

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: July 30, 2015

Cancellation No. 92058315

State of Michigan

v.

M22, LLC

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of Petitioner's July 20, 2015 1) motion to extend time to serve discovery responses, and 2) motion for a protective order. The motions are fully briefed.

When time is of the essence, the moving party may request that a motion or motions be resolved by telephone conference call. *See* TBMP § 521 (2015). Respondent filed a July 22, 2015 request for a telephone conference with the Board. The Board granted the request, and on July 27, 2015 convened a telephone conference to resolve the issues presented in the motions.¹ *See*

¹ Disposing of Petitioner's argument that the conference should be held after its reply brief in support of each motion is filed, Petitioner is directed to TBMP § 526.01 (2015), which states in relevant part: "The Board has the discretion to decide the motion by telephone conference prior to the expiration of the written briefing period for filing a response or reply."

Petitioner's proof of service of its filings omit name and address information. The Board expects that a certificate of service, or other statement signed by a filing party or its attorney, should specify the name and address (street and/or email address) of each party upon whom service was made. *See* TBMP § 113.03 (2015).

Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (2015). Participating were Petitioner's counsel Toni L. Harris, Respondent's counsel John Di Giacomo, and the interlocutory attorney.

The Board reviewed the parties' motions and briefs on the motions, but for efficiency does not restate the parties' arguments in their entireties. This order summarizes the Board's analysis and findings based on the briefs, as well as arguments on reply and clarifications provided during the conference.

Motion to extend

With a motion to extend, the moving party need only show good cause for the requested extension. *See* Fed. R. Civ. P. 6(b). A party moving to extend time must demonstrate that the requested extension is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor. *See* TBMP § 509.01 (2015). The moving party retains the burden of persuading the Board that it was diligent in meeting its responsibilities and should therefore be awarded additional time. *See National Football League v. DNH Mgt. LLC*, 85 USPQ2d 1852, 1854 (TTAB 2008). The movant must state with particularity the facts believed to constitute good cause for the requested extension of time; mere conclusory allegations lacking in factual detail are insufficient. *See Luemme, Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1760 (TTAB 1999). Generally, the Board is liberal in granting extensions of time before the period to act has elapsed so long as the movant has

not been guilty of negligence or bad faith, and the privilege of extensions is not abused. *See National Football League v. DNH Mgt. LLC*, 85 USPQ2d at 1854.

The record reflects that Petitioner set forth with specificity the need for additional time to respond to Respondent's discovery served on June 23, 2015. Furthermore, Petitioner has requested a reasonable extension, and does not require additional time as a result of its own negligence, or a lack of diligence or attentiveness to this proceeding. Petitioner has not abused the privilege of extensions. Moreover, Respondent's ability to develop and present its case will not be prejudiced by allowing Petitioner a reasonable extension of time.

Upon consideration of all of the circumstances presented on the record, the Board finds that Petitioner has fulfilled the good cause standard required in order to be granted an extension of time. *See Trademark Rule 2.120(a)(3)*. Accordingly, Petitioner's motion is granted to the extent that it is allowed until August 17, 2015 to serve responses to Respondent's first set of written discovery requests served June 23, 2015.

Motion for protective order

At issue is the Notice of Discovery Deposition of the State of Michigan, which Respondent served on June 23, 2015. Petitioner seeks an order requiring Respondent to serve a revised notice for the Fed. R. Civ. P. 30(b)(6) deposition, on the basis of objections to the date and location thereof, as well as various objections to several of the identified topics.

Turning to the notice of deposition, with respect to the July 28, 2015 date, the Board finds that Respondent did not sufficiently communicate and coordinate with Petitioner prior to establishing the date, and thus did not proceed in the manner in which the Board expects of parties in cancellation proceedings. *See* TBMP § 404.01 (2015). Coordination with Petitioner's present counsel so as to ascertain a mutually agreeable date would have prevented the schedule-related problems that resulted. In view of these findings, Petitioner's objection is sustained.

