiced by withdrawal or amendment. See TBMP Section 525.

For the Board to reopen respondent's time in which to serve responses to petitioner's requests for admission, respondent must establish that her failure to timely respond thereto was the result of excusable neglect. See Fed. R. Civ. P. 6(b)(1)(B); TBMP Section 509.01(b). In *Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 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," as used in the Federal Rules of Civil Procedure and elsewhere. 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. v. Brunswick Associates L.P., 507 U.S. at 395. In subsequent applications of this test, several courts have stated that the third *Pioneer* factor, namely the reason for the delay and whether it was within the reasonable control of the movant, might be considered the most important factor in a particular case.

See Pumpkin, Ltd. v. The Seed Corps, 43 USPQ2d at 1586, fn. 7 and cases cited therein.

Turning initially to the third *Pioneer* factor, the Board finds that respondent's failure to timely respond to petitioner's requests for admission was caused by her inattention to the applicable procedural rules, which was within her control.² In the February 24, 2012 order, respondent was advised that "[t]he Board expects all parties appearing before it, whether or not they are represented by counsel, to comply with the Trademark Rules of Practice and[,] where applicable, the Federal Rules of Civil Procedure." February 24, 2012 order at 2, fn. 1. The Board is justified in enforcing procedural deadlines. See *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 1554, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860 (TTAB 2002). In addition, the Board, in that order, provided respondent with links to websites that contain the Trademark Board Manual of Procedure (TBMP), the Trademark Rules of Practice, and the Federal Rules of Civil Procedure. See February 24, 2012 order at 2, fn. 1. See also the Board notice instituting this proceeding. Information regarding the due date for

² Respondent does not explain why she thought that her responses to petitioner's requests for admission were not due until the time between the due date for her pretrial disclosures and the closing date of her testimony period, i.e., after the close of petitioner's time in which to present its case-in-chief at trial.

responses to discovery requests is readily available in the TBMP and the Trademark Rules of Practice. See Trademark Rules 2.119(c) and 2.120(a)(3); TBMP Sections 403.03 and 407.03. Accordingly, this factor weighs against a showing of excusable neglect.

Regarding the first *Pioneer* factor, the Board finds that petitioner would be prejudiced by reopening respondent's time in which to respond to the requests for admissions. Petitioner's requests for admissions stood effectively admitted at the time trial commenced, and petitioner relied upon respondent's admissions as its evidence in its case-in-chief. To allow respondent to amend those admissions after the close of petitioner's testimony period would substantially prejudice petitioner in this case because it would fully change during trial the evidence upon which petitioner is relying in this case. Accordingly, this factor weighs against a showing of excusable neglect.

Regarding the second *Pioneer* factor, the Board finds that the delay caused by respondent's motion and the impact of that delay upon this proceeding is significant. Respondent did not seek relief from her effective admissions until two months after the expiration of time to respond to petitioner's discovery requests and until after petitioner relied upon those admissions as evidence during its testimony period. Further, if the Board were to reopen

respondent's time to respond to petitioner's requests for admission and accept respondent's concurrently filed responses to those requests, the Board would need, as a means of eliminating prejudice to petitioner and as a matter of fairness, to reopen petitioner's testimony period so that petitioner could revise its case-in-chief in light of those responses. Cf. *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (possible prejudice avoided by extending discovery period). Reopening petitioner's testimony period would delay resolution of this case by several months, and such delay would otherwise disrupt the orderly administration of this case from a docket management standpoint.³ See *Atlanta-Fulton County Zoo Inc. v. DePalma*, 45 USPQ2d 1858 (TTAB 1998). Accordingly, this factor weighs against a showing of excusable neglect.

Regarding the fourth *Pioneer* factor, the Board finds that there is no evidence that respondent filed her motion in bad faith.⁴ However, the Board finds that, on balance,

³ A motion for relief from the effective admissions should have been filed prior to petitioner's testimony period on December 10, 2012. See *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (motion to withdraw admissions granted when propounding party's testimony period had not yet opened); and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989) (motion to withdraw admissions granted when case was still in pretrial stage).

⁴ The Board notes, however, that, although respondent states in her motion to reopen that she is not represented by an attorney,

respondent has failed to show that her failure to timely respond to petitioner's requests for admission was the result of excusable neglect.

To the extent that respondent's motion to reopen is intended as one to withdraw and amend her admissions under Fed. R. Civ. P. 36(b), the Board notes that, even assuming that the presentation of the merits of this case will be subserved by allowing respondent to amend her admissions, the Board has determined earlier in this order that petitioner would be prejudiced by so allowing at this stage of the proceeding. See *supra*.

Based on the foregoing, respondent's motion to reopen her time to respond to requests for admission and/or to withdraw and amend her admissions is denied. Petitioner's requests for admissions remain admitted.

In view of the foregoing, respondent's belated responses to petitioner's requests for admissions are not part of the evidentiary record of this proceeding.⁵ Accordingly, petitioner's motion to strike those responses will receive no consideration.

the record in this case indicates that respondent has consulted an attorney at various points in this case. In her February 13, 2012 motion to extend time to answer, respondent refers to her "legal team." In a May 15, 2012 communication, respondent refers to "a discussion between [the parties'] attorneys."

⁵ Once submitted, the Board does not remove documents from the proceeding file.

Cancellation No. 92053298

Proceedings herein are resumed. Remaining dates are reset as follows.

Defendant's Pretrial Disclosures Due	7/6/2013
Defendant's 30-day Trial Period Ends	8/20/2013
Plaintiff's Rebuttal Disclosures Due	9/4/2013
Plaintiff's 15-day Rebuttal Period Ends	10/4/2013

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.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.