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March 31, 2003

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U.S. Patent & TMOfc/TM Mail Rcpt Dt. #66

Box TTAB - NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Tan Pro, Inc. v. St. Louis Tan Company, Inc. - Trademark Opposition No. 91152594.

Dear Commissioner:

Enclosed herewith are St. Louis Tan Company, Inc.'s Opposition to Tan Pro, Inc.'s Motion to Extend Discovery Period and Declaration of Michael A. Thorne in support thereof, in regard to the above-referenced Opposition, and a return postcard to acknowledge receipt.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: BOX TTAB - NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on March 31, 2003.

Michael A. Thorne

Michael A. Thorne, Attorney for St. Louis Tan Company, Inc.

MAT/
Enclosures
File: 5003191-0011

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

In re Application Serial No. 76/235,824

TAN PRO, INC.,	)	
	)	
Opposer,	)	Opposition No. 91152594
	)	
v.	)	
	)	
ST. LOUIS TAN COMPANY, INC.	)	
	)	
Applicant.	)	
	)	

ST. LOUIS TAN COMPANY, INC.'S OPPOSITION TO TAN PRO, INC.'S MOTION TO EXTEND DISCOVERY PERIOD

Applicant St. Louis Tan Company, Inc. requests that Opposer's Motion to Extend Discovery Period be denied. Opposer has altogether failed to show that any good cause exists to extend the discovery period. Therefore, Opposer has provided the Trademark Trial and Appeal Board ("Board") with absolutely no grounds on which to grant its Motion.

Applicant agrees with Opposer that Federal Rule of Civil Procedure 6(b) is the correct standard for motions to extend a prescribed period prior to the expiration of that period. That standard is good cause. Fed. R. Civ. P. 6(b)(1); 37 CFR § 2.121 (a)(1). In addition, Applicant agrees with Opposer that "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 Prod., Inc. v. DowBrands, Inc.*, 22 USPQ2d 1313 (TTAB 1992).

But what Opposer fails to mention in its Motion is that it bears the burden of proof here, and must "state with particularity the grounds therefor, including ***detailed facts constituting***

good cause." Fed. R. Civ. P. 6(b); *SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372, 1375 (TTAB 2001) (emphasis added) (internal citation omitted). Not only has Opposer failed to meet its burden by stating with any kind of particularity facts constituting good cause, it has failed to set forth facts showing *any* cause for which the Board should grant its Motion. Moreover, Opposer's complete inaction until just days before the close of the discovery period demonstrates that Opposer has been guilty of negligence and bad faith, and that granting Opposer's Motion would allow Opposer to abuse the privilege of extension.

Opposer filed its Motion on the very last day of the discovery period. For this gross delay, Opposer offers no reason, justification, or excuse. In fact, Opposer only summarily states that it has not been guilty of negligence or bad faith and that it has not previously sought or been granted an extension. Motion at 1. Such conclusory, self-serving statements are a far cry from satisfying the applicable "good cause" standard and certainly do not amount to a statement of particular facts warranting an extension of the discovery period. "Cursory or conclusory allegations that are denied by the non-movant, and that are not otherwise supported by the record, will not constitute a showing of good cause." *Instr. SA, Inc. v. ASI Instr., Inc.*, 53 USPQ2d 1925, 1927 (TTAB 1999). Applicant denies that Opposer has made any allegations that constitute good cause for extending the discovery period and the record is devoid of any such statements by Opposer.

Opposer allowed more than six (6) months of the discovery period to pass without making any attempt to extend the discovery period or to arrange to depose Applicant. *See* Declaration of Michael A. Thorne ("Thorne Decl.") at ¶¶ 5-6, attached hereto as Exhibit A. Opposer simply idled for nearly the entire discovery period, then presumed that it could have the

discovery period extended at its whim. Again, these circumstances do not even come close to good cause for extending the discovery period.

