

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mail date: September 29, 2004

Opposition No. 91/121980
Cancellation No. 92/042251

Estefan Enterprises, Inc.

v.

Bongo, S.A. de C.V.

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

This case now comes up on defendant's fully briefed motion, filed June 18, 2004, to extend its time to respond to plaintiff's discovery requests, served April 30, 2004;¹ plaintiff's fully briefed motion, filed June 24, 2004, to compel responses to its discovery requests; and plaintiff's consented motion, filed August 26, 2004, to extend discovery and trial dates.

In support of its motion to extend its time to serve its discovery responses, defendant argues that the additional time is needed because the due date coincides with tourist season in Cancun, Mexico, where defendant is located; and the defendant relies on such tourist trade and cannot direct full resources to responding to the requests. In addition, applicant argues that

¹ The parties had already agreed to an initial extension until June 14, 2004. Applicant seeks an additional thirty days.

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there is some difficulty in communicating and sending documents due to language differences and technology differences.

In response, plaintiff argues that, after agreeing to an initial extension of time for defendant to serve responses, it was surprised that no responses at all were served. Plaintiff argues that it was willing to grant an additional fourteen-day extension if defendant would either assure plaintiff that the responses would be forthcoming at the expiration of the period or if defendant were serve responses immediately to those requests for which responses were easy to make. According to plaintiff, defendant would not agree to either alternative. In addition, plaintiff argues that this proceeding has been ongoing for three years and that defendant, thus, has had ample opportunity to organize documents and information relevant hereto; and that defendant's physical location in Mexico is not an excuse for communication problems in this day of fax, email and international overnight delivery services. Plaintiff seeks an order from the Board compelling defendant's discovery responses.

In reply, defendant argues that plaintiff's motion to compel is deficient in two respects. The first is that it is not accompanied by copies of plaintiff's discovery requests, which defendant acknowledges did accompany its own motion to extend. The second is that it is not accompanied by the statement of plaintiff's attorney that a good faith effort has been made to resolve the dispute.

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Preliminarily, when a party files a motion to compel, the Board will suspend proceedings with respect to all matters not germane to the motion. See Trademark Rule 2.120(e). In this case, then, proceedings are considered suspended since the filing of plaintiff's motion to compel on June 24, 2004. Thus, plaintiff's consented motion, filed August 26, 2004, is granted to the extent that it is encompassed by the suspension of proceedings. Upon resumption, *infra*, appropriate dates, including the close of discovery, will be reset.

Defendant is accurate in pointing out that plaintiff's motion to compel is technically deficient because it is not accompanied by copies of plaintiff's discovery requests in dispute. *Id.* However, in this case, defendant's objection is merely form over substance, and the deficiency is harmless. Plaintiff references such requests as its "Composite Exhibit A." Thus, it appears that submission of the requests was intended. More importantly, however, such requests are of record with defendant's motion to extend, which is related to plaintiff's motion to compel in that the discovery motion is combined as part of plaintiff's response to defendant's motion to extend.²

Defendant is also accurate in pointing out that plaintiff's motion to compel is technically deficient because it is not accompanied (or does not embody) a written statement from

² That is, the discovery requests are exhibits to the motion initiating all matters presently before the Board, and a search of the record is not necessitated.

plaintiff that it has made a good faith effort by conference or correspondence to resolve the dispute. *Id.* Plaintiff's recitation of circumstances, however, does indicate that plaintiff was willing to grant defendant an extension with some contingencies that defendant apparently felt it could not meet. Thus, some effort in good faith was made to resolve the dispute.³

Nonetheless, as discussed below, because defendant has shown good cause in support of its extension request, plaintiff's motion to compel is premature and will not be considered on its merits.

The standard for allowing an extension of a prescribed period prior to the expiration of that period is good cause. See Fed. R. Civ. P. 6(b)(1). Ordinarily, the Board is liberal in granting extensions of time before the period to act has elapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1316 (TTAB 1992).

While it is true that this proceeding has been pending for three years, plaintiff served its discovery requests on April 30, 2004, which first put defendant on notice of the nature and extent of the requests, and made service of responses due June 5,

³ In addition, plaintiff's attorney signed the motion, which included the circumstances, at least from plaintiff's point of view, regarding the effort made to resolve the dispute. The attorney's signature constitutes a certification of the elements specified in 37 C.F.R. §10.018(b).

2004. See Trademark Rule 2.119(c). Although the discovery requests *per se* do not appear to be particularly onerous, service of the requests, as explained by defendant, was during a season when it was not able to dedicate as much time and personnel to responding thereto. Plaintiff graciously granted an extension until June 14, 2004. However, defendant has requested additional time; there is no showing that defendant has been guilty of negligence or bad faith at this point; and defendant has not abused the privilege of extensions.⁴

Accordingly, for good faith shown, defendant's motion to extend its time to respond to plaintiff's discovery requests is granted. Defendant has now had plaintiff's discovery requests for over six months. In addition, the expiration of the thirty day extension sought by defendant initially was July 14, 2004. Thus, defendant has had ample time to prepare responses, and is allowed until **forty days** from the mailing date of this order to serve responses to plaintiff's discovery requests (served April 30, 2004).

A review of the docket entries, as viewed online, does not indicate that the parties have submitted a stipulated protective agreement for the exchange of confidential information and

⁴ However, the Board agrees with plaintiff that defendant's location in Cancun, Mexico, a tourist area, should not complicate sending documents and coordinating schedules, absent a showing of hardship, such as the production of thousands of documents. Technology and international services should equalize any disparities that may have existed in the past.

material, a common objection to discovery requests. The parties are allowed until **twenty days** from the mailing date of this order to enter into, and submit for the record, a mutually agreeable protective agreement, if they so desire and if they anticipate that objections to discovery requests based on confidentiality may be made. The parties are advised that the Board will impose its standardized protective order in the event any dispute arises over objections to discovery requests based on confidentiality.⁵

Discovery and trial dates are reset as indicated below:

THE PERIOD FOR DISCOVERY TO CLOSE:	January 15, 2005
30-day testimony period for party in position of plaintiff to close:	April 15, 2005
30-day testimony period for party in position of defendant to close:	June 14, 2005
15-day rebuttal testimony period to close:	July 29, 2005

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. Rule 2.125.

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

⁵ The parties may view the Board's standardize protective order on the USPTO's website at www.uspto.gov by clicking on the word "Trademarks," scrolling to "About TTAB," and selecting from under "Standard Documents and Guidelines."

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