

ESTTA Tracking number: **ESTTA637724**

Filing date: **11/07/2014**

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

Proceeding	92057058
Party	Plaintiff Fifty-Six Hope Road Music Limited
Correspondence Address	JILL M PIETRINI SHEPPARD MULLIN ET AL 1901 AVENUE OF THE STARS STE 1600 LOS ANGELES, CA 90067 6017 UNITED STATES wwalters@smrh.com, mdanner@smrh.com
Submission	Opposition/Response to Motion
Filer's Name	Paul A. Bost
Filer's e-mail	pbost@sheppardmullin.com, lthompson@sheppardmullin.com, jpietrini@sheppardmullin.com, lmartin@sheppardmullin.com, mdanner@sheppardmullin.com
Signature	/s/ Paul A. Bost
Date	11/07/2014
Attachments	Petitioner's Opposition to Motion to Reopen.pdf(194458 bytes)

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

<p><i>In re Matter of Application Registration No. 3,225,517 for the mark: MARLEY'S A TASTE OF THE CARIBBEAN & Design</i></p>  <p>Fifty-Six Hope Road Music Limited, Petitioner, vs. Island Food and Fun, Inc., Registrant.</p>	<p>Cancellation No. 92-057058</p> <p>PETITIONER FIFTY-SIX HOPE ROAD MUSIC LIMITED'S OPPOSITION TO REGISTRANT ISLAND FOOD AND FUN, INC.'S MOTION TO REOPEN</p>
--	--

I. INTRODUCTION

Registrant Island Food & Fun, Inc.'s ("Registrant") motion to reopen readily admits the key facts establishing Registrant's inexcusable neglect in failing to timely respond to Petitioner Fifty-Six Hope Road Music Ltd.'s ("Petitioner") discovery requests. Registrant admits that Petitioner timely served Registrant with discovery requests and that Registrant received such requests. Registrant admits that it never expressly sought an extension of time to respond to these requests and that Petitioner never responded to Registrant's request that the parties agree to suspend this proceeding. Registrant admits that it did not timely respond to Petitioner's discovery requests. Registrant admits that, despite Petitioner's meet and confer efforts, it has still failed to serve responses to these requests more than 6 months after they were due.

Registrant also admits that, despite having more than 6 months to prepare responses to these requests, it refused to provide Petitioner with responses after the adjudication of its motion for summary judgment, instead requesting that its deadline to provide responses be set for November 17, 2014, the same day that Petitioner's pretrial disclosures are currently due.

In light of the above facts, which clearly weigh against finding any excusable neglect on the part of Registrant, Registrant tries to misdirect the Board by referring to alleged instances of "gamesmanship" by Petitioner. Not only is Registrant's narrative misleading, it is, more importantly, irrelevant to the instant matter, that is, Registrant's abject and inexcusable failure to respond to Petitioner's discovery requests.

Accordingly, the Board should deny Registrant's motion to reopen and order Registrant to serve its responses, without objections, to Petitioner's first sets of interrogatories and requests for production ("RFPs"), and produce all responsive documents, within 7 days of any such order. The Board should also extend the pre-trial and trial dates by at least 45 days after entry of the Board's order on Registrant's motion to reopen.

II. RELEVANT FACTS

On February 14, 2014, Petitioner served Registrant with its first set of discovery requests – interrogatories, RFPs, and requests for admission – by first class mail in order to discover facts probative of its claims and Registrant's defenses. (Russell Decl. ¶ 18.) Registrant's written responses to the requests were due to be served on Petitioner no later than March 21, 2014, the discovery deadline. Registrant never requested nor was granted an extension of this deadline. Although Registrant, as part of a settlement offer, requested that the parties agree to suspend the case on February 19, 2014, it never specifically requested an extension or tolling of its deadline to respond to Petitioner's discovery requests. (Russell Decl. ¶ 19, Ex. G.) In any event,

Registrant admits that Petitioner never responded to Registrant's request for suspension. (Russell Decl. ¶¶ 20-22.) On March 27, 2014, *after* the expiration of Registrant's deadline to respond to Petitioner's discovery requests, Petitioner responded to Registrant's settlement offer. (Russell Decl. ¶ 22, Ex. I.) Registrant acknowledges that, in its settlement response, Petitioner did not agree to any suspension of the matter, much less extension of Registrant's deadline to respond to Petitioner's discovery requests, *which were already past due*. (*Id.*)

