

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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General Contact Number: 571-272-8500

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Mailed: September 2, 2014

Cancellation No. 92055094

Swig, Inc.

v.

Temperance Distilling Company, Inc.

Elizabeth A. Dunn, Attorney:

This case comes up on Petitioner's motion to extend its testimony period, which is contested.¹ The motion was first filed on October 21, 2013, but decision was suspended pending the district court's disposition of Respondent's motion to quash Petitioner's subpoenas or depositions on written questions. On February 28, 2014, the court denied Respondent motion to quash the subpoenas.

This case has been pending since January 25, 2012, and involves Petitioner's claim of priority and likelihood of confusion between its four

¹ On July 18, 2014, new counsel for Petitioner filed an appearance. When the withdrawal of counsel would leave a party without representation in the Board proceeding, a formal withdrawal must be approved by the Board. Trademark Rule 2.19(b). However, filing an appearance is sufficient for recognition for representation. Trademark Rule 2.17(b)(2). Accordingly, the appearance by new counsel for Petitioner makes unnecessary the formal withdrawal filed by former counsel on April 30, 2014. The withdrawal is denied as moot. Copies of this order have been mailed to the addresses listed at the end of this order.

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registered SWIG marks for restaurant and cocktail services and carbonated soft drinks, and Respondent's mark SWIG for alcoholic beverages except beer. The cancellation also involves Respondent's counterclaim to cancel Petitioner's pleaded registrations for services on the ground that Petitioner knew of third party uses of the same mark for identical services, and thus that Petitioner committed fraud with its averments regarding exclusive rights to the marks, and to cancel the pleaded registration for beverages on the ground that Petitioner is not the owner of the mark. Proceedings were suspended for a year via four consented motions filed by the parties. Pursuant to the last consented motion filed and granted June 17, 2013, Petitioner's testimony period was set to close October 21, 2013.

In support of its motion to extend its testimony period for thirty days, Petitioner contends that on October 16, 2013, its subpoenas for the oral deposition of two former officers of Respondent were quashed by the United States District Court for the Northern District of Ohio on the ground that privileged information was sought; on October 18, 2014, Petitioner served subpoenas for depositions on written question of the same witnesses so that the questions could be tailored to avoid disclosure of privileged information; and on October 21, 2014, following Respondent's filing of a motion to quash, the district court stayed enforcement of the subpoenas; and that the extension of testimony is necessary based on the court's stay of Petitioner subpoenas.

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In opposition to the motion Respondent asserts that Petitioner has failed to demonstrate good cause for the required extension; that Petitioner was not diligent in seeking the nonparty testimony; that Petitioner's testimony period opened September 22, 2013; that Petitioner waited until October 9, 2013 to seek oral examination by subpoena; that on October 18, 2014 petitioner gave notice that it would seek deposition by written questions; that Petitioner failed to comply with Trademark Rule 2.124(b)(1), which requires the party desiring to take a testimonial deposition upon written questions to "serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice"; that petitioner's failure to comply with the rule deprives Respondent of the opportunity to prepare cross-examination; and that Petitioner's motion to extend should be denied.

DISCUSSION

The standard for allowing an extension of a prescribed period prior to the expiration of that period is "good cause." *See* Fed. R. Cir. P. 6(b). "[T]he Board is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith and the privilege of extension is not abused." *National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1854 (TTAB 2008). After review of the parties' arguments, the Board finds that Petitioner has not been dilatory in seeking the extension, and that Petitioner has not abused the

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privilege of extensions. In the circumstances of this case, where Petitioner first sought the testimony by oral examination, and was stopped from doing so by Respondent's objection, the failure to provide the notice required by the rule does not demonstrate a lack of diligence.

With respect to Respondent's allegation of prejudice, the Board finds no prejudice which cannot be allayed by suspending proceedings until the depositions on written questions have concluded, and notes that Trademark Rule 2.124 (d)(1) provides for this contingency.² "In view thereof, the Board finds that these circumstances constitute good cause for the extension sought. Petitioner's motion to extend is hereby GRANTED to the extent that proceedings herein are suspended pursuant to Trademark Rule 2.124(d)(2) in order to allow the parties sufficient time in which to complete the testimony upon written questions of Molly and Brian Pearson."³

Petitioner shall promptly advise the Board of the completion of the testimony upon written questions in order that the Board can reschedule the remaining trial dates (commencing with Petitioner's trial period) in this case.

² Trademark Rule 2.124 (d)(1) provides:

On motion for good cause filed by any party, or on its own initiative, the Board may extend any of the time periods specified in 37 CFR § 2.124(d)(1), that is, the time periods for serving cross questions, redirect questions, recross questions, objections, and substitute questions. Further, on receipt of written notice that one or more testimony depositions are to be taken on written questions, the Board will suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions on written questions.

³ The parties are advised that procedures applicable to depositions on written questions are set forth in Trademark Trial and Appeal Board Manual of Procedure (TBMP) §702.02(g)(3rd ed. 2014.).

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