In fact, it was not until March 4, 2003, only six (6) days before the close of the discovery period, that Opposer's counsel made any effort whatsoever to contact Applicant's counsel to seek consent for an extension. Thorne Decl. at ¶ 5. Even then, the only reason offered for extending the discovery period was that Opposer's wanted to depose Applicant with the benefit of having Applicant's discovery responses, which were not due until after discovery was closed. *Id.* at ¶ 5. Clearly, Opposer was well aware that the discovery requests it served on Applicant on February 14, 2003 would not be due until after the close of discovery when it served its requests. Opposer's delay should not be rewarded with the privilege of an extension. In considering Opposer's Motion, the Board should "**scrutinize whether good cause has been shown, *including the diligence of the moving party during the discovery period***." *Luemme, Inc. v. D.B. Plus Inc.,* 53 USPQ2d 1758, 1760 (TTAB 1999), *citing Miscellaneous Changes to Trademark Trial and Appeal Board Rules,* 63 Fed. Reg. at 48086, 1214 TMOG at 149 (emphasis added).

The case law on this subject is both replete and clear. The "Board has found that ***mere unexplained delay in initiating action in an affected time period does not constitute good cause."*** *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987) (emphasis added). Unexplained delay is the only thing that Opposer has offered the Board. Opposer has not stated that it made prior attempts to depose Applicant. Opposer has not stated that Applicant or its counsel have had some other extraordinary scheduling conflicts, about which they did not know until just days before the close of the discovery. In short, Opposer has offered nothing to substantiate good cause.

These circumstances are very similar to those in *Procyon Pharm. Inc. v. Procyon Biopharma, Inc.* in which the Board stated:

> Besides petitioner's failure to provide detailed information regarding apparent difficulty in preparing and submitting evidence, ***the record is devoid of any explanation as to why petitioner waited until the last day of its testimony period to request an extension***. ***Petitioner brought this cancellation proceeding and, thus, carries the burden of going forward in a timely manner.*** In the September 5, 2000 order, which was well in advance of the June 22, 2001 filing of petitioner's motion to extend, the Board clearly set forth petitioner's present testimony period (May 23-June 22, 2001). Petitioner had a duty to diligently plan how it would prove its case during that prescribed testimony period.

61 USPQ2d 1542, 1544 (TTAB 2001). Here too, Opposer brought this proceeding and thus carries the burden for going forward in a timely manner. Opposer should not be allowed to delay for nearly the entire discovery period and then complain that it now needs more time.

The point is this. Opposer brought this proceeding and has the responsibility for moving the case along according to the Board's schedule, not delaying the proceeding and dragging it out for no good reason. Opposer had months to plan its discovery, including both serving written discovery and taking depositions. In fact, Applicant notes that Opposer has assigned the responsibilities of this case to not only one, but to two attorneys. Certainly, between two competent attorneys, Opposer's discovery should have been accomplished during the prescribed time period.

Opposer could have requested to depose Applicant months ago, but it did not. Opposer could have served its written discovery months ago so it could have had the benefit of Applicant's responses prior to deposing Applicant, but it chose not to do so. Opposer had lots of time and lots of options to accomplish its desired discovery in the time prescribed by the Board, but it failed to so. Consequently, the Board's ruling in *Luehrmann* is particularly instructive here:

> ***A party may not wait until the waning days of the discovery period to serve his discovery requests or notices of deposition and then be heard to complain that he needs an extension of the discovery period in order to take additional discovery.*** Mere delay in initiating discovery does not constitute good cause for an extension of the discovery period. If a party believes that issues in a case are complex and may involve lengthy discovery, it is his responsibility to begin taking discovery early in the discovery period. ***To allow an extension for all purposes herein would be to reward petitioner for its delay in initiating discovery, a result which is to be discouraged.***

2 USPQ2d at 1305 (emphasis added).

Opposer has totally failed to show good cause for extending the discovery period. Applicant, and presumably the Board, has a legitimate interest in completing this proceeding according to schedule. If the good cause standard means anything, Applicant respectfully submits that Opposer's Motion must be denied.

Dated this 31st day of March, 2003.

