ESTTA Tracking number: **ESTTA151704**

Filing date: **07/18/2007**

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

Proceeding	91171203
Party	Plaintiff Melquiades Gonzalez Melquiades Gonzalez 929 SW 149 Court Miami, FL 33194 UNITED STATES
Correspondence Address	Jorge Espinosa, Esq. Kluger, Peretz, Kaplan & Berlin, P.L. 201 S. Biscayne Blvd., 17th Floor Miami, FL 33131 UNITED STATES trademarks@kpkb.com
Submission	Other Motions/Papers
Filer's Name	Jorge Espinosa
Filer's e-mail	trademarks@kpkb.com
Signature	/JorgeEspinosa/
Date	07/18/2007
Attachments	orishadiscoveryext.PDF (5 pages)(199308 bytes)

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

In re Application Serial No. 78/695,000
Filed on February 21, 2007
For the mark: ORISHA

Melquiades Gonzalez, Opposer, v. Augusto Ramon Lopez Lorenzo and Eva Maria Lopez Lorenzo, Applicant.	**AGREED MOTION OF THE PARTIES' TO REOPEN DISCOVERY AND FOR AN EXTENSION OF DEADLINES** Opposition No. 91171203

Opposer, Melquiades Gonzalez and Applicants Augusto Ramon Lopez Lorenzo and Eva Maria Loprez Lorenzo pursuant to Section 2.116(a) of the Rules of Practice in Trademark Cases and Rule 37 of the Federal Rules of Civil Procedure, hereby jointly move for the entry of an order reopening the discovery period in this matter, and extending such discovery period until 60 days after the Board adjudicates this motion, and then resetting the remaining deadlines, including the testimony periods, accordingly.

I. Overview

Fundamental fairness requires that the discovery period be reopened in this case because the Board granted an extension of time to respond to discovery to Applicant which expired after the start of the testimony period. Applicant and Opposer were discussing settlement and where unaware that the deadline was lapsing. Applicant wishes and intends to produce the discovery if the parties are not able to reach an agreement. However, the parties wish to continue to work together for an agreement without suffering prejudice.

Opposer is the owner of trademark registration 76/601,041 for the mark ORISHA for Cigars, cigarillos, smoking tobacco and related accessories. Applicant has filed an application No. 78/695,000 for the mark ORISHA for rum. Opposer considers the two classes of goods to share highly intermingled channels of trade which will inevitably cause consumer confusion. Opposer has therefore filed the current opposition.

On February 22, 2007, Opposer filed its first request for production, request for admissions and interrogatories. The discovery sought On March 26, 2007, Applicant filed a motion requesting a 60 day extension of time to respond to Opposer's interrogatories, requests for production and request for admissions. The Board granted the motion on April 30, 2007. This deadline overlapped the deadline for the start of the testimony period. The parties have been negotiating a resolution and wanted to avoid costs as well as motions incurring sanctions for failure to produce discovery or prejudice arising from the lapse of deadline.

II. Legal Standard

A motion to reopen discovery should be granted if a party demonstrates that its failure to act was the result of excusable neglect. See Pumpkin, Ltd. v. Seed Corps., 43 U.S.P.Q.2d 1582, 1586 (T.T.A.B. 1997) (citing Fed. R. Civ. P. 6(b), made applicable to Board proceedings by Trademark Rule 2.116(a)). The determination of whether a party's neglect is excusable is "at bottom an equitable one" based on a weighing of the following factors:

- The danger of prejudice to the nonmovant,
- The length of the delay and its potential impact on the judicial proceedings,
- The reason for the delay, and
- Whether the movant acted in good faith.

Id. at 1586 (citing Pioneer Inv. Services Co. v. Brunswick Assc. Ltd. P'ship, 507 U.S. 380, 395 (U.S. 1993)).

As stated below, each of the above identified factors weighs strongly in favor of the Board finding that there was excusable neglect.

