UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

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Mailed: March 31, 2003

Opposition No. 116,606
Opposition No. 120,531
Opposition No. 120,533

Havana Club Holding, S.A.

v.

Havana Cola Inc.

Albert Zervas, Interlocutory Attorney

This consolidated case now comes up on opposer's motion (filed October 3, 2002) to extend the testimony periods. Applicant has opposed the motion in a combined response (filed October 10, 2002) and motion in the alternative for suspension "to allow time for Opposer to complete the process of responding to Applicant's December 20, 2001 discovery requests …."

In order to expedite a decision on the motions, the Board presumes familiarity with the contentions of each party and does not repeat them in this order.

To prevail on its motion, opposer must establish good cause for the requested extension of time. See Fed. R. Civ. P. 6(b)(1); TBMP § 509.01.

Based on the record in this case, it appears that opposer has not provided *any* documents or verified interrogatory answers in response to applicant's discovery requests, served on opposer on December 20, 2001.[1] Thus, over *one year and three months* has gone by and opposer has failed to produce "a single requested document, … a single interrogatory answer under oath, .. [or] even the documents and information to which no objections had been raised …." (Emphasis in the original.) It is difficult to imagine a case at the Board - which only involves the limited question of registration of a trademark, see Section 17 of the Trademark Act, and TBMP Section 102.01 - requiring over one year and three months for preparation of a response to document requests and answers to interrogatories.

Opposer attributes its delay in providing discovery to its attorneys' misfiling of applicant's letter of July 22, 2002,[2] which proposes that the parties "confer for the purpose of identifying all remaining areas of disagreement over Opposer's responses," to the circumstance that "its files and records are in three different places; Havana,

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[1] According to applicant, on January 24, 2002, opposer served unsworn responses to applicant's interrogatories and document requests. Also, "in addition to making a number or objections, Opposer repeatedly stated that it would provide the requested information and documents to the extent that they were revealed by a then 'ongoing search.'"

[2] It appears from the record that applicant's July 22, 2002 letter is its only communication regarding its discovery requests after the denial of its motion to compel on June 20, 2002, until opposer filed its motion to extend.

Cuba, Luxembourg and Paris, France"; and to "previously revealed geographical and political problems [which] continue to slow Applicant's [sic] efforts to make good on its promises to supply what it has promised to Applicant." Opposer adds that as of September, 2002, "the additional searches [for documents] were still proceeding, but continued to be hampered by lack of knowledge as to the whereabouts of certain documents that had been used in the Galleon trial; and that after locating the July 22, 2002 letter, opposer's attorney called applicant's attorney and "accepted the proposal therein to cooperate in good faith to expedite the transmittal to Applicant of all information and documents that Opposer can uncover that are responsive to applicant's requests, and to which objections were not made" and agreed to work with applicant "in a good faith effort to reformulate Applicant's requests to which objections were made so that responses can be made to them."

In view of the foregoing, the Board finds that opposer has just barely shown good cause for extending the testimony periods, and grants opposer's motion to extend. Applicant's motion in the alternative for suspension is hence denied.[3] The parties are allowed **thirty days** from the mailing date of

[3] As part of applicant's motion for suspension, applicant seeks leave to file another motion to compel. Because Trademark Rule 2.120(e) prohibits the filing of motions to compel after the first testimony period has commenced, and opposer's first

this order to -- in good faith -- reformulate applicant's requests to which objections were made so that responses can be made to them. If the parties do not reach an agreement on the reformulation of applicant's discovery requests within the time period allowed above, opposer is ordered to serve a verified response to applicant's interrogatories, to serve a signed response to applicant's document requests and to produce all responsive documents, subject to any valid objections, within **forty-five days** from the mailing date of this order.[4]

The testimony periods are reset as indicated below. 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.

DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close:	July 15, 2003
30-day testimony period for party in position of defendant to close:	September 13, 2003
15-day rebuttal testimony period to close:	October 28, 2003

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testimony period has already commenced, applicant's request for leave to file another motion to compel is denied.

[4] The parties are once again advised that if proper discoverable matter is withheld from the requesting party, then the responding party will be precluded from relying on such information and from adducing testimony with regard thereto during its testimony period. *See Shoe Factory Supplies Co. v. Thermal Engineering Company*, 207 USPQ 517 (TTAB 1980); and *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, at n.5 (TTAB 1988).

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