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

Proceeding	91172725
Party	Plaintiff Acuity Brands, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial Nos.: 78/702,949
78/888,436
78/888,432

Acuity Brands, Inc.	)	
	)	
Opposer,	)	Opposition Nos.: 91172725
	)	91174816
v.	)	
	)	
Technical Consumer Products, Inc.	)	
	)	
Applicant.	)	
	)	

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

OPPOSER'S RESPONSE AND MEMORANDUM IN SUPPORT THEREOF TO APPLICANT'S MOTION TO REOPEN DISCOVERY AND FOR EXTENSION OF TIME TO SERVE RESPONSES

Opposer, Acuity Brands, Inc., hereby opposes the motion of Applicant, Technical Consumer Products, Inc. to reopen discovery (and for an extension of the testimony periods) and for an extension of time to serve responses to Opposer's outstanding discover requests. Applicant's motion should be denied. Applicant's decision to change counsel does not justify reopening of discovery or for the requested extensions. Opposer's new claims concerning fraud on the PTO and mis-marking by improper use of the federal registration symbol do not necessitate the reopening of discovery, nor does the assignment of the prior registration asserted by Opposer during the pendency of this proceeding. As for Applicant's request for

yet another extension of time to respond to Opposer's outstanding discovery requests, Applicant has already been given extensions and has had ample time to respond. Applicant should not be allowed to delay its responses further.

BACKGROUND

This consolidated opposition proceeding involves Opposer's opposition to Applicant's attempt to register various marks containing the term N:VISION for fluorescent lamps and incandescent lamps based on Opposer's prior mark and registration for ENVISION for electric lighting fixtures. On August 28, 2006, Opposer filed a timely Notice of Opposition against Applicant's first to publish application for N:VISION (Opposition No. 91172725). The discovery period for this proceeding was set to open on September 26, 2006 and to close on March 25, 2007. On December 26, 2006, Opposer filed a timely Notice of Opposition against Applicant's subsequently published applications for the slogans N:VISION EVERYTHING LIGHT TOUCHES and N:VISION A NEW SPIN ON (Opposition No. 91174816). The discovery period for this proceeding was set to open on January 15, 2007 and to close on July 14, 2007. On May 14, 2007, Opposer filed a Consented to Motion to Extend Discovery Dates and Testimony Periods in Opposition No. 91172725 so as to coordinate them with the discovery dates and testimony periods in Opposition No. 91174816. This consented to motion was filed because the two oppositions involved common factual issues and were likely to involve the same witnesses and because the coordination of the oppositions would allow these proceedings to proceed in a more orderly and efficient manner with a resulting cost savings to both parties. (Consented to Motion, page 2.) It also gave Applicant additional time to take discovery in the first opposition proceeding, which Applicant had not yet commenced.

The Board granted Opposer's consented to motion, consolidated the two opposition proceedings, and adopted the discovery and testimony schedules in the second opposition, No. 91174816. (Board's Order dated May 16, 2007).

During the coordinated discovery schedule, both parties took discovery on the issues raised by Opposer's Notices of Opposition and Applicant's answers thereto, including the issue of likelihood of confusion and Applicant's use of the subject marks. Opposer initiated its discovery requests on November 17, 2006 by serving interrogatories, document production requests, and requests for admission. Applicant, on the other hand, waited until June 15, 2007 to begin its discovery, and did so by serving on Opposer requests for admission and a set of interrogatories.

As a result of the responses received from Applicant to Opposer's discovery, Opposer filed a motion to amend its notices of opposition to add claims (1) that Applicant committed fraud on the PTO by falsely stating it used or intended to use its marks on incandescent lamps and (2) that Applicant improperly used the federal registration symbol in connection with its unregistered N:VISION mark. By its Order dated September 25, 2007, the Board granted Opposer's motion and allowed opposer until November 30, 2007 to take discovery on these limited issues. As permitted by the Board, Opposer served on Applicant a second set of discovery requests (interrogatories and document production requests) limited to the newly added claims. This second set of discovery requests was served by mail on Applicant's counsel, Mr. Joseph Taddeo, on November 6, 2007. On November 28, 2007, Mr. Taddeo called Opposer's counsel to request a two month extension to respond. Opposer's counsel agreed to a one month extension to serve its answers (but not its objections) provided

Applicant's counsel move the Board to extend the testimony periods by a similar one month period. Applicant filed this motion to extend on November 30, 2007, and the motion was granted.[1] Subsequently, on December 7, Mr. Taddeo, and Eileen Mathews of the firm of Benesch, Friedlander, Copland & Aronoff LLP contacted Opposer's counsel by telephone to advise that Applicant had engaged new counsel in this matter, and that the Benesch firm would be acting as counsel for Applicant. Ms. Mathews renewed the request for a 60 day extension of time to respond to Opposer's discovery requests; Applicant's counsel believed that 60 days was excessive but in view of the change of counsel agreed to an extension until January 15, 2008, which included an extension of the right to object.

