

ORIGINAL

TTAB

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

DETROIT ENTERTAINMENT, LLC,

Opposer,

v.

MOTOR CITIES CASINOS, LLC,

Applicant.



12-23-2003

U.S. Patent & TMO's/TM Mail Rpt Dt. #22

Opposition No. 9,115,1905

**OPPOSER DETROIT ENTERTAINMENT'S
NOTICE OF APPEAL**

I, CRYSTAL MATTESON, DO HEREBY CERTIFY THAT THIS DOCUMENT IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS EXPRESS MAIL, POSTAGE PREPAID, IN AN ENVELOPE ADDRESSED TO THE ASSISTANT COMMISSIONER FOR TRADEMARKS, BOX TTAB, 2900 CRYSTAL DRIVE, ARLINGTON, VIRGINIA 22202-3513, ON THE DATE BELOW.

Crystal Matteson
AN EMPLOYEE OF QUIRK & TRATOS
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12/23/03
DATE OF DEPOSIT

Opposer, Detroit Entertainment, LLC, by and through its attorney, Mark G. Tratos of the law firm of Quirk & Tratos, hereby petitions the United States Court of Appeals for the Federal Circuit for review of the October 30, 2003 Decision of Administrative Trademark Judges Hohein, Chapman and Holtzman of the Trademark Trial and Appeal Board dismissing Opposer's case. Opposer seeks reinstatement of the matter before the Trademark Trial and Appeal Board. A copy of the October 30, 2003 Decision is attached hereto as Exhibit 1.

DATED: December 23, 2003.

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NOTICE OF APPEAL

CERTIFICATE OF SERVICE

I hereby certify that on December 23, 2003, I served the foregoing Notice of Appeal on:

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by causing a full, true, and correct copy thereof to be sent by the following indicated method or methods, on the date set forth below:

- by mailing in a sealed, first-class postage-prepaid envelope, addressed to the last-known office address of the attorney, and deposited with the United States Postal Service at Las Vegas, Nevada.
- by hand delivery.
- by sending via overnight courier in a sealed envelope.
- by faxing to the attorney at the fax number that is the last-known fax number.
- by electronic mail to the last known e-mail address.



An employee of Quirk & Tratos

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Trademark Trial and Appeal Board
2900 Crystal Drive
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Baxley

Mailed: October 30, 2003

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DETROIT ENTERTAINMENT, LLC

v.

MOTOR CITIES CASINOS LLC

Before Hohein, Chapman and Holtzman,
Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of applicant's motion (filed August 26, 2003) to dismiss for failure to prosecute under Trademark Rule 2.132(a); and opposer's motion (filed September 11, 2003) to reopen its testimony period. The motions have been fully briefed.

In support of its motion to dismiss for failure to prosecute, applicant notes that the Board, in an April 25, 2003 order, extended the closing date of opposer's testimony period to July 16, 2003, and contends that opposer's only action during its testimony period was to send to applicant's attorney a settlement offer on July 7, 2003; that the settlement offer did not operate to stay proceedings herein; and that, in the cover letter that accompanied the settlement offer, opposer's attorney

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specifically stated that the offer did not constitute a basis to suspend this proceeding. Inasmuch as opposer did not take any testimony or file any other evidence during its testimony period, applicant asks that the opposition be dismissed with prejudice pursuant to Trademark Rule 2.132(a).

In opposition to applicant's motion to dismiss and in support of its motion to reopen its testimony period, opposer contends that it has actively participated throughout this proceeding; that applicant did not provide full and complete responses to opposer's discovery requests; that opposer sought to resolve the parties' discovery dispute through discussion rather than by filing a motion to compel; that opposer's attorney docketed July 16, 2003 as the closing date of its testimony period; that applicant has failed to provide information and/or counteroffers in response to opposer's efforts to settle this case; that opposer's attorney forwarded its latest settlement offer to applicant's attorney on July 7, 2003; that, in response to the settlement offer, applicant's counsel indicated that he would forward the offer to applicant and asked that opposer's witnesses be made available for discovery depositions; and that, because of miscommunication between opposer and its attorney regarding moving forward in this case in the absence of settlement, opposer inadvertently

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allowed its testimony period to expire without taking testimony or filing other evidence. Accordingly, opposer contends that its failure to timely act was the result of excusable neglect. Opposer asks that the Board reopen its testimony period and accept the evidence submitted under the notice of reliance that it filed concurrently with its motion.

