

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

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Mailed: May 12, 2010

Opposition No. 91191003

Itility, L.L.C.

v.

DynaSis Integrated Systems
Corp.

Before Walters, Grendel, and Bergsman,
Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of (1) applicant's motion (filed January 29, 2010) to reopen its time to serve responses to opposer's discovery requests¹ and (2) opposer's motion (filed January 29, 2010) for summary judgment based on applicant's admissions.

We first consider applicant's motion to reopen its time to serve discovery responses.

In support of its motion for leave to file responses to opposer's discovery requests, applicant asserts that while opposer sent applicant its first requests for the production of documents, first set of interrogatories, and requests for

¹ Opposer's supplemental brief in response (filed on March 11, 2010) is untimely and has been given no consideration. See Trademark Rule 2.127(a).

admission on November 10, 2009, applicant's counsel only received such requests on January 28, 2010;² that upon receipt of such requests, applicant's counsel immediately called opposer's counsel to inform him that the requests were received on January 28, 2010; that prior to January 28, 2010, applicant's attorney received no correspondence from opposer's counsel regarding the requests; and that "the interests of justice" support the relief sought in this instance because applicant's failure to timely respond to opposer's discovery requests was the result of excusable neglect.

In response, opposer argues that applicant did not respond to the discovery request by the December 15, 2010 due date; that applicant's motion does not include any declaration or affidavit evidence stating when opposer's discovery requests were actually received by applicant's counsel or explain the reason for the delay of the receipt, (e.g., the discovery was misplaced by counsel or the U.S. Postal Service lost the envelope with the requests); that the motion does not include copies of opposer's discovery requests with a date stamp acknowledging the date of receipt; that when applicant's counsel contacted opposer's counsel on January 28, 2010 to advise him that she had not

² Applicant's counsel indicates in the reply brief that she inadvertently stated that she received the requests on January 27, 2010 in the memorandum in support of the motion.

received the discovery requests until January 28, 2010, opposer's counsel inquired whether opposer's discovery was received "in counsel for applicant's office or mail room before that date" and applicant's counsel did not respond; that opposer's counsel further inquired if the requests were only delivered by the Post Office on January 28, 2010 or whether they were delivered earlier but only first seen by applicant's counsel on January 28, 2010; that opposer's counsel further advised that opposer would consider agreeing to applicant's proposed extension of time if applicant could provide a reasonable explanation for when the discovery was actually received in counsel's office and that the delay was the fault of the Post Office, but applicant's counsel "did not provide any further insight as to when Opposer's Discovery was actually received in applicant's counsel's office or why the discovery was not received at an earlier date."

In reply, applicant indicates that during the January 28, 2010 phone conference applicant's counsel advised opposer's counsel that she would investigate the reason for the delay and follow up with opposer's counsel the next day; that on the morning of January 29, 2010, applicant's counsel spoke to her office staff and was informed that opposer's discovery requests were indeed received on January 28, 2010 and forwarded to applicant's counsel on such date; that

applicant's counsel contacted the United States Postal Service to discuss the issue and was informed that it was possible that the mail was delayed but the postal service could not confirm the same because there was no tracking data available; that, thereafter, applicant's counsel contacted opposer's counsel to inform him of the results of her investigation and to make him aware of the filing of the present motion; that applicant believes the delay was caused by the postal service; that applicant did not delay in responding to opposer's discovery requests and promptly sought leave to rectify the matter and immediately served responses to opposer's requests for admissions on January 29, 2010. Applicant's counsel submitted a signed declaration in support of applicant's position with the brief in reply.

The Board may, in its discretion, permit a party to reopen an expired time period where the failure to act is due to excusable neglect. See Fed. R. Civ. P. 6(b). The Supreme Court has held that excusable neglect should be determined by considering the circumstances surrounding the omission. Such circumstances include (1) the prejudice to the non-moving party, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, and whether it was within the reasonable control of the movant, and (4) whether the moving party had acted in

good faith. *Pioneer Invest. Svcs. Co. v. Brunswick Assoc. Ltd. P'shp*, 507 U.S. 380, 395 (1993). See also *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997).

