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

77,699,474

EJW

Mailed: May 13, 2013

Opposition No. 91196425

Demand Media, Inc.

v.

Global Media Arts and Global Digital LLC

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

This case now comes up for consideration of applicants' fully briefed motion (filed April 5, 2012) to "extend" the time to respond to opposer's motions (filed March 14, 2012) to amend its pleading, to test the sufficiency of applicants' responses to certain requests for admissions, and for sanctions. Also considered is applicants' motion filed on March 6, 2012.[1]

Applicants' Contested Motion to "Extend Time"

Opposer filed its motions to amend, to test the sufficiency of applicants' responses to requests for

[1] The Board's delay in addressing these matters is regretted.

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admissions, and for sanctions on March 14, 2012.[2] In view thereof, applicants' responses to said motions were due no later than April 3, 2012. *See* Trademark Rule 2.127(a). However, applicants' motion to extend time was not filed until April 5, 2012. Inasmuch as said motion was filed subsequent to the date on which responsive briefs were due, the Board must determine whether applicants' failure to submit timely responsive briefs was the result of excusable neglect. *See* Fed. R. Civ. P. 6(b) (When an act is to be done within a specified time, the Court may "upon motion made after the expiration of the specified period permit the act to be done where the failure to act was the result of excusable neglect"). *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1852 (TTAB 2000) ("Pursuant to Fed. R. Civ. P. 6(b)(2), the requisite showing for reopening an expired period is that of excusable neglect."). The relevant case which addresses the excusable neglect standard is *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997).

[2] The Board notes opposer's certificate of filing with its paper "motion to determine the sufficiency of applicants' response to requests for admission," stating that said motion was mailed to the Board on March 14, 2012. It is also noted that applicants were served with copies of all three motions on the same date.

In *Pioneer*, the Supreme Court stated that the determination of excusable neglect is at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith. *Pioneer*, 507 U.S. at 395. The Board has also noted that several courts have held that the third *Pioneer* factor, *i.e.*, "the reason for the delay, including whether it was within the reasonable control of the movant," may be deemed to be the most important of the *Pioneer* factors in a particular case. *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d at 1586 n.7. *See also S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1296 (TTAB 1997).

Applicants do not address the four factors set forth in *Pioneer* in their motion. Nonetheless, the Board shall consider in turn each factor with respect to applicants' submission.

Applying *Pioneer* to the present case, in regard to the first *Pioneer* factor, there does not appear to be any measurable prejudice to opposer should the Board reopen applicants' time to submit responses to opposer's motions. Mere passage of time is not considered prejudicial, and

opposer has not indicated in its response to applicants' submission that it would be prejudiced, such as through lost evidence or unavailable witnesses. *See Pratt v. Philbrook*, 109 F.3d 18, 22 (1st Cir. 1997); and *Paolo's Associates Ltd. Partnership v. Paolo Bodo*, 21 USPQ2d 1899, 1904 (Comm'r 1990). In view thereof, the first *Pioneer* factor weighs in favor of applicant.

As to the second *Pioneer* factor, the Board must evaluate the total length of the delay incurred as a result of applicants' failure to respond in a timely manner to opposer's motions, including the time for the Board to consider the instant motion. *See, e.g., Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1702-1703 (TTAB 2002); and *PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860, 1862 (TTAB 2002). In short, the Board must consider the potential impact of applicants' delay on the proceedings.

Here, applicants filed the subject motion to extend time to respond two days after responses were due to opposer's motions. In addition, should the Board grant applicants' effective motion to reopen the time to respond to opposer's motions, the proceeding would be delayed another thirty days to allow time for filing the responses, and another fifteen days to allow opposer to file its reply briefs. Further, the Board has had to consider here whether

applicants' failure to submit a timely response to opposer's motions constitutes excusable neglect. In view of the foregoing, notwithstanding the Board's delay in addressing the subject motions, the Board finds that the time delay caused by applicants' delay is not significant, and concludes that the second *Pioneer* factor for finding excusable neglect weighs in favor of applicant.