On April 15, 2014, and pursuant to its meet-and-confer obligations under 37 C.F.R. § 2.120(e)(1) and TBMP § 523, Petitioner sent Registrant a letter notifying Registrant of its waiver of objections to Petitioner's RFPs and interrogatories for its failure to timely respond or object, and requested Registrant's service of responses, without objection, to the RFPs and interrogatories. (Russell Decl. ¶ 28, Ex. L.) On April 16, 2014, Registrant responded to Petitioner's letter and stated, without authority, that the parties' participation in settlement discussions excused Registrant from its discovery obligations. Furthermore, Registrant admitted therein that it had sought Petitioner's consent to suspend the matter for purposes of negotiating settlement, but that Petitioner "never responded to [its] request for consent." (Russell Decl. ¶ 29, Ex. M.) By letter of April 28, 2014, Petitioner explained the foregoing to Registrant and, *again*, requested its service of responses, without objection, to Petitioner's RFPs and interrogatories by May 6, 2014, failing which Petitioner would file a motion to compel Registrant's compliance with its discovery obligations. (Bost Decl. ¶ 32, Ex. P.) Registrant did not comply – and, to date, has not complied – with its discovery obligations, and has not provided any written responses or document production to Petitioner's discovery requests. Instead, on May 2, 2014, with its discovery responses outstanding and a motion to compel forthcoming, Registrant filed its motion for summary judgment, and stated that it would provide discovery responses "[i]n the

event the [motion for summary judgment] does not result in a dismissal of all claims.” (Docket No. 13, Russell Decl. ¶ 11.)

On September 17, 2014, the Board issued its ruling on Registrant’s motion for summary judgment and re-set the remaining deadlines in this case, including Petitioner’s deadline to serve pretrial disclosures, which it scheduled for November 17, 2014. On October 6, 2014, Petitioner reminded Registrant of its obligation to respond to Petitioner’s discovery requests, and requested such responses by October 10, 2014, more than 6 months after they were originally due.

(Russell Decl. ¶ 34, Ex. Q.) Registrant requested that Petitioner forego filing a motion to compel and give it until November 17, 2014 – Petitioner’s deadline to serve its pretrial disclosures – to serve its responses. (*Id.*) Petitioner rejected Registrant’s request because of its proximity to its pretrial disclosure deadline, but, in the interest of compromise, requested Registrant’s responses by October 17, 2014. (Russell Decl. ¶ 35, Ex. R.) Thereafter, Registrant filed the instant motion to reopen, more than 6 months after its discovery responses were originally due.

III. IRRELEVANT FACTS

In its motion, Registrant makes a number of allegations relating to Petitioner’s alleged lack of diligence with respect to the parties’ Rule 26 discovery conference. (Russell Decl. ¶¶ 6-13, Exs. A-C.) Registrant makes no showing as to how these allegations – which are no more than baseless mudslinging – are remotely relevant to the instant dispute, that is, Registrant’s failure to timely respond to its discovery requests and unsupported motion to reopen time. As such, the Board should not consider these facts

IV. REGISTRANT’S MOTION TO REOPEN SHOULD BE DENIED

On a motion to reopen time, “[t]he movant must show that its failure to act during the time previously allotted therefor was the result of excusable neglect.” TBMP § 509.01(b)(1);

Fed.R.Civ.P. 6(b)(1) (“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 *Hewlett-Packard Co. v. Olympus Corp.*, plaintiff Hewlett-Packard claimed that its failure to prosecute its case was the product of excusable neglect because it had sent defendant Olympus a letter requesting an extension of the parties’ testimony period, to which Olympus never responded. 18 U.S.P.Q.2d 1710, 1711 (Fed. Cir. 1991). The Federal Circuit upheld the Board’s finding that Hewlett-Packard failed to establish excusable neglect, holding that “[a] mere request to one’s opponent for extension of time is not sufficient to meet Hewlett’s burden in seeking an enlargement of its testimony period, and Hewlett cannot rely on Olympus’ inaction to establish that its own neglect was excusable.” *Id.* at 1712. Further, the Federal Circuit held that Olympus “was under no affirmative duty to remind Hewlett that it had failed to present its case or to properly seek an extension of Hewlett’s testimony period.” *See also Giersch v. Scripps Networks Inc.*, 85 U.S.P.Q.2d 1306, 1308 (TTAB 2007) (“Counsel for respondent’s mistaken belief that counsel for petitioners would simply agree to another extension request does not absolve respondent from its duty to adhere to the appropriate deadlines in this case.”)

