

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

Baxley

Mailed: April 6, 2016

Cancellation No. 92060464

Safeside Tactical, LLC

v.

CheyTac USA LLC

Andrew P. Baxley, Interlocutory Attorney:

The following motions are pending in this case: (1) Petitioner's motion (filed August 26, 2015) for summary judgment; and (2) Respondent's motion (filed December 22, 2015, with revision filed December 30, 2015) to amend the dates of use in its involved Registration No. 4509171.

In view of Petitioner's opposition to the motion to amend the dates of use, the Board, in keeping with its general practice, defers consideration of the motion to amend until final decision.¹ *See* TBMP § 514.03 (2015).

¹ In any event, dates of use in the involved registration are not evidence; dates of use in a Board proceeding must be established by competent evidence. *See* Trademark Rule 2.122(b)(2). Respondent may prove an earlier date of use than the date alleged in its involved registration, but its proof must be clear and convincing and must not be characterized by contradiction, inconsistencies or indefiniteness. *See Hydro-Dynamics, Inc. v. George Putnam & Co., Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987); *Threshold.TV Inc. v. Metronome Enterprises Inc.*, 96 USPQ2d 1031, 1036 (TTAB 2010). The reason for this evidentiary burden on Respondent is because a change of position to earlier dates of use from one considered to have been made against interest at the time of filing the application, requires enhanced substantiation. *See id.*

Cancellation No. 92060464

Turning to the motion for summary judgment, that motion is based entirely upon Respondent's failure to respond to requests for admission that Petitioner served by mail on July 6, 2015.² Under Federal Rule of Civil Procedure 36(a)(3), "[a] matter is admitted unless, within 30 days after being served, the party to whom the request is directed serves on the requesting party a written answer or objection addressed to the matter and signed by the party or its attorney." Where matters stand admitted, they are conclusively established. *See Fram Trak Ind. Inc. v. WireTracks LLC*, 77 USPQ2d 2000, 2005 (TTAB 2006). In view of Respondent's failure to timely respond to the requests for admission, Petitioner's requests for admission are deemed admitted and therefore conclusively established, unless the Board allows withdrawal or amendment thereof.³

To avoid the effect of admissions resulting from a failure to timely respond, a responding party may pursue two separate avenues for relief. A party may either (1) move to reopen its time to respond to the admission requests because its failure to timely respond was the result of excusable neglect under Federal Rule of Civil

² Accordingly, responses to those requests were due by August 10, 2015. *See* Trademark Rules 2.119(c) and 2.120(a)(3).

³ Respondent's assertion that Petitioner's requests for admission are not deemed admitted because no discovery conference occurred in this case is unpersuasive. Petitioner asserts in its reply brief in support of the motion for summary judgment that the parties held a discovery conference in this case on or about January 27, 2015. 21 TTABVUE 6.

Moreover, although a party is prohibited from serving discovery requests or filing a motion for summary judgment until it serves its initial disclosures (*see* Trademark Rules 2.120(a)(3) and 2.127(a)), there is no corresponding prohibition regarding failure to participate in the mandatory discovery conference. Rather, failure to participate in the discovery conference is properly raised by filing, prior to the deadline for the parties' initial disclosures, a motion for sanctions under Trademark Rule 2.120(g)(1) and/or to compel participation in the discovery conference. *See Promgirl Inc. v. JPC Co.*, 94 USPQ2d 1759 (TTAB 2009).

Cancellation No. 92060464

Procedure 6(b)(1)(B), or (2) move to withdraw and amend its admissions pursuant to Federal Rule of Civil Procedure 36(b). In a motion under Rule 6(b)(1)(B), the movant seeks to reopen the time to serve responses to the outstanding admission requests based on a showing of excusable neglect; in a motion under Rule 36(b), the movant implicitly acknowledges that its responses are late and the requested admissions are therefore deemed admitted, but now seeks to withdraw the effective admissions and provide responses. *See Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007).

In the brief in response to the motion for summary judgment, Respondent contends that “Petitioner’s Claim that Respondent’s Admissions are Deemed Admitted for Failure to Respond to Discovery Requests Must Be Disregarded.” 18 TTABVUE 7. Respondent further contends that “There is No Deemed Admission Because Registrant Never Received the Discovery Requests.” 18 TTABVUE 9. Respondent also states that, after obtaining a copy of the requests for admission by downloading them as an exhibit to Petitioner’s motion for summary judgment, Respondent served responses to those requests “[o]n or about December 21, 2015.” 18 TTABVUE 6. The Board therefore construes Respondent’s brief in response to the motion for summary judgment as seeking to show excusable neglect to be relieved of the untimeliness of its responses under Rule 6(b)(1)(B) and to make operative the responses to the requests for admissions that it belatedly served upon Petitioner.