The Board turns now to the third *Pioneer* factor, namely, the reason for the delay, including whether it was within the reasonable control of applicant. Critically, in *Pumpkin Ltd. v. The Seed Corps*, *supra*, 43 USPQ2d at 1586 n.7, the Board noted that several courts have held that the third *Pioneer* factor, *i.e.*, "the reason for the delay, including whether it was within the reasonable control of the movant," may be deemed to be the most important of the *Pioneer* factors in a particular case. *See also S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1296 (TTAB 1997).

Applicants have provided no reasons as to why they did not respond to opposer's motions or file a request for an extension of time to file responses in a timely fashion. Applicants state only that they seek a thirty-day extension for the purpose of seeking the advice of legal counsel in order to respond to opposer's motions.

In view of the standard discussed in *Pioneer*, the Board

finds that the circumstance mentioned by applicants in the subject motion does not constitute excusable neglect. In particular, it was within applicants' reasonable control to promptly file a motion to extend the time to respond to opposer's motions. Notably, applicants were certainly capable of and did file a "motion to dismiss" on March 6, 2012, approximately one week prior to the filing of opposer's motions, without the assistance of counsel. Simply put, applicants' failure to timely submit a response to opposer's motions was in applicants' reasonable control. *See Old Nutfield Brewing Co.*, 65 USPQ2d at 1704 ("… the delay was entirely avoidable by the exercise of reasonable diligence, and was entirely within the control of opposer"). Further, all parties are expected to adhere to applicable Board rules and Federal Rules of Civil Procedure regardless of whether they are represented by counsel. For these reasons, the third *Pioneer* factor weighs heavily against applicant. *See DC Comics and Marvel Characters Inc. v. Margo*, 68 USPQ2d 1319 (TTAB 2003).

Regarding the fourth *Pioneer* factor, there is evidence of record that applicants' failure to timely respond to opposer's motions and request for time to hire counsel was made in bad faith. The Board notes in particular that, notwithstanding the Board's admonition to applicants in its August 19, 2011 order to not file any further meritless

motions and communications (see 8/19/2011 order at 14), applicants filed on March 6, 2012, another meritless and nonsensical motion entitled "motion to dismiss," in which applicants appear to seek to argue, *inter alia*, the merits of opposer's claim and applicants' defenses, including the unclean hands defense which was stricken by the Board in the above-referenced order. Further, the motion contains, *inter alia*, inflammatory allegations involving opposer's former counsel, and a request to modify the parties' protective order so that documents may be released to the SEC and the FBI. These accusations, rambling arguments, and requests are either untimely, without merit, and/or are unrelated to a Board proceeding, and amount to a tantrum. The filing of said motion belies the sincerity of applicants' stated desire (in the motion to extend time) to retain counsel to assist applicants with their responses to opposer's motions.[3] Thus, the fourth factor also weighs heavily against applicant.

After considering the *Pioneer* factors and the relevant circumstances in this case, and in the exercise of its discretion, insofar as the third and fourth *Pioneer* factors weigh heavily against applicant, the Board finds that applicants have failed to show excusable neglect in support

[3] Notably, an appearance of counsel on behalf of applicants has not been submitted since the filing of applicants' motion to extend time, over one year ago.

of their effective motion to reopen the time to respond to opposer's motions. Accordingly, applicants' motion to reopen the time to respond to opposer's motion is **denied**. Fed. R. Civ. P. 6(b).

Opposer's Uncontested Motions

Insofar as applicants failed to submit timely responses to opposer's motions and failed to establish excusable neglect for their failure to so respond, opposer's motions are granted as conceded to the extent discussed below. *See* Trademark Rule 2.127(a).

- ***Motion to Amend Notice of Opposition***

Opposer requests leave to amend its notice of opposition to delete the reference to its pleaded registration which was cancelled under Section 8 of the Trademark Act. Fed. R. Civ. P. 15(a) provides, in relevant part, that once a responsive pleading is filed, a party may amend its pleading only by leave of the court or by written consent of the adverse party. Opposer's motion to amend its pleading to delete reference to the now-cancelled registration is granted as conceded. *See* Trademark Rule 2.127(a). *See also* TBMP § 507.02 (3d ed. rev. 2012). *Cf. Huffy Corp. v. Geoffrey, Inc.*, 18 USPQ2d 1240 (Comm'r 1990) (opposer's motion to amend to join party and claim ownership of registration granted).

Accordingly, opposer is allowed until **FIFTEEN DAYS** from the mailing date of this order to file with the Board an executed copy of the amended pleading that was attached to its motion.