In reply and in opposition to applicant's motion to reopen, applicant contends that opposer has not shown that its failure to timely act was the result of excusable neglect. In particular, applicant contends that opposer has admitted to being aware of the closing date of its testimony period; and that opposer has failed to explain the nature of opposer's miscommunication with its own attorney. Accordingly, applicant asks that the Board deny opposer's motion to reopen testimony and dismiss this proceeding for failure to prosecute.

Under Trademark Rule 2.132(a), a plaintiff that has neither taken testimony nor filed any evidence during its testimony period must, upon filing of a motion to dismiss for failure to prosecute, show good and sufficient cause why judgment should not be rendered against it, failing which the proceeding will be dismissed with prejudice. The "good and sufficient cause" standard is equivalent to the "excusable neglect" standard which opposer is required to

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meet under Fed. R. Civ. P. 6(b) with regard to its motion to reopen its testimony period. See *Grobet File Co. of America Inc. v. Associated Distributors Inc.*, 12 USPQ2d 1649 (TTAB 1989).

In *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 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*, 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*, *supra* at footnote 7 and cases cited therein.

Turning initially to the third *Pioneer* factor, we find that opposer's failure to take appropriate action during its

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testimony period was wholly within its control.¹ Opposer's attorney admits to docketing July 16, 2003 as the closing date of its testimony period, and thus opposer was fully aware of the trial calendar herein. Further, the cover letter that opposer's attorney sent to applicant's attorney with the July 7, 2003 settlement offer specifically stated that the offer was not a basis for suspension of this proceeding. See *Atlanta-Fulton County Zoo Inc. v. DePalma*, 45 USPQ2d 1858 (TTAB 1998). Inasmuch as the parties had not reached settlement and had not moved to suspend or extend dates, this case continued apace, with dates continuing to run. However, opposer, despite its awareness of the trial calendar, allowed its testimony period to lapse. Although opposer alludes to miscommunication with its own attorney with regard to moving forward in the absence of a settlement, a plaintiff and its attorney share a duty to communicate with each other and to remain diligent in the prosecution of a case. See *CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300 (TTAB 1999). As such, the purported miscommunication between

¹ The fact that opposer had diligently pursued this proceeding prior to trial is irrelevant. Further, any issues relating to discovery should have been addressed in a motion to compel prior to the commencement of opposer's testimony period. See Trademark Rule 2.120(e)(1); and TBMP Sections 523.03 and 523.04 (2d ed. June 2003). Parties who continue to take discovery after the commencement of trial do so outside of the Trademark Rules of Practice and, therefore, act at their own risk.

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opposer and its own attorney at this crucial juncture of the proceeding does not entitle opposer to another day before the Board.

With regard to the second *Pioneer* factor, we find that the delay caused by opposer's inaction during its testimony period is significant because it has disrupted the orderly administration of this proceeding. In addition to the time between the close of opposer's testimony period and the filing of the motions decided herein, the calculation of the length of the delay in proceedings also must take into account the additional, unavoidable delay arising from the time required for briefing and deciding such motions. Furthermore, both the Board and the parties before it have an interest in minimizing the amount of the Board's time and resources expended on matters, such as the motions decided herein, which come before the Board solely as a result of opposer's failure to abide by a trial calendar which it admits to having docketed. See *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860 (TTAB 2002). The Board's interest in deterring such failure weighs against a finding of excusable neglect under the second *Pioneer* factor.

With regard to the first *Pioneer* factor, we find that there is no evidence of significant prejudice to applicant, and, with regard to the fourth *Pioneer* factor, we find that

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there is no evidence of bad faith on the part of opposer. On balance, however, we find that opposer's failure to timely act prior to the close of its testimony period was not the result of excusable neglect.

In view thereof, opposer's motion to reopen testimony periods is denied. As such, the notice of reliance that opposer filed with its motion to reopen its testimony period is untimely and is hereby *sua sponte* stricken.

Inasmuch as opposer failed to take any testimony or offer any other evidence during its testimony period, applicant's motion to dismiss under Trademark Rule 2.132(a) for opposer's failure to prosecute is hereby granted. Judgment is hereby entered against opposer under Trademark Rule 2.132(a), and the opposition is dismissed with prejudice.