In evaluating excusable neglect in light of the factors set forth in *Pioneer*, and taking into account all relevant circumstances, the Board finds that applicant has demonstrated excusable neglect so as to justify the reopening of its time to serve its discovery responses.

In subsequent applications of this test, several courts have stated that the third *Pioneer* factor, namely the reason for the delay and whether it was within the reasonable control of the movant, might be considered the most important factor in a particular case. See *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d at 1586, n.7 and cases cited therein. The Board finds that applicant's failure to timely act was caused by the failure of the postal service to deliver opposer's requests in a timely manner. Although it is well settled that the proper mailing of a letter through the United States Postal Service creates a rebuttable presumption that the letter reached its destination and was actually received by the person to whom it was addressed, *Hagner v. United States*, 285 U.S. 427, 430, 76 L.Ed. 861, 52 S.Ct. 417 (1932), it is likely in these circumstances that the postal service did not deliver opposer's requests until January 28, 2010. Such delay was not within the reasonable control of applicant.

With regard to the first *Pioneer* factor, there is no evidence of prejudice to opposer. With regard to the second *Pioneer* factor we note that the delay is not significant and applicant acted swiftly in filing its motion. With regard to the fourth *Pioneer* factor, there is no evidence of any bad faith by applicant.

In view thereof, applicant's motion to reopen its time to file responses to opposer's discovery requests is hereby granted.³

In order to avoid a possible repeat situation, the parties are advised to consider stipulating to service by email. See Trademark Rule 2.119(b)(6).

We turn to consider opposer's motion for summary judgment in its favor on the likelihood of confusion claim.⁴ We note that in support of its motion, opposer relies on the position that there is no genuine issue of material fact in dispute and opposer is entitled to judgment as a matter of law because applicant did not timely respond to opposer's requests for admissions and, therefore, such admissions are deemed admitted under Fed. R. Civ. P. 36. Specifically, opposer argues that applicant admits there is a likelihood

³ We note, again, that applicant states that it served its responses to the requests for admissions on January 29, 2010. We further note that in its response to opposer's motion for summary judgment, applicant states that it served its responses to opposer's first set of requests for production of documents and opposer's first set of interrogatories on February 17, 2010.

of confusion between the parties' marks by way of its response to Request for Admission No. 5 which reads as follows:

Admit that there is a likelihood of confusion between applicant's trademark ITILITY for the services of: application service provider, namely, providing, hosting, managing, developing, and maintaining applications, software, web sites, and databases in the fields of personal productivity, wireless communication, mobile information access, wired Internet connectivity and remote data management for delivery of content to desktops, thin clients, handheld computers, laptops and mobile electronic devices and opposer's trademark ITILITY for business management and consultation and consulting in the field of information technology, assuming each party uses their respective trademark in United States commerce.

Because we have granted applicant's motion to reopen and because opposer has not established, based on the evidence present, that there is an absence of genuine issues of material fact as to its pleaded ground, opposer's motion for summary judgment on Section 2(d) claim is denied. Furthermore, the issue of likelihood of confusion is a question of law which the Board decides based on all the facts in evidence. We are not bound by a response to a request for admission regarding a question of law.

⁴ We find that full briefing on the motion for summary judgment is unnecessary in view of our decision on applicant's motion to reopen.

In view thereof, opposer's motion for summary judgment is hereby denied.⁵

Proceedings herein are resumed. Dates are reset as follows:

Expert Disclosures Due ⁶	6/11/2010
Discovery Closes	7/11/2010
Plaintiff's Pretrial Disclosures	8/25/2010
Plaintiff's 30-day Trial Period Ends	10/9/2010
Defendant's Pretrial Disclosures	10/24/2010
Defendant's 30-day Trial Period Ends	12/8/2010
Plaintiff's Rebuttal Disclosures	12/23/2010
Plaintiff's 15-day Rebuttal Period Ends	1/22/2011

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.

⁵ The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of the motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

⁶ Proceedings were suspended on January 29, 2010. Opposer's motion (filed February 16, 2010) to extend the time to serve expert disclosures is moot.