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

Mailed: April 6, 2009

Opposition No. 91170009

Suyen Corporation

v.

Americana International Limited

Opposition No. 91173139

Americana International Limited

v.

Suyen Corporation

Jennifer Krisp, Interlocutory Attorney:

These consolidated proceedings are before the Board for consideration of Suyen Corporation's[1] motion (filed February 5, 2009) to permit withdrawal of admissions under Fed. R. Civ. P. 36(b). The motion is fully briefed.

The Board may, upon its initiative and in its discretion, hear arguments on and/or resolve a motion filed in an inter partes proceeding by telephone conference. *See* Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (2d ed. rev. 2004). On April 3, 2009 the Board convened a telephone

[1] Because the parties are in reverse positions in these consolidated proceedings, they are herein referred to as "Suyen" (Suyen Corporation, opposer/plaintiff in Opposition No. 91170009 and applicant/defendant in Opposition No. 91173139), and "Americana" (Americana International Limited, applicant/defendant

conference to resolve the issue(s) presented in the motion. Participating were Lloyd S. Mann, Esq., counsel for Suyen, Faith D. Kasparian, Esq., counsel for Americana, and the assigned Interlocutory Attorney.

Analysis

Fed. R. Civ. P. 36(a) provides that a requested admission is deemed admitted unless a written answer or objection is provided to the requesting party within thirty days after service of the request. Such requests will stand admitted unless the nonresponding party is able to demonstrate that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b), and granted by the Board. *See* TBMP §§411.02 and 407.03(a)(2d ed. rev. 2004).

Pursuant to the parties' written agreement entered into via exchanges of email, Suyen's answers to Americana's First Set of Interrogatories, First Set of Requests for Production of Documents, and First Set of Requests for Admissions were due September 1, 2008. Inasmuch as verified responses to said discovery requests were not served until September 23, 2008, and inasmuch as Suyen has failed to demonstrate that its failure to timely respond was the result of excusable neglect, each of the requests for admissions served upon

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in Opposition No. 91170009 and opposer/plaintiff in Opposition No. 91173139).

Suyen are deemed admitted by operation of Fed. R. Civ. P. 36(a).[2] *See Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2064 n.1 (TTAB 1990).

On February 5, 2009, after trial had commenced, Suyen filed a motion, pursuant to Fed. R. Civ. P. 36(b), to permit withdrawal of its admissions. Under Fed. R. Civ. P. 36(b), applicable to the Board by operation of Trademark Rule 2.116(a), the Board may permit withdrawal or amendment of admissions "if it would promote the presentation of the merits of the action and if the court is not persuaded that it would prejudice the requesting party in maintaining or defending the action on the merits."

Emphasized throughout the Federal Rules of Civil Procedure is the importance of resolving actions on the merits whenever possible. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 (TTAB 1989). Consistent with the language in the rule, "withdrawal is at the discretion of the court." *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1308 (TTAB 2007) (citation omitted). "[T]he decision to allow a party to withdraw its admission is quintessentially an equitable one, balancing the rights to a full trial on the merits, including the presentation of all relevant evidence, with

[2] Furthermore, Suyen acknowledged that its responses to discovery requests were served late.

the necessity of justified reliance by parties on pre-trial procedures and finality as to issues deemed no longer in dispute." *Id.* (citation omitted).

Thus, the test for withdrawal or amendment of admissions is based on two prongs. The first prong of the test is satisfied "when upholding the admissions would practically eliminate any presentation of the merits of the case." *Id.* (citation omitted). In other words, the proposed withdrawal or amendments must "facilitate the development of the case in reaching the truth." *Id.* (citation omitted). Under the second prong, the court must examine whether withdrawal or amendment will prejudice the party that has obtained the admissions. As contemplated under Rule 36(b), "'prejudice' is not simply that the party who initially obtained the admission will now have to convince the fact finder of its truth, but rather, relates to the special difficulties a party may face caused by the sudden need to obtain evidence upon withdrawal or amendment of admission." *Id.* (citation omitted). "'Mere inconvenience' does not constitute 'prejudice.'" *Id.* (citation omitted). The test is whether that party is now any less able to obtain the evidence required to prove the matter which was admitted than it would have been at the time the admission was made. *Id.* (citation omitted).

With respect to the first prong, it is clear from the record that withdrawal of the admissions which resulted from Suyen's failure to timely respond would indeed allow for and promote the presentation of the merits of this case. Suyen's responses served on September 23, 2008 indicate that several previously admitted issues are in fact denied, and hence are factually in dispute in this case. In conference, Suyen noted the preclusive effect of its admissions of matter contained in Requests Nos. 36, 37 and 38, which request, respectively, whether consumers encountering Suyen's goods and services in connection with its BENCH mark are likely to believe that such goods are sponsored by Americana, are likely to believe that such goods and services are endorsed by Americana, and are reminded of Americana's BENCH marks. Verified responses to these as well as other requests for admissions go to the heart of the grounds of opposition and/or cancellation, are highly relevant, and will substantially aid in accurately setting forth the merits of these consolidated proceedings.