Cancellation No. 92060464

In *Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), the Supreme Court clarified the meaning and scope of "excusable neglect," as used in the Federal Rules of Civil Procedure and elsewhere. The Court held that the determination of whether a party's neglect is excusable 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 Investment Services Co. v. Brunswick Associates L.P., 507 U.S. at 395. In subsequent applications of this test, several courts have stated that the third *Pioneer* factor, namely the reason for the delay and whether it was within the reasonable control of the movant, might be considered the most important factor in a particular case. *See Pumpkin, Ltd.*, 43 USPQ2d at 1586 n.7 and cases cited therein.

Turning initially to the third *Pioneer* factor, the Board finds that Respondent's delay was caused by its nonreceipt of the service copy of Petitioner's requests for admission, which were served upon Respondent's former attorney on July 6, 2015, more than three months after the April 4, 2015 death of that attorney. The Board further finds that such nonreceipt was beyond Respondent's reasonable control. As the Board noted in its November 28, 2015 order, wherein the Board granted Respondent's motion to reopen time to respond to the motion for summary judgment, "it is unusual that a party who fails to receive discovery responses files a

Cancellation No. 92060464

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.” 17 TTABVUE 6. Based on the foregoing, this factor is resolved in Respondent’s favor.

With respect to the first *Pioneer* factor, Respondent’s delay, by itself, is not prejudicial. See *Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1702 (TTAB 2002). While Petitioner relied on the admissions in its motion for summary judgment, such reliance does not rise to the level of prejudice. See *Giersch*, 85 USPQ2d at 1309. Rather, Petitioner has pointed to no loss of witnesses or missing evidence which would affect its ability to prosecute its case. See *Pratt v. Philbrook*, 109 F.3d 18 (1st Cir. 1997). Further, any potential prejudice can be mitigated by extending the discovery period.⁴ See *Johnston Pump/General Valve, Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989). Accordingly, this factor is resolved in Respondent’s favor.

As to the second *Pioneer* factor, the relevant period for measuring delay is the time that has lapsed since the August 10, 2015 due date for Respondent’s discovery responses, i.e., nearly eight months. However, because proceedings have been suspended since September 10, 2015, any impact from the delay on this proceeding has been minimal. The Board further notes that Petitioner contributed to such

⁴ After Petitioner filed its motion for summary judgment, the Board, in a September 10, 2015 order, suspended this proceeding pending a decision on the motion for summary judgment. The motion for summary judgment was filed with more than four months remaining in the discovery period.

Cancellation No. 92060464

delay by failing to contact Respondent after Respondent failed to serve timely responses to Petitioner's discovery requests. Accordingly, this factor is resolved in Respondent's favor. Finally, as to the fourth *Pioneer* factor, there is no evidence that Respondent has acted in bad faith.

Based on the foregoing, the Board finds that, on balance, Respondent's failure to serve timely responses to Petitioner's requests for admissions was the result of excusable neglect. Accordingly, Respondent is hereby relieved of the failure to timely respond to those requests and the responses that Respondent served on or about December 21, 2015 are deemed operative. Because Petitioner's motion for summary judgment is based entirely on admissions that are no longer operative, that motion is moot.⁵

Proceedings herein are resumed. The parties are allowed until thirty days from the mailing date set forth in this order to serve responses to any outstanding written discovery requests. Remaining dates are reset as follows.

Initial Disclosures Due ⁶	4/18/2016
Expert Disclosures Due	8/16/2016
Discovery Closes	9/15/2016
Plaintiff's Pretrial Disclosures Due	10/30/2016
Plaintiff's 30-day Trial Period Ends	12/14/2016
Defendant's Pretrial Disclosures Due	12/29/2016

⁵ Evidence submitted in connection with the motion for summary judgment will receive no consideration at final hearing unless it is properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

⁶ Petitioner states that it already served its initial disclosures. 6 TTABVUE 4. The record is unclear as to whether Respondent has served its initial disclosures. Petitioner is reminded that it has a duty to supplement or correct its initial disclosures as necessary. *See Fed. R. Civ. P. 26(e)(1)*.

Cancellation No. 92060464

Defendant's 30-day Trial Period Ends	2/12/2017
Plaintiff's Rebuttal Disclosures Due	2/27/2017
Plaintiff's 15-day Rebuttal Period Ends	3/29/2017

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. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129. If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.