ARGUMENT

When the time period for taking an action, such as discovery, has closed, a party moving to reopen such time period must show that its failure to act in the original time period resulted from excusable neglect. Fed. R. Civ. P. 6(b) (2007). A determination of whether a party's neglect is excusable involves consideration of (1) the prejudice to the non-moving party, (2) the length of delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was in the reasonable control of the moving party, and (4) whether the moving party has acted in good faith. *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380, 395 (1993), followed by *Pumpkin, Ltd. v. The Seeds Corps*, 43 USPQ2d 1582 (TTAB 1997). A motion to extend time must

[1] Applicant's motion also requested a one month extension of the November 30, 2007 discovery period, which was not discussed. On December 7, 2007, Opposer's counsel confirmed with Mr. Taddeo and Applicant's new counsel by email that this extension only applied to the discovery period granted by the Board's Order of September 25, 2007.

include more than mere conclusory allegations lacking factual detail, but rather must set forth with particularity the facts said to constitute good cause for the request. TBMP 509.01(a).

It is first noted that any failure of a former counsel to take an action does not constitute excusable neglect:

> [I]t is well settled that the client and the attorney share the duty to remain diligent in prosecuting or defending the client's case; that communication between the client and attorney is a two-way affair; and that action, inaction or even neglect by the client's chosen attorney will not excuse the inattention of the client so as to yield the client another day in court.

Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc., 59 USPQ2d 1369 (TTAB 2000), citing *CTRL Systems Inc. v. Ultraphonics of North American Inc.*, 52 USPQ2d 1300, 1302 (TTAB 1999). Thus, adding new counsel by itself should not constitute a justification for Applicant's requests.

Addressing the considerations for excusable neglect, Opposer would undoubtedly be prejudiced by the reopening of discovery. Opposer has already spent considerable time and resources responding to the discovery taken by Applicant during the once extended and now closed discovery period. To have to go through yet another round of discovery on the same issues would substantially and unduly add to Opposer's costs in prosecuting this action, both in terms of attorney's fees and management time .[2] It is also noted the Opposer's and Applicant's counsel arrived at an agreement to coordinate the discovery and testimony periods for the now

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[2] Contrary to the assertion at p. 5 of Applicant's Supporting Memorandum, Opposer's responses were not late. Applicant's discovery requests were served by mail and the responses were due July 19, 2007. Due to the number of interrogatories and admission requests and the time needed to gather the information in order to fully respond, Opposer requested and was granted a short extension to complete its responses. The responses were served on July 27, 2007, within the permitted short extension period.

consolidated opposition proceedings for the very purpose of streamlining these proceedings and minimizing costs to both sides. (Opposer's Consented to Motion of May 14, 2007, p.2.) Applicant's motion to now reopen discovery certainly undermines the purpose of that earlier consented to motion.

As to the length of time and reasons for delay factors, discovery has been closed for more the six months. Prior to the close of discovery, Applicant had ample opportunity to take whatever discovery it thought it needed, and did so by serving on Opposer lengthy requests for admission (31 Requests) and a lengthy set of interrogatories (34 Interrogatories) prior to the close of discovery. Applicant proffers no reasons for its delay and current attempt to reopen discovery on"old issues" other than change of counsel and conclusory statements that their request "would not impose undue delay" and that "the impact on these judicial proceedings would not be substantial." (Applicant's Supporting Memorandum, pp. 4-5.)

In further support of its request, Applicant contends that the recent assignment of Opposer's ENVISION trademark raises new discoverable issues.[3] Transfer of an asserted registration during the pendency of an opposition proceeding is governed by Rule 25(c) of the Federal Rules of Civil Procedure:

> If an interest is transferred, the action may be continued by or against the original party unless the court, on motion, orders the transferee to be substituted in the action or joined with the original party.

See also TMBP §512.01. Any decision by this Board in the instant proceeding will be binding

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[3] The transfer referred to by Applicant is an assignment of the registration asserted by Opposer to a related holding company called ABL IP Holding LLC. This Assignment was recorded with the Assignment Branch of the USPTO on October 11, 2007.

on Opposer's assignee. *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, n.1 (TTAB 1982). Thus, there are no new issues raised by this assignment warranting the reopening of discovery as requested by Applicant.[4] To the extent the Board feels that Application should be permitted discovery on this issue, the reopening of discovery should be limited to discovery on the assignment in question.

Similarly, the "New Claims" (fraud and improper use of registration symbol) included in Opposer's amended notices of opposition do not warrant the reopening of discovery. The facts relating to these New Claims all involve conduct by Applicant and are entirely within the possession of Applicant.

As to Applicant's request for yet another extension of time to respond to Opposer's pending discovery requests, from January 15, 2008 to February 15, 2008, Applicant has failed to set forth any facts that would justify the requested extension. Opposer's outstanding discovery requests were served in early November and Applicant's new counsel has been involved with this case since at least as early as December 7. Applicant counsel (former and present) have had ample opportunity to respond. The extension request should be denied.

In conclusion, for the reasons set forth above, it is respectfully requested that Applicant's motion to reopen discovery (and for an extension of the testimony periods) and for extension of time to serve responses be denied.

[SIGNATURE PAGE FOLLOWS]

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[4] Opposer will consent to the joinder of ABL IP Holding LLC in this proceeding if required by the Board.

Respectfully submitted,

Acuity Brands, Inc.

Dated: January 3, 2008

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **OPPOSER'S RESPONSE AND MEMORANDUM IN SUPPORT THEREOF TO APPLICANT'S MOTION TO REOPEN DISCOVERY AND FOR EXTENSION OF TIME TO SERVE RESPONSES** was served by United States First Class Mail, postage prepaid, on January 3, 2008, upon the following:

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