III. Argument

A. Neither Party Will Be Prejudiced by the Board Granting this Motion.

The parties agree to this motion and represent that they will not be prejudiced. They were in the process of negotiations and wish to continue same.

B. The Parties have Not Delayed in Bringing this Motion.

The parties were under the impression that the Board had continued to discovery period AND all accompanying deadlines. The parties discovered that this was not the case on Friday 13, 2007, when Opposer spoke to the Board attorney regarding the course of the case. The parties immediately consulted and agreed to file this motion.

C. The Reasons For The Delay Are Clearly Excusable.

1. Undersigned Counsel Believed the Case Would be Suspended Pursuant to TBMP § 510.03

Pursuant to TBMP § 510.03, "when a party to a Board proceeding files a motion which is potentially dispositive of the proceeding, such as a motion to dismiss, a motion for judgment on the pleadings, or a motion for summary judgment, the case will be suspended by the Board with respect to all matters not germane to the motion." In binding authority, the Board has held that the filing of a potentially dispositive motion justified the parties ceasing activities unrelated to the motion:

> The filing of a potentially dispositive motion, such as the motion for judgment on the pleadings here, does not automatically suspend a case, inasmuch as proceedings are not suspended until the Board issues a suspension order.

> (Citations omitted.) However, since the parties are presumed to know that the filing of a potentially dispositive motion will result in a suspension order, the filing of such a motion generally will provide the parties with good cause to cease or defer activities unrelated to the briefing of such motions.

Leeds Tech., Ltd. v. Topaz Communications, Ltd., 2002 WL 1628149, * 3, 65 U.S.P.Q.2d 1303 (T.T.A.B 2002). Here, Life Assurance's Motion, if denied, would have been dispositive. Therefore, undersigned counsel reasonably believed that the Motion "provide[d] the parties with good cause to cease or defer activities unrelated to the briefing of" the Motion, and that after a suspension, the Board, as a matter of course, would reopen or extend its deadlines. The Board has previously held that an attorney's justifiable confusion about its obligations under a scheduling order constituted excusable neglect. See S. Indus., Inc. v. Lamb-Weston, Inc., 1997 TTAB Lexis 50, *10, 45 U.S.P.Q.2d 1293 (T.T.A.B. 1997).

Undersigned counsel respectfully submits that its reliance on TBMP § 510.03 constitutes excusable neglect.

2. Applicant's Counsel's Paralegal Failed to Alert Applicant's Counsel that the Discovery Deadline and Testimony Period deadlines were Approaching.

Applicant's counsel's paralegal failed to follow office procedure and alert Applicant's counsel that the discovery deadline had lapsed. If the paralegal had followed office procedure, as a precautionary measure, counsel may have filed a motion to suspend this proceeding or, in the alternative, to extend all deadlines. Counsel's paralegal's failure to follow office procedure coupled with counsel's misapprehension, that the Board would reset all deadlines if it granted the partie's submit that this lapse constitutes excusable neglect.

D. The Parties Acted in Good Faith

The record clearly establishes that the parties are acting in good faith and have been engaged in active negotiations. Moreover, this matter has never been placed on the back burner or been allowed to languish, by either party.

IV. Conclusion

For the foregoing reasons, the parties, jointly, respectfully request that the Board reopen the discovery period in this matter, extend such discovery period until ninety days after the Board adjudicates this motion, and reset the remaining deadlines, including the testimony periods, accordingly.

Respectfully submitted,

Applicants, Augusto Ramon Lopez
Lorenzo Eva Maria Lopez Lorenzo

By: _____

KLUGER, PERETZ, KAPLAN & BERLIN, P.L.
Attorneys for Opposer, Melquiades Gonzalez
201 South Biscayne Boulevard, 17th Floor
Miami, Florida 33131
Telephone: (305) 379-9000
Facsimile: (305) 379-3428

By: _____
JORGE ESPINOSA
Fla. Bar No. 779032
jespinosa@kpkb.com