Michael A. Thorne

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ATTORNEYS FOR APPLICANT

EXHIBIT A

Declaration of Michael A. Thorne (attached)

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

In re Application Serial No. 76/235,824

TAN PRO, INC.,	)	
	)	
Opposer,	)	Opposition No. 91152594
	)	
v.	)	
	)	
ST. LOUIS TAN COMPANY, INC.	)	
	)	
Applicant.	)	
	)	

DECLARATION OF MICHAEL A. THORNE

Comes now the undersigned, and having been first duly sworn, declares as follows:

1. My name is Michael A. Thorne. I am an attorney employed by Spencer Fane Britt & Browne, LLP, a Missouri Limited Liability Partnership, having business offices at 120 South Central Avenue, Fifth Floor, St. Louis, Missouri 63105 and 1000 Walnut Street, Suite 1400, Kansas City, Missouri 64106 (herein, "Spencer Fane").
2. Spencer Fane represents St. Louis Tan Company ("St. Louis") for trademark matters, including this Opposition Proceeding No. 91152594 ("Proceeding").
3. The Trademark Trial and Appeal Board ("Board") mailed the discovery schedule to the parties' counsel for this Proceeding on or about August 22, 2002.
4. According to the Board's schedule, the discovery period for this Proceeding closed on March 10, 2003.
5. On March 4, 2003, just six (6) days before the close of the discovery period, Melissa Cannady of the King & Spaulding firm and counsel for Opposer in

this Proceeding, contacted me by telephone and requested my consent to extend the discovery period. Ms. Cannady stated that she wanted to extend the discovery period so that Opposer could depose a representative of Applicant after Opposer received Applicant's responses to Opposer's discovery requests. Since Opposer did not serve its discovery requests until February 14, 2003, Applicant's responses to those requests were not due until after the discovery period closed, March 10, 2003. This is the only reason Ms. Cannady cited for her request to extend the discovery period.

6. At no other time during this Proceeding did Ms. Cannady or any other counsel for Opposer request to take Applicant's deposition or request any other extension of the discovery period. As stated above, the first and only request was made just six (6) days prior to the close of discovery.

The undersigned states that each declaration or representation of fact contained herein of which I have direct knowledge is true, correct, and accurate, that each statement or representation of fact contained herein of which I do not have direct knowledge is, to the best of my information and belief, believed to be true, accurate, and correct. I have been warned and am aware that willful false statements, misrepresentations, or omissions of material facts and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the Application and any Amendments thereto or any trademark or service mark registration resulting therefrom.

Michael A. Thorne

Michael A. Thorne, Attorney
SPENCER FANE BRITT & BROWNE LLP
120 South Central Avenue, Fifth Floor
St. Louis, Missouri 63105
Telephone: (314) 863-7733
Facsimile: (314) 862-4656

I, the undersigned, a Notary Public, certify that Michael A. Thorne, having appeared before me and having been first duly sworn, executed the Affidavit, on this 31st day of March, 2003.

IN WITNESS WHEREOF, I have hereunto subscribed my name and affixed my official seal on the day and year last above written.

Marilyn M. Heidotten

Notary Public
MARILYN M. HEIDOTTEN
St. Louis County
My Commission Expires
March 19, 2005

My commission expires:

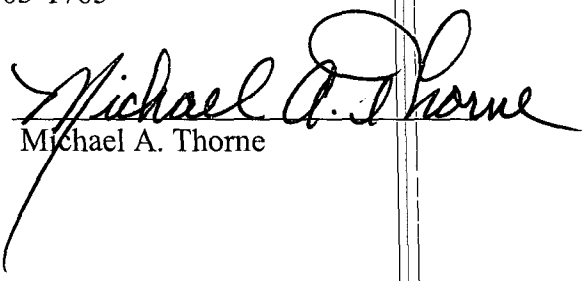
Notary Public Notary Seal State of Missouri

Dated this 31st day of March, 2003.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing St. Louis Tan Company, Inc.'s Opposition to Tan Pro, Inc.'s Motion to Extend Discovery Period was served on Opposer's counsel this 31st day of March, 2003, by first-class mail, U.S. postage prepaid, in an envelope addressed to:

Courtland L. Reichman
M. Melissa Cannady
King & Spalding LLP
191 Peachtree Street, N.E.
Atlanta, Georgia 30303-1763



Michael A. Thorne

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that Applicant's Opposition to Opposer's Motion to Extend Discovery and Declaration of Michael A. Thorne is being deposited with the United States Postal Service as first class mail in an envelope addressed to: BOX TTAB - NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on March 31, 2003.

Michael A. Thorne
Attorney for Applicant