Hewlett-Packard is instructive and should govern the Board’s adjudication of Registrant’s motion to reopen. Registrant, like Hewlett-Packard, cannot rely on Petitioner’s lack of response to Registrant’s request for suspension as a means of establishing excusable neglect. Petitioner’s decision not to respond to Registrant’s request – which *Hewlett-Packard* confirms Petitioner is under no affirmative to do – does not constitute “some unexpected or unavoidable hindrance or accident, or reliance on the care and vigilance of his counsel or on promises made by the adverse party.” *Hewlett-Packard*, 18 U.S.P.Q.2d at 1712. On the contrary, Registrant

had actual knowledge of Petitioner's lack of response to Registrant's request to suspend the proceeding; it knew that Petitioner had not agreed to suspend the proceedings, much less extend Registrant's deadline to provide discovery responses. (Russell Decl. ¶¶ 19-21, Exs. G-I.)¹ Also, Registrant has not – and cannot – identify anything in the parties' course of conduct to lead Registrant to reasonably believe that Petitioner had tacitly agreed to an extension of Registrant's deadline to respond to the outstanding discovery requests. Under these circumstances, Registrant cannot reasonably argue that its failure to respond to Petitioner's discovery requests is excusable.

Petitioner submits that this case's identity to *Hewlett-Packard* is sufficient grounds alone to deny Registrant's motion. Nevertheless, the balance of the factors set forth in *Pumpkin Ltd v. The Seed Corps.*, 43 U.S.P.Q.2d 1582, 1586 (TTAB 1997) also weighs in favor of denying Registrant's motion.

The First Factor: The Danger of Prejudice to Petitioner

If Registrant's motion to reopen is granted, Petitioner will be significantly prejudiced. After the Board issued its decision on Registrant's motion for summary judgment, and without waiver of its objections and position as to Registrant's failure to timely respond, Petitioner requested Registrant to serve its discovery responses – without objections – by October 17, 2014, more than six months after Registrant's responses were originally due. Registrant's request that Petitioner agree to move this deadline by a month to November 17, 2014 is patently

¹ Again, as noted above, Registrant never sought an extension of its deadline to respond to Petitioner's discovery requests. Instead, Registrant "request[ed Petitioner's] consent to a motion for suspension for purposes of settlement negotiation." (Russell Decl. ¶ 19, Ex. G.) Furthermore, Registrant's purported "follow ups" merely requested that Petitioner "suggest a time in the coming week when we can discuss the settlement proposal [Registrant] emailed on Wednesday"; they did not renew Registrant's request for a suspension, much less expressly request an extension of time to respond to Petitioner's discovery requests. (Russell Decl. ¶¶ 20-21, Exs. H and I.)

unreasonable, as Registrant's responses would be due the same day that Petitioner's pretrial disclosures are due. Petitioner cannot reasonably be expected to account for Registrant's discovery responses in pretrial disclosures that are due to be served that very day. *See Pumpkin*, 43 U.S.P.Q.2d at 1587 (prejudice measures the impact of the non-movant's "ability to defend against [the movant's] claims.") Contrary to Registrant's suggestion otherwise, Petitioner informed Registrant of this specific prejudice prior to Registrant's filing of this motion. (Russell Decl. ¶ 35, Ex. R.)

Furthermore, if Registrant's motion to reopen is granted, resolution of this matter will be further delayed. This is not a case in which the parties have repeatedly stipulated to extensions and suspensions of deadlines such that they cannot reasonably complain about yet another delay in the proceedings. On the contrary, the parties have only stipulated to two extensions in this matter; the first was prior to Registrant's filing of its answer in order to allow Registrant's counsel "additional time to secure and review relevant documents and files" (Docket No. 5), and the second was in December 2013 to accommodate the medical needs of Petitioner's counsel. (Docket No. 11; Russell Decl. ¶¶ 14-15, Ex. D.) The main reason this case has been delayed is Registrant's filing of its motion for summary judgment, which delayed the matter nearly four months.²

///

///

² Even if the Board determines that Registrant's motion to reopen does not prejudice Petitioner, that is by no means dispositive. On the contrary, in *Pumpkin*, the Board denied the movant's motion to reopen despite finding that granting it would not have prejudiced the non-movant. *Id.* at 1588 ("The absence of prejudice and bad faith in this case, under the first and fourth *Pioneer* factors, is outweighed by the combination of circumstances under the second and third *Pioneer* factors which are present in this case.")

The Second Factor: The Length of Delay and Its Potential Impact on the Proceedings

Registrant files its motion to reopen more than *six* months after its discovery responses were due. Furthermore, by virtue of filing this motion, this matter will be further delayed. *See Pumpkin* at 1588 (“in addition to the time between the expiration of the time for taking action and the filing of the motion to reopen, the calculation of the length of the delay in proceedings also must take into account the additional, unavoidable delay arising from the time required for briefing and deciding the motion to reopen. The impact of such delays on this proceeding, and on Board proceedings generally, is not inconsiderable.”) Additionally, Petitioner has set forth above how the delay occasioned by Registrant’s refusal to timely respond to the discovery requests and, instead, file a motion to reopen prejudices Petitioner and its interest in a timely resolution of this dispute.

