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

EJW

Mailed: September 30, 2015

Cancellation No. 92060018

Todd Sean White[1]

v.

Gary L. Pifer and Joe Faustine

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

This case comes now for consideration of Respondent's contested motion (filed August 7, 2015) to substitute the party-defendant, Gary Pifer, with the assignee of the involved registration, Joe Faustine. Respondent also seeks an extension of time to serve his initial disclosures.

For purposes of this order, the Board presumes the parties' familiarity with the arguments set forth by each party in connection with the subject motions.

Motion to Substitute Party-Defendant

By way of background, on June 23, 2015, Respondent filed an assignment of the involved registration from Gary L. Pifer to Joe Faustine, which was recorded in the USPTO Assignment Recordation Branch at Reel 5563/Frame 0483. Mr. Pifer conveyed the entire interest in the registration to Mr. Faustine. Respondent Pifer

[1] The appearance of counsel filed July 8, 2015, for Petitioner is noted and the proceeding file has been updated accordingly.

now requests that the Board substitute him with Mr. Faustine as the Respondent (party-defendant) in this matter.

If the mark in a registration which is the subject matter of an *inter partes* proceeding before the Board is assigned, together with the registration, the assignee may be joined as a party (as a party defendant, in the case of an opposition or cancellation proceeding) upon the filing with the Board of a copy of the assignment. When the assignment is recorded in the Assignment Recordation Branch of the USPTO, as it has been here, the assignee may be substituted as a party if the assignment occurred prior to the commencement of the proceeding, or the assignor is no longer in existence, or the plaintiff raises no objections to substitution, or the discovery and testimony periods have closed; otherwise, the assignee will be joined, rather than substituted, to facilitate discovery. *See, e.g., NSM Resources Corp. v. Microsoft Corp.,* 113 USPQ2d 1029, 1031 (TTAB 2014) (finding joinder rather than substitution appropriate where assignment of pleaded mark was executed one year after proceeding commenced and nothing in the record indicated petitioner or business connected with mark no longer in existence); *Drive Trademark Holdings LP v. Inofin,* 83 USPQ2d 1433, 1434 n.2 (TTAB 2007) (applicant's motion to join another defendant granted where assignment of application occurred after commencement of proceeding); TBMP § 512.01 (2015).

Because the assignment of the involved mark occurred after the commencement of this proceeding, and Petitioner objects to substitution, Mr. Faustine cannot be substituted for Mr. Pifer. Rather, Mr. Faustine must be joined as a party-defendant

in this proceeding. Accordingly, Respondent's motion is **denied**, and Joe Faustine is hereby **JOINED** as a party-defendant in this proceeding.

Motion to Extend Time to Serve Initial Disclosures

In accordance with the Board's order mailed on July 7, 2015, the date on which each party was obligated to serve initial disclosures was August 6, 2015. Respondent's motion was filed the day after, on August 7, 2015, so his motion to extend time to serve his initial disclosures must be considered as a motion to reopen. *See* Fed. R. Civ. P. 6(b); *See Pioneer Inv. Svcs. Co. v. Brunswick Assoc. Ltd. P'shp,* 507 U.S. 380, 395 (1993); *FirstHealth of the Carolinas Inc. v. CareFirst of Md. Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1921-22 (Fed. Cir. 2007); and *Pumpkin Ltd. v. Seed Corps,* 43 USPQ2d 1582, 1586 n.7 (TTAB 1997).

Neither party discussed whether Respondent had shown excusable neglect for failing to serve his initial disclosures by the due date. Petitioner, nonetheless, opposes the extension (reopened period), arguing that Respondent failed to contact Petitioner regarding the need for an extension of time and has failed to respond to Petitioner's discovery.

Respondent's asserted failure to participate in discovery in this proceeding is not a basis for denying Respondent's motion. Petitioner's discovery concerns are not before the Board. Additionally, in view of the totality of the circumstances shown in the record, including the apparent misunderstanding of Respondent Pifer that he would be relieved from participating in the proceeding once the involved registration was assigned, lack of prejudice to Petitioner, and no evidence of bad

faith on the part of Respondents, the Board finds that Respondents' deadline for serving initial disclosures should be reopened. Accordingly, Respondents' motion to reopen their time to serve initial disclosures is **granted**. In that regard, Respondents are directed to the following sources regarding initial disclosures:

> **http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf** and to http://edocket.access.gpo.gov/2006/pdf/06-197.pdf, or to http://www.uspto.gov/trademarks/process/appeal/RULES01_17_06.pdf. *See* Notice of Final Rulemaking ("Miscellaneous Changes to Trademark Trial and Appeal Board Rules") in the Federal Register, 72 Fed. Reg. 147 (August 1, 2007) and 71 Fed. Reg. 10, 2501 (January 17, 2006) (pages 2498 and 2501).

No further extension of time for serving initial disclosures will be granted.

Trial Dates Reset

Trial dates are reset as shown below.

Respondents' Initial Disclosures Due	**10/30/2015**
Expert Disclosures Due	**1/28/2016**
Discovery Closes	**2/27/2016**
Plaintiff's Pretrial Disclosures Due	**4/12/2016**
Plaintiff's 30-day Trial Period Ends	**5/27/2016**
Defendant's Pretrial Disclosures Due	**6/11/2016**
Defendant's 30-day Trial Period Ends	**7/26/2016**
Plaintiff's Rebuttal Disclosures Due	**8/10/2016**
Plaintiff's 15-day Rebuttal Period Ends	**9/9/2016**

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. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

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