

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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DUNN

Mailed: November 28, 2015

Cancellation No. 92060464

Safeside Tactical, LLC

v.

Cheytac USA LLC

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on Respondent's motion filed November 6, 2015 to reopen its time to respond to Petitioner's motion for summary judgment which closed September 30, 2015, and Respondent's motion filed November 9, 2015 to reopen its time to correct deficiencies in its proposed amendment which closed March 11, 2015. The motions are contested.

As background the Board notes that this likelihood of confusion case was filed December 1, 2014, that shortly after filing its answer, Respondent filed a deficient and unconsented motion to amend subject Registration No. 4509171 to assert earlier dates of use; that on February 9, 2015, the Board issued an order advising Respondent as to how to correct the proposed amendment, that the last filing by Respondent was its February 10, 2015 reply brief (which apparently was mailed before the Board's order issued). On

June 5, 2015, the Board noted that Respondent's proposed amendment remained deficient and would be given no further reconsideration, and resumed proceedings, with the next deadline being the parties' discovery conference, which was to take place by July 6, 2015.

On July 6, 2015, Petitioner served Respondent with written discovery requests, including requests for admission, making Respondent's responses due August 10, 2015. On August 26, 2015, having received no responses to its requests for discovery, Petitioner filed the motion for summary judgment based on Respondent's admissions deemed admitted by operation of Fed. R. Civ. P. 36. While the motion includes a chronology which states when Petitioner served Respondent with its initial disclosures, there is no reference to any attempt to communicate with Respondent regarding the required discovery conference.

In support of its motion to reopen Respondent submits the declarations of David McCutcheon, President of Respondent, who in both declarations avers that he retained attorney Gerald Romanoff to represent Respondent in this proceeding; that he is not an attorney, that he is not familiar with trademark matters, and attorney Romanoff handled all matters with respect to the case up until his death; that Attorney Romanoff died April 4, 2015; that after learning of attorney Romanoff's death; that Respondent made his best effort to retrieve the files in Attorney Romanoff's custody; that Respondent also was undergoing a corporate reorganization; that Respondent

sought new counsel; and that Respondent was unaware of pending deadlines and unaware that the motion for summary judgment had been filed.

With respect to the motion to reopen Respondent's time to correct its proposed amendment to its registration, Respondent asserts that, upon investigation, Attorney Romanoff filed the required declaration and fee but in the wrong place. More specifically, Respondent notes that instead of filing its February 18, 2015 response with the Board, Attorney Romanoff filed the declaration and fee in the Trademark file, and the fee was returned.

In opposition to both motions to reopen, Petitioner notes that Attorney Romanoff's death took place more than six months ago, and that Respondent learned of his death within two weeks of its occurrence, and so Attorney Romanoff's death should not be considered the basis for the following five months of delay and inaction.

DISCUSSION

Pursuant to Fed. R. Civ. P. 6(b)(1)(B), "When an act may or must be done within a specified time, the court may, for good cause, extend the time ... on motion made after the time has expired if the party failed to act because of excusable neglect." The Board's "excusable neglect" standard was discussed in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), which followed the test set out by the Supreme Court in *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993). In *Pioneer*, the Court stated that a determination of excusable neglect

is at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include ... (1) the danger of prejudice to the [nonmovant], (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith. *Pioneer*, 507 U.S. at 395.

a) REOPEN TIME TO RESPOND TO MOTION FOR SUMMARY JUDGMENT

The Board finds that three of the four *Pioneer* factors clearly favor the grant of Respondent's motion. With respect to the first factor, Petitioner points to no loss of witnesses or evidence which would affect its ability to put on its case. *See Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997)(no showing that any of applicant's witnesses and evidence have become unavailable as a result of the delay in proceedings). Contrary to Opposer's argument, the delay itself is not prejudicial. *See Old Nutfield Brewing Co. v Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1701 (TTAB 2002)(the mere passage of time is generally not considered prejudicial). As to the second *Pioneer* factor, the relevant period for measuring delay is not the six months since counsel's death, but the five weeks since Respondent's response to the motion for summary judgment was due. The response was due September 30, 2015, and the motion to reopen the time for responding was filed on November 6, 2015. Inasmuch as proceedings have been suspended, the Board sees little impact from the delay on this proceeding. Finally, as to the fourth

factor, there is no evidence that Respondent has acted in anything but good faith.

The reason for the delay, the third *Pioneer factor*, presents the closest question. In this regard the Board agrees with Petitioner that, while there is no reason to doubt Respondent's assertion that Respondent was at a loss following counsel's death, and that Respondent was unaware of the motion for summary judgment, Respondent was aware that it was involved in this proceeding. Knowing that, it was not reasonable for Respondent to delay obtaining new representation for many months, even with the pressure of a corporate reorganization. *Compare HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156 (TTAB 1998) (excusable neglect not shown where, in seeking to reopen their initial testimony period on the basis of the death of their attorney, petitioners failed to provide the Board with the date of the attorney's death and an explanation as to why other attorneys listed as counsel for petitioners could not have assumed responsibility for the case).

However, because Petitioner could and should have found out about the death of Attorney Romanoff sooner, the Board cannot find the delay solely attributable to Respondent. The Board's June 5, 2015 order required the parties to conduct a discovery conference, and it is well settled that conducting the conference is a mutual obligation of the parties. *Influence, Inc. v. Elaina Zuker*, 88 USPQ2d 1859, 1860 (TTAB 2008). If Petitioner had attempted to meet its obligation to conduct the discovery scheduled before

July 6, 2015, Petitioner would have learned of the death of Attorney Romanoff. At that point Petitioner could have involved the Board, and the Board would have raised the issue of representation and pending deadlines to Respondent.

In this regard the Board also notes that it is unusual that a party who fails to receive discovery responses files a motion for summary judgment based on admissions two weeks later, with no intervening communication with the responding party. Usually the first action of a requesting party is to contact the other side to see if the discovery dispute may be resolved. To do otherwise risks the exact situation in which Petitioner now finds itself, which is receiving belated knowledge of extraordinary circumstances, such as the death of counsel.

In sum, while the Board finds that Respondent did not act promptly in obtaining new counsel, the Board finds that Petitioner contributed to the length of time in which representation was at issue by failing to communicate with Respondent. Considering all the circumstances here, the Board makes the equitable determination that Respondent has demonstrated that its failure to timely respond to the motion for summary judgment was the result of excusable neglect. Accordingly, Respondent's motion to reopen its time to respond to Petitioner's motion for summary judgment is GRANTED.

Respondent is allowed until THIRTY DAYS from the mailing date of this order to respond to the motion for summary judgment.

b) REOPEN TIME TO CORRECT DEFICIENCIES IN PROPOSED AMENDMENT

There is no need to reopen Respondent's time to correct the proposed amendment in its motion to amend its registration filed January 13, 2015. The Board's February 9, 2015 order allowed Respondent time to correct deficiencies in the amendment, failing which it would be given no consideration. In accord with that order, when Respondent failed to respond, the Board resumed proceedings. The Board did not deny the motion to amend with prejudice. If Respondent wishes to file another motion to amend, there is no procedural bar to doing so.

As stated previously, consideration of any unconsented amendment will be deferred decision upon a motion for summary judgment or following trial. Since a motion for summary judgment is pending, a motion to amend the subject registration would be germane to the motion for summary judgment and not barred by the suspension order.

PROCEEDINGS REMAIN SUSPENDED

Proceedings herein remain suspended pending disposition of Petitioner's motion for summary judgment.