- ***Motion to Test the Sufficiency of Applicants' Responses to Opposer's Requests for Admission***

Opposer requests that in view of applicants' lack of response to opposer's requests for admission nos. 15 and 16, and evasive responses to requests nos. 21, 29, 52, and 55, that said requests for admission be deemed admitted.

To determine whether applicants' responses are sufficient, the Board must consider whether they comply with the requirements of Federal Rule 36(a)(4), which is applicable to this proceeding under Trademark Rule 2.116(a). Federal Rule 36(a)(4) requires that the answering party admit or deny the matter set forth in the requests for admission, or detail the reasons why the party can do neither. Rule 36(a)(4) also specifically provides that "[t]he answering party may assert lack of knowledge or information as a reason for failing to admit or deny only if the party states that it has made reasonable inquiry and that the information it knows or can readily obtain is insufficient to enable it to admit or deny." Further, if the responding party fails to respond to the propounded requests for admission and has failed to file a motion to

amend or withdraw those admissions, by operation of Federal Rule 36(a), the requests are deemed admitted. *See* Fed. R. Civ. P. 6(b) and 36(a); TBMP § 525 (3d ed. rev. 2012). *See also Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064 (TTAB 1990) (if a party upon whom requests for admission have been served fails to timely respond thereto, the requests will stand admitted unless the party is able to show 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 Federal Rule 36(b), and granted by the Board).

In the first instance, because applicants failed to respond to request nos. 15 and 16, those responses are deemed admitted by operation of Rule 36(a). Fed. R. Civ. P. 36(a); Trademark Rule 2.116(a). With respect to requests for admission nos. 21, 39, 52, and 55, insofar as applicants responded to those requests with evasive responses, rather than admitting or denying those requests, the Board finds applicants' responses to those requests to be unresponsive and insufficient. Accordingly, applicants are hereby **ORDERED** to serve on opposer's counsel proper answers to opposer's requests for admission nos. 21, 39, 52, and 55, and are allowed until **THIRTY DAYS** from the mailing date of this order to do so, failing which all four requests shall be deemed admitted. To be clear, the proper answer to the

above-referenced requests for admission is either, "admit," "deny," *or* applicants must state in detail why they cannot truthfully admit or deny any particular request and state that "applicants have made a reasonable inquiry and information applicants know or can readily obtain is insufficient to enable applicants to admit or deny." Fed. R. Civ. P. 36(a)(4).

- ***Motion for Sanctions***

Opposer requests that the Board grant judgment in its favor in view of applicants' overall dilatory conduct and failure to respond to opposer's requests for production of documents pursuant to the Board's August 19, 2011, order, which allowed applicants until a date certain to respond to said discovery. Alternatively, opposer requests that applicants be prohibited from introducing at trial any documents which should have been produced in response to the Board's August 19, 2011 order.

Under Trademark Rule 2.120(g)(1), if a party fails to comply with a Board order compelling discovery, the Board may order appropriate sanctions as defined in that rule and in Fed. R. Civ. P. 37(b)(2), including entry of judgment. See *MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG*, 59 USPQ2d 1477 (TTAB 2000); TBMP Section 527.01(a) (3d ed. rev. 2012). The sanctions which may be entered by the Board pursuant to Rule 2.120(g)(1) include striking all or

part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party. *See* TBMP § 527.01(a) (3d ed. rev. 2012). *HighBeam Marketing, LLC v. Highbeam Research, LLC*, 85 USPQ2d 1902, 1904 (TTAB 2008). Further, to the extent there is any question about the Board's reliance on Trademark Rule 2.120(g)(1), the Board may also rely on its inherent authority. *See Central Mfg. Inc. v. Third Millennium Technology, Inc.*, 61 USPQ2d 1210 (TTAB 2001) (sanctions imposed under Board's inherent authority), *cited in Highbeam*, 85 USPQ2d at 1907.

Here, opposer's motion for sanctions under Trademark Rule 2.120(g)(1) is premature insofar as the Board's August 19, 2011 order did not *compel* production of documents from applicants. *See, e.g., Kairos Institute of Sound Healing LLC v. Doolittle Gardens LLC*, 88 USPQ2d 1541, 1543 (TTAB 