

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: March 13, 2006

Opposition No. 91163527
Cancellation Nos. 92044091
92044257

YOSHIDA & COMPANY

v.

PORTER INTERNATIONAL CO., LTD.

Peter Cataldo, Attorney:

Proceedings Consolidated

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. See Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. See, for example, Wright & Miller, *Federal Practice and Procedure*: Civil 2d §2383 (1999); and *Lever Brothers Co. v. Shaklee Corp.*, 214 USPQ 654 (TTAB 1982). Consolidation is discretionary with the Board, and may be

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ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, for example, Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991).

Inasmuch as the parties to the instant proceedings are identical and the issues are substantially the same, Opposition No. 91163527 and Cancellation Nos. 92044091 and 92044257 are hereby consolidated.

The consolidated cases may be presented on the same record and briefs. *See Hilson Research Inc. v. Society for Human Resource Management, supra*; and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). The Board file will be maintained in Opposition No. 91163527 as the "parent" case. As a general rule, from this point on only a single copy of any paper or motion should be filed herein; but that copy should bear all three proceeding numbers in its caption.

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. *See Wright & Miller, Federal Practice and Procedure, supra*. The decision on the consolidated cases shall take into account any differences in the issues raised

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by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

In keeping with standard Board practice, the consolidated proceeding schedule is reset to that of the "youngest" of the consolidated cases, that is, Cancellation No. 92044257.

Motions to Extend

These consolidated cases now come before the Board for consideration of (1) defendant's motion (filed in each of the above-referenced proceedings prior to consolidation) for an extension of time to serve its responses to plaintiff's written discovery requests, and (2) plaintiff's cross motion (also filed in each of the above-referenced proceedings prior to consolidation) for an extension of time to serve its responses to defendant's written discovery requests. Both parties have filed briefs in opposition to the other's motion to extend.¹

The Board has carefully considered the arguments of both parties with regard to the above motions. However, an exhaustive review of those arguments would only serve to delay the Board's disposition of this matter.

¹ The Board is exercising its discretion to come to a determination on the parties' motions to extend prior to the expiration of their time in which to file reply briefs with regard thereto. Consideration of reply briefs is discretionary on the part of the Board. See Trademark Rule 2.127(a).

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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); TBMP §509 and the authorities cited therein. Ordinarily, the Board is liberal in granting extensions of time so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. See, e.g., *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313 (TTAB 1992); and *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147 (TTAB 1985).

The Board first turns to defendant's motions to extend, and finds that defendant has presented a credible argument that supports granting the requested extension. More particularly, during the relevant time period, it appears that the parties were attempting in good faith to negotiate a settlement of these matters. As both parties note in their respective motions to extend as well as their responses to each other's motions to extend, the parties have consented to several prior extensions for the specific purpose of facilitating ongoing settlement negotiations. Further, it appears that during the most recently reset deadline for the parties to exchange discovery responses, defendant forwarded to plaintiff a settlement proposal.

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Thus, defendant cannot be found to have been negligent in the discharge of its discovery obligations or its defense of these matters. Further, the additional requirements of translating the discovery requests for defendant, a foreign corporation, mitigate in favor of granting the requested extension.

Given the totality of circumstances regarding the parties' settlement negotiations and the necessity of translating plaintiff's discovery requests, the Board finds good cause for defendant's motions to extend. Moreover, the Board finds no evidence of bad faith on the part of defendant or prejudice to plaintiff. In that regard, the fact that both parties have requested extensions of time to respond to the other's discovery requests suggests an absence of prejudice to either that would result from granting the requested extensions. Nor do we find that defendant has abused its privilege of extensions.

In view thereof, defendant's motions to extend its time to respond to plaintiff's outstanding discovery requests are **granted**.

Turning to plaintiff's motions to extend, the Board notes that plaintiff's sole basis for seeking the requested extension is its desire to receive defendant's discovery responses prior to submitting its own responses to plaintiff's discovery requests. Plaintiff's arguments are

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not well taken. First, it is settled that discovery in proceedings before the Board is not governed by any concept of priority. Parties are under an obligation to respond to their adversary's requests for discovery during the time allowed therefore under the applicable rules, irrespective of the sequence of requests for discovery, or of an adversary's failure to respond to a pending request for discovery. See Fed. R. Civ. P. 26(d), and TBMP § 403.03 and the authorities cited therein. In this case, plaintiff asserts that it served its written discovery requests one week prior to defendant's service of its own discovery requests and thus is entitled to receive defendant's discovery responses one week prior to serving its own. However, plaintiff cites to no authority to support a finding that priority of the service of discovery requests constitutes good cause for an extension of a party's time to respond.

Second, plaintiff asserts in its motions to extend that it does not believe that further extensions of time are warranted with regard to the parties' discovery responses; but that its time to respond to defendant's discovery requests nonetheless should be extended until one week after defendant's responses are due, "whenever that may be." As such, plaintiff does not argue that good cause exists for granting its requested extension, but rather suggests that

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it does not. It is settled that a motion to extend must state with particularity the grounds upon which it is based, however, plaintiff's motions contain very little information upon which the Board could find good cause. See Fed. R. Civ. P. 6(b); *HKG Industries, Inc. v. Perma-Pipe, Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998); and *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n. 3 (TTAB 1989). Thus, the Board finds that plaintiff has failed to make a sufficient showing of good cause for granting the requested extension.

In view thereof, plaintiff's motions to extend its time to respond to defendant's outstanding discovery requests are **denied**.

Further, in light of the procedural history of these proceedings, the parties are advised that no further extensions of this nature will be permitted, in the absence of an agreement by the parties or a showing of unanticipated, extraordinary circumstances.

In view of the foregoing, defendant is allowed until thirty (30) days from the mailing date of this order to respond to plaintiff's outstanding written discovery requests. Plaintiff's discovery responses are due immediately, and in any event must be served upon defendant within seven (7) days from the mailing date of this order.

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Discovery Reminders

The parties are reminded that should information and documents responsive to the above interrogatories and document requests subsequently come to light, the parties are under a duty to seasonably supplement discovery responses pursuant to Fed. R. Civ. P. 26(e).

The parties are further reminded that as to information refused during discovery, the parties may be precluded from relying on such information and from adducing this testimony as evidence at trial. See TBMP § 527.05 and the authorities cited therein.

The Board expects each party and its attorney to cooperate in the discovery process and to make a good faith effort to satisfy the discovery needs of its adversary. See Fed. R. Civ. P. 26(g), *Sentrol, Inc. v. Sentex Systems, Inc.* 231 USPQ 666 (TTAB 1986), and *Johnson Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719 (TTAB 1989).

Trial Dates

As indicated above, trial dates, including the close of discovery, are reset in these consolidated proceedings to conform to the trial schedule as most recently set in Cancellation No. 92044257.