

TTAB

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



05-24-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #70

TED LAPIDUS,

Opposer,

v.

LAMBERTSON TRUEX, INC.,

Applicant.

Opposition No. 118,497

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TRADEMARK TRIAL AND APPEAL BOARD

REQUEST FOR RECONSIDERATION OF BOARD'S
DECISION MAILED APRIL 19, 2002

Opposer respectfully requests reconsideration, pursuant to 37 CFR §2.127(b), of the decision of the Trademark Trial and Appeal Board ("Board") mailed April 19, 2002 to the extent that it denied opposer's request for reconsideration of the Board's earlier October 3, 2001 decision denying opposer's motion to extend its testimony period and to the extent that it granted applicant's motion to reset applicant's testimony period.

I. Opposer's Limited Renewed Request for Reconsideration of Board's October 3, 2001 Decision Denying Opposer's Motion to Extend Its Testimony Period

Opposer moved for reconsideration of the Board's October 3, 2001 decision denying opposer's motion to extend its testimony period. In reaching its decision, the Board made a manifest error in law in concluding that good cause was not shown. The Board's decision was based entirely on its conclusion that opposer did not show good cause by relying upon the delay

occasioned by the parties' failure to informally exchange documents and the foreign status of opposer.¹

In fact, however, such delay was not the basis for opposer's motion. Opposer's motion was based on the lack of responses to its discovery requests.²

Although opposer clearly stated this basis in its initial motion and in its motion for reconsideration, the Board failed to address this basis. In doing so, the Board misconstrued opposer's motion and reached an erroneous decision.

Common sense and ample precedent make clear that opposer was entitled to the benefit of responses to its discovery requests prior to taking testimony. Since applicant had not responded to opposer's discovery requests, opposer was unquestionably entitled to an extension of time for taking testimony. However, even assuming that the Board declined to follow prior precedent, opposer's adherence to the guidance provided by precedent in seeking an extension most assuredly satisfied the requirement of good cause.

Opposer respectfully submits that the Board also erred in failing to give proper weight to the fact that opposer did, in

¹ The Board also stated that it would not consider the "new evidence" submitted with opposer's motion for reconsideration. However, the declaration submitted by opposer's counsel was merely a statement of earlier presented facts and contained absolutely no new evidence. The Board thus committed manifest error in ignoring the declaration.

² The foreign status of opposer was merely mentioned in the motion as a ground for seeking sufficient additional time to obtain translations after applicant's discovery responses were received.

fact, timely serve formal discovery requests on March 16, 2001, three months before the close of opposer's testimony period. Had applicant timely responded to opposer's discovery requests, which it was obligated to do, opposer would have had ample opportunity to proceed with the orderly taking of testimony prior to the close of testimony on June 16, 2001.

Applicant intentionally delayed in responding to opposer's discovery requests until June 21, 2001, more than two months after the responses were originally due and nine days after the close of opposer's testimony period. Applicant readily acknowledges that it intentionally delayed in responding to opposer's discovery because it served discovery requests before opposer did (by three days) so that, according to applicant, applicant was entitled to receive discovery responses from opposer before responding to opposer's discovery requests. As opposer repeatedly pointed out to applicant and the Board, the "priority of discovery" rule has long been abolished, see, Miss America Pageant v. Petite Productions Inc., 17 USPQ2d 1067,1070 (TTAB 1990), and applicant was not relieved of its discovery obligations simply because it served discovery requests three days earlier than opposer.

Opposer served its discovery requests in sufficient time to receive applicant's responses well in advance of opposer's testimony period. While opposer (and applicant) may have forfeited the right to take follow-up discovery, opposer did not forfeit the right to receive applicant's discovery responses

before proceeding with the taking of testimony. The Board has long recognized that a party is entitled to the benefits of discovery in preparing for trial. Stated otherwise, the Board has repeatedly concluded that an opposer is entitled to discovery responses prior to its obligation to take testimony. Any contrary conclusion would be absurd. See, e.g., Ortho Pharmaceutical Corp. v. Schattner, 184 USPQ 556,558 (TTAB 1975) ("Opposer's position is fair since it is clearly entitled to use the benefits of discovery in its preparation for trial."); Sunkist Growers, Inc. v. Benjamin Ansehl Co., 229 USPQ 147,149 (TTAB 1985) ("Clearly, in this case it is reasonable to extend time in order to allow Opposer to complete its discovery before progressing into its testimony.").