Registrant has not cited any authority supporting its contention that any alleged delay by Petitioner in *initiating* this proceeding is remotely relevant to establishing whether Registrant’s failure to meet a deadline *during* the proceeding was the product of excusable neglect. In any event, Petitioner presented evidence in its opposition to Registrant’s motion for summary judgment of Registrant’s recent activities intentionally and expressly associating its restaurant and mark with Bob Marley. (Docket No. 18, Bost Decl. ¶ 4, Ex. G.)

In sum, this factor weighs in Petitioner’s favor

The Third Factor: The Reason for the Delay, Including Whether It Was Within the Reasonable Control of Registrant

As discussed at length above, Registrant has no colorable excuse for its failure to timely respond to Petitioner’s discovery requests, much less its failure to provide responses within six months of Registrant’s original deadline to respond. Further, there is no dispute that Registrant’s

delay was within its control. Registrant intentionally failed to timely respond to Petitioner's discovery requests, failed to respond after Petitioner requested responses without objection in April 2014, and has failed to respond since the Board's adjudication of its motion for summary judgment on September 17, 2014. This factor, which is the most important factor in the balancing test, weighs heavily in favor of denying Registrant's motion to reopen. *See Pumpkin*, 43 U.S.P.Q.2d at 1587, n. 7 ("In undertaking the *Pioneer* analysis, several of the Circuit Courts of Appeals have stated that this third *Pioneer* factor may be deemed to be the most important of the *Pioneer* factors in a particular case.")

The Fourth Factor: Whether Registrant Acted in Good Faith

Registrant has not established any good faith on its part. There is no suggestion that it mistakenly failed to respond to Petitioner's discovery requests, much less that its continued failure to do so for the next 6 months was mistaken or inadvertent. Instead, the record shows that Registrant has deliberately not complied with its obligations under the Federal Rules and Trademark Rules of Practice. In fact, Registrant's claimed good faith is called into question by its deliberate decision to file a motion for summary judgment to avoid responding to Petitioner's discovery requests or opposing a motion to compel the same. Indeed, Registrant stated that it would only respond to Petitioner's discovery requests if its motion for summary judgment were denied.

Registrant's accusations of gamesmanship on the part of Petitioner are irrelevant to the Board's consideration of Registrant's motion and, in any event, are meritless. As noted above, Petitioner had no affirmative duty to respond to Registrant's request for suspension and never "led Registrant to believe that cooperation," whatever that means, "was forthcoming." (Motion, p. 8.) Notably, Registrant claims it did not serve discovery responses in reliance on Petitioner's

March 27, 2014 correspondence regarding settlement. (Russell Decl. ¶ 22, Ex. I.) This is absurd. Registrant admits that Petitioner did not address Petitioner's request for suspension – much less Registrant's outstanding discovery responses – in its March 27, 2014 letter. (*Id.*) Furthermore, Registrant admits that its deadline to serve its responses was March 21, 2014. Thus, by definition, Registrant could not have failed to serve responses on March 21, 2014 in reliance on correspondence sent on March 27, 2014. (Russell Decl. ¶ 23.)

In sum, this factor weighs in favor of Petitioner and denying the motion to reopen.

V. CONCLUSION

Based on the foregoing, the Board should deny Registrant's motion to reopen and order Registrant to serve its responses, without objections, to Petitioner's first sets of interrogatories and RFPs, and produce all responsive documents, within 7 days of any such order. Petitioner also requests the Board to reset the remaining pre-trial and trial deadlines by 45 days after the date of its order on this motion.

Respectfully submitted,

Dated: November 7, 2014

/s/Paul A. Bost
Jill M. Pietrini
Whitney Walters
Paul A. Bost
Sheppard Mullin Richter & Hampton LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, CA 90067
Telephone: 310.228.3700

Attorneys for Petitioner

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this **PETITIONER FIFTY-SIX HOPE ROAD MUSIC LIMITED'S OPPOSITION TO REGISTRANT ISLAND FOOD AND FUN, INC.'S MOTION TO REOPEN** is being submitted electronically to the Commissioner for Trademarks, Trademark Trial and Appeals, through ESTTA, on this 7th day of November, 2014.

/s/Lynne Thompson _____

Lynne Thompson

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **PETITIONER FIFTY-SIX HOPE ROAD MUSIC LIMITED'S OPPOSITION TO REGISTRANT ISLAND FOOD AND FUN, INC.'S MOTION TO REOPEN** is being deposited as first class mail, postage prepaid, in an envelope addressed to:

Elizabeth T Russell
Russell Law
6907 University Avenue, #227
Middleton, Wisconsin 53562

on this 7th day of November, 2014.

/s/Lynne Thompson _____

Lynne Thompson

SMRH:434767475.1