While the Board recognizes that Suyen failed to act diligently in not moving sooner for relief from its deemed admissions, the Board finds that upholding Suyen's responses as having been deemed admitted would undoubtedly prevent it from reaching a determination of the registrability of the marks at issue based on a careful consideration of sound arguments and properly adduced evidence.

Turning to the second prong of the test, timing is particularly relevant inasmuch as prejudice is more likely to be found when a motion under Fed. R. Civ. P. 36(b) is made during trial. *See Hadley v United States*, 45 F.3d 1345 (9th Cir. 1995). Under the circumstances, however, the Board finds minimal actual prejudice to Americana in allowing the withdrawal of Suyen's effective admissions and their replacement with the late-served responses, and finds that the potential prejudice asserted by Americana is nonspecific, undefined and speculative.

The record includes no indication of special difficulties Americana faces in presenting its case, the record includes no indication that the untimeliness of Suyen's motion has hindered Americana's ability to obtain witnesses or evidence, and during conference counsel for Americana did not indicate any particular witness, type of witness, evidence or type of evidence which is in fact no longer available or no longer reliable. Second, while it is recognized that Suyen failed to act with sufficient diligence in seeking withdrawal of the matters deemed admitted, Americana's assertion that it has been prejudiced because it has been precluded from testing the sufficiency of Suyen's discovery responses must be weighed against Americana's own failure, on more than one occasion far earlier in this proceeding, to either challenge discovery responses or to seek extensions of the commencement of trial in

order to preserve its ability to seek relief via a timely motion to compel discovery and/or motion to test sufficiency. While it would have been better practice for Suyen to have moved for withdrawal of its admissions in September 2008, or in November 2008 upon Americana's filing of its motion for summary judgment in reliance of said admissions, it is also significant that the far better practice for Americana, and what is in fact common practice, would have been to extend the commencement of trial, as needed, so as to preserve its ability to timely challenge Suyen's discovery responses under Trademark Rule 2.120, as appropriate. Americana's insistence that it relied on an August 4, 2008 email does not lead to the conclusion that it will now suffer actual and specific prejudice by withdrawal of Suyen's admissions.[3]

To continue, it is noted that mere inconvenience does not rise to the level of prejudice, *see Hadley, supra* at 1349, and that Americana's preparation and filing of a motion for summary judgment, albeit untimely, in reliance on matters having been deemed admitted does not constitute prejudice in this context. *See FDIC v. Prusia*, 18 F.3d 637 (8th Cir. 1994). Finally, the Board may mitigate actual prejudice, if any, by reopening discovery and/or resetting trial periods or remaining trial

[3] If a party that served a request for admission receives a response thereto which it believes to be inadequate, but fails to file a motion to test the sufficiency of the response, it may not thereafter be heard to complain about the sufficiency thereof. *See* TBMP § 524.04 (2d ed. rev. 2004).

periods in order to allow the requesting party to conduct follow-up discovery, if needed.

On balance, the Board finds that Suyen has met its burden with respect to its motion to withdraw.[4] In view thereof, the motion to permit withdrawal is hereby granted, and Suyen's responses, served on September 23, 2008, to Americana's Requests for Admissions are accepted.

Schedule

Discovery is reopened, for Americana only, for thirty (30) days from the mailing date of this order. The Board acknowledges that Suyen's first testimony period has passed.[5] Thereafter, remaining trial periods are hereby reset as indicated below:

Testimony period for **Americana** as defendant in Opp. 91170009 and as plaintiff in Opp. 91173139 to close:	7/10/2009
Testimony period for **Suyen** as defendant in Opp. 91173139, plaintiff in the counterclaim, and its rebuttal as plaintiff in Opp. 91170009 to close:	9/8/2009
Rebuttal testimony period for **Americana** as plaintiff in Opp.	

[4] The Board notes that the application of a more restrictive standard, as Americana suggests, would not alter the determination with respect to Suyen's motion to permit withdrawal.

[5] The Notice of Reliance filed by Suyen on October 27, 2008 is deemed to have been timely filed during its testimony period as previously reset, and need not be resubmitted.

91173139, and as defendant in the counterclaim to close: 11/7/2009

Rebuttal testimony period for **Suyen** as plaintiff in counterclaim to close: 12/22/2009

Briefs shall be due as follows: [See Trademark rule 2.128(a)(2)].

Brief for **Suyen** as plaintiff in Opp. 91170009 and defendant in Opp. 91173139 shall be due: 2/20/2010

Brief for **Americana** as defendant in Opp. 91170009 and plaintiff in Opp. 91173139 shall be due: 3/22/2010

Brief for **Suyen** as plaintiff in the counterclaim, and its reply brief (if any) as plaintiff in Opp. 91170009 shall be due: 4/21/2010

Reply brief (if any) for **Americana** as plaintiff in Opp. 91173139, and as defendant in the counterclaim shall be due: 5/6/2010

Reply brief (if any) for **Suyen** as plaintiff in the counterclaim shall be due: 5/21/2010

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.

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

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:
http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndaqmnt.htm