Applicant's refusal to respond to opposer's discovery requests in a timely manner necessitated opposer's motion to extend its testimony period, and such constitutes good cause under Fed. R. Civ. P. 6(b)(1) for granting opposer's motion. Applicant's intentional delay in responding to opposer's discovery requests should not be used to prejudice opposer by foreclosing it from presenting testimony in support of its opposition. By denying opposer's motion to extend its testimony period, opposer has been nonsuited and applicant has been rewarded for its dilatory conduct. Since the Board's decision effectively nonsuits opposer, the Board should exercise its discretion to reopen opposer's testimony period under the foregoing circumstances. Opposer should not be non-suited for

relying upon precedent of this Board in seeking an extension of time to take testimony. CTRL Systems, Inc. v. Ultraphonics of North America, Inc., 52 USPQ2d 1300, 1301 (TTAB 1999):

The law favors determination of cases on the merits; and when circumstances dictate that a judgment by way of default or dismissal for failure to prosecute should be set aside, the Board will exercise its discretion ... to reopen the case.

II. Opposer's Request for Reconsideration of Board's April 19, 2002 Decision Granting Applicant's Motion for Resetting of Applicant's Testimony Period

Applicant moved for a suspension of proceedings in the counterclaim and for a resetting of applicant's testimony period in the counterclaim pending the Board's decision on applicant's motion for dismissal of the opposition. In its decision, the Board not only granted applicant's motion, but also reopened applicant's testimony period in the opposition, which pursuant to the Board's October 3, 2001 decision, had closed on December 1, 2001. Opposer respectfully submits that the decision is in error in reopening and resetting the testimony period for applicant in the opposition. The decision should have, as explicitly requested by applicant, reset applicant's testimony period in the counterclaim only.

Briefly by way of background, applicant untimely filed a motion for dismissal of the opposition, which the Board refused to consider due to its untimeliness. Applicant did not seek a suspension of the proceedings in the counterclaim, nor did applicant seek a resetting of applicant's testimony period in the

counterclaim pending the Board's decision on its motion for dismissal. It is therefore unfair and prejudicial to opposer for the Board, on its own, to reopen and reset applicant's testimony period in the opposition as such now affords applicant another opportunity to move for dismissal of the opposition, which applicant has again done.

Applicant delayed, without justification, until after the opening of its testimony period before initially moving for dismissal of the opposition, and the Board denied consideration of the motion due to its untimeliness. Now, more than five months later, the Board sua sponte reopened applicant's testimony period in the opposition, thereby again rewarding applicant's dilatory conduct and affording applicant another opportunity to move for dismissal of the opposition. If applicant's original motion for dismissal was untimely when made five months ago, it is submitted that the Board erred in reopening applicant's testimony period in the opposition for the ostensible purpose of permitting applicant to again move for dismissal.

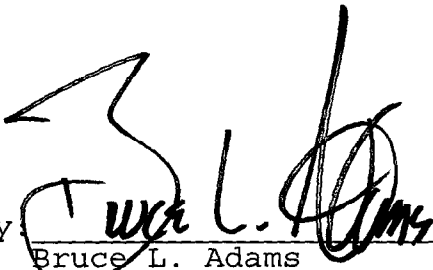
In reopening and resetting applicant's testimony period, the decision states that it is the practice of the Board to suspend proceedings pending the disposition of a motion to dismiss. However, that practice presupposes that the motion to dismiss is timely made, otherwise any party could at any time move to dismiss and thereby automatically obtain a suspension of proceedings. Clearly that is not the practice of the Board, and should not be the practice in this case.

Opposer respectfully submits that the Board erred in not granting opposer's motion for extension of its testimony period, and that the Board erred in reopening and resetting applicant's testimony period in the opposition. In view thereof, opposer respectfully requests that the decision be modified to grant opposer's motion for extension of its testimony period together with a resetting of the trial dates and, if opposer's motion for extension of its testimony period is not granted, that the Board's decision be modified to reset the trial dates in the counterclaim only.

Respectfully submitted,

Dated: New York, NY
May 20, 2002

By



Bruce L. Adams
ADAMS & WILKS
50 Broadway-31st Floor
New York, NY 10004
(212) 809-3700

Attorneys for Opposer
TED LAPIDUS

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing REQUEST FOR RECONSIDERATION OF BOARD'S DECISION MAILED APRIL 19, 2002 has been served by first class mail, postage prepaid, this 20th day of May, 2002, on applicant's counsel, by sending the same to the following address:

William S. Frommer, Esq.
Marilyn Matthes Brogan, Esq.
Frommer Lawrence & Haug LLP
745 Fifth Avenue
New York, NY 10151



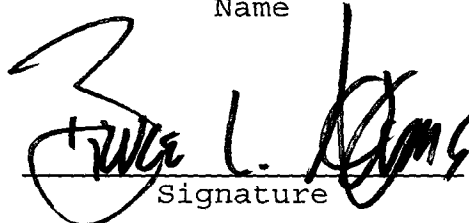
Bruce L. Adams

MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: UNITED STATES PATENT AND TRADEMARK OFFICE, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA 22202-3513, on the date indicated below.

Bruce L. Adams

Name



Signature

MAY 20, 2002

Date