

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

Mailed: September 11, 2012

Cancellation No. 92054980

Andoni, Inc.

v.

Paisanos Pasta, LLC

Andrew P. Baxley, Interlocutory Attorney:

Under the schedule in the Board notice instituting this proceeding the discovery period was set to close on September 4, 2012. On September 4, 2012, petitioner filed a motion to extend the discovery period. Respondent has filed a brief in response thereto. On September 6, 2012, respondent filed a motion to compel responses to its first set of interrogatories and first set of document requests. In the interest of moving the case forward without undue delay, the Board attorney assigned to this case convened a telephone conference with the parties' attorneys on September 10, 2012 to discuss the pending motions. See Trademark Rule 2.120(i)(1); TBMP Section 502.06(a) (3d ed. rev. 2012).

The standard for allowing an extension of a prescribed period prior to the expiration of that period is "good cause." See Fed. R. Civ. P. 6(b); TBMP Section 509 (3d ed.

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rev. 2012). The Board is generally liberal in granting extensions before the period to act has lapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. See, e.g., *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313 (TTAB 1992).

Although petitioner bases its motion to extend on the parties' recent exchanges of settlement proposals, motions for extensions and/or suspensions for settlement negotiations are generally filed by agreement of the parties, with suspensions for settlement negotiations being subject to either party's right to request resumption at any time. See TBMP Section 510.03(b). Respondent opposes the extension sought.

Nonetheless, the record herein indicates that the parties agreed to extend the due date for respondent's responses to the discovery requests that petitioner served on July 13, 2012 to September 10, 2012, i.e., after the close of the discovery period under the schedule set forth in the institution notice.¹ Thus, under that schedule, petitioner would be precluded from taking follow-up discovery, notwithstanding that it served its discovery requests nearly two months prior to the close of the

¹ Respondent's attorney indicated that it expected to serve its discovery responses later that day.

discovery period. Had respondent served discovery responses in compliance with Trademark Rules 2.119(c) and 2.120(a)(3), petitioner would have time in which to take follow-up discovery prior to the close of the discovery period.² See TBMP Section 403.04. The Board notes in addition that petitioner's motion is the first motion to extend that either party has filed in this proceeding. Bearing in mind the Board's liberal practice with regard to granting extensions, the Board finds that there is good cause for the extension sought. Accordingly, the motion to extend is granted to the extent modified by this order. The discovery period is reset to close for petitioner on **October 4, 2012** in accordance with its motion to extend.³ Remaining dates are reset at the conclusion of this order.

To the extent that respondent seeks entry of sanctions under Trademark Rule 2.120(g)(1), no order compelling discovery has been issued herein. See TBMP Section 527.01(a). To the extent that respondent seeks entry of sanctions under Trademark Rule 2.120(g)(2), the record herein indicates that petitioner has not stated that "no

² An extension of time to serve discovery responses does not automatically extend the close of the discovery period. See Trademark Rule 2.120(a)(3).

³ Petitioner should not have included specific dates in its unconsented motion. The better practice is to request an extension of a specified duration to run from the date of the Board's decision on the motion to extend. See TBMP Section 509.02.

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response will be made" to respondent's discovery requests. See TBMP Section 527.01(b). Rather, petitioner has indicated that it will respond to discovery requests if the parties' settlement negotiations are unsuccessful. Accordingly, the motion for sanctions will receive no consideration.

Turning to the motion to compel, the Board finds that respondent made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. See Trademark Rule 2.120(e)(1).

As noted *supra*, suspensions for settlement negotiations are subject to either party's right to request resumption at any time. See TBMP Section 510.03(b). Further, "the mere existence of settlement negotiations alone does not justify a party's inaction or delay." *Atlanta-Fulton County Zoo Inc. v. DePalma*, 45 USPQ2d 1858, 1859 (TTAB 1998). The record herein indicates that the parties have not agreed to suspend or defer discovery while negotiating to settle this case. Accordingly, notwithstanding petitioner's August 22, 2012 settlement offer and the parties' subsequent discussions, petitioner should have served its responses to respondent's discovery requests by August 24, 2012, as the parties previously agreed.⁴ However, the Board, in its

⁴ Petitioner brought this proceeding and in doing so took responsibility for moving the case forward under the operative

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discretion, finds that requiring petitioner to serve discovery responses without objection is unwarranted under the circumstances herein.⁵ See *No Fear Inc. v. Rule*, 54 USPQ2d 1551 (TTAB 2000); TBMP Section 403.03.

Based on the foregoing, respondent's motion to compel is granted to the extent that petitioner is allowed until **thirty days** from the mailing date set forth in this order to: (1) serve responses to respondent's first sets of interrogatories and document requests; (2) select, designate and identify the items and documents, or categories of items and documents, to be produced in response to respondent's document requests; and (3) notify respondent that the selection, designation and identification of such items and documents has been completed.⁶ Respondent is allowed until thirty days from receipt of notification from petitioner that the items or documents have been selected, designated and identified to inspect and copy the produced materials,

schedule. *Atlanta-Fulton County Zoo Inc. v. DePalma*, *supra* at 1860.

⁵ See TBMP Section 414 regarding the discoverability of various types of information in Board proceedings.

Petitioner is reminded that, as the plaintiff herein, it has the burden of proof and that it may be precluded from relying at trial upon documents and information that was properly sought but not produced during discovery. See Fed. R. Civ. P. 37(c)(1).

⁶ If the materials are voluminous, defendant may produce a representative sampling and so inform plaintiff that a representative sampling has been produced.

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as provided for in Fed. R. Civ. P. 34(b) and Trademark Rule 2.120(d)(2), unless the parties otherwise agree.⁷

A review of the pleadings herein indicates that the parties' marks both include forms of the word PAISANO and are used in connection with overlapping services. The parties are directed to review the Board's website regarding accelerated case resolution (ACR) at

<http://www.uspto.gov/web/offices/com/sol/notices/acrognoticerule.pdf>.

If the parties do not settle this case and agree to pursue ACR, they should notify the above-signed interlocutory attorney by not later than the closing date of the discovery period for respondent.

To the extent that respondent asks that discovery be extended further for itself only, the Board finds that the requested further extension is warranted. See TBMP Section 403.04. Accordingly, remaining dates herein are reset as follows.⁸

Expert Disclosures for Respondent Due	10/4/2012
Discovery Closes for Respondent	11/3/2012
Plaintiff's Pretrial Disclosures Due	12/18/2012
Plaintiff's 30-day Trial Period Ends	2/1/2013
Defendant's Pretrial Disclosures Due	2/16/2013
Defendant's 30-day Trial Period Ends	4/2/2013
Plaintiff's Rebuttal Disclosures Due	4/17/2013
Plaintiff's 15-day Rebuttal Period Ends	5/17/2013

⁷ If petitioner fails to comply with this order, respondent's remedy is to file a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1).

⁸ As noted *supra*, petitioner's discovery period will close on October 4, 2012.

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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.