Regarding the Traverse City location, Respondent failed to notice the deposition in a manner consistent with Trademark Rule 2.120(b). *See also* TBMP § 404.03(a) and 408.01 (2015). On this basis, Petitioner's objection is sustained. Furthermore, Petitioner's counsel has stated that the State's principal place of business is Lansing, and that the individuals likely to be its Rule 30(b)(6) designees reside and/or are employed in or near Lansing.

Regarding the nineteen topics that Respondent identified in the notice, as a general matter, the Board finds unpersuasive Petitioner's objections that Respondent seeks information that is irrelevant to this proceeding, and that the categories of testimony requested are burdensome. Petitioner chose to avail itself of the Board's *inter partes* procedures. More specifically, Petitioner filed an operative pleading in which it alleges numerous grounds for cancellation and sets forth a multiplicity of allegations. For instance, Petitioner's relevance objection based on the assertion that Respondent seeks "information dating back 80 or 100

years” (Petitioner’s brief, p. 5) is overruled; Petitioner sets forth allegations regarding its asserted rights that date back to 1919 (*e.g.*, Second Amended Consolidated Petition to Cancel, para. 2, 5, 11), and thus has placed its asserted rights dating to that time at issue.

During the conference the Board noted that certain topics are not identified with sufficient specificity to provide Petitioner adequate notice. Turning to the substance therein, Topic 1 requires either deletion or amendment to narrow and specify the allegations on which Respondent intends to question the witness(es). Topics 2 and 3 require amendment so as to identify, at a minimum, the allegations, grounds or defenses to which they are directed. Topics 5, 9, 10, 11 and 19 require amendment so as to identify the section(s) of the MUTCD, as well as the type(s) of use of the mark, about which Respondent intends to depose the witness(es). Topic 19 requires amendment to specify the identity or category of third parties to which Respondent refers. Topic 7 requires amendment to narrow the type of revenue, and type of use of the sign, to which it is directed. Respondent’s counsel stated during the conference that Topic 12 will be deleted. Topics 13, 14 and 15 require amendment so as to further specify, by date, event, publication and/or region of Michigan, the specific information to which each topic pertains and about which Respondent intends to depose the witness(es).

Respondent is directed to serve a revised notice of deposition which addresses the deficiencies and the sustained objections discussed herein.

Notwithstanding that Petitioner filed a motion for a protective order, the remedy that is consistent with its objections to the notice of deposition at issue is to quash the notice of deposition. *See* TBMP § 521 (2015). Accordingly, for the reasons noted above, the notice of deposition served on June 23, 2015 is quashed.

The Board reminds the parties that its Standard Protective Order is in effect and enforceable. *See* Trademark Rule 2.116(g); TBMP § 412 (2015).

The Board noted in the conference that Respondent developed the listed topics without having in hand Petitioner's answers to written discovery, and that this approach contributed to various matters that gave rise to petitioner's motion. The better practice in Board proceedings is to ascertain the topics on which to depose an adversary subsequent to a review of responses to discovery, *e.g.*, interrogatories and requests for documents and things. Also, even though the Board does not set a firm deadline for Respondent to serve a revised notice of deposition during the discovery period, it is anticipated that Respondent will reschedule to a date that is subsequent to August 17, 2015, and on which the parties mutually agree. The Board expects that Respondent will communicate and coordinate with Petitioner prior to determining a date and specific office location for Petitioner's deposition. The Board expects that the same approach will be followed with respect to any other depositions that Respondent may wish to take in this proceeding.

Regarding the manner in which the Rule 30(b)(6) deposition may be taken, the parties may opt to employ remote or technological means, such as video-

Cancellation No. 92058315

teleconferencing. Fed. R. Civ. P. 30(b)(4). *See* TBMP § 404.06(2015); *Hewlett-Packard Co. v. Healthcare Personnel, Inc.*, 21 USPQ2d 1552, 1152-53 (TTAB 1991).

Schedule

Discovery, pretrial disclosure and trial dates remain as set in the Board's May 29, 2015 order. *See* Trademark Rule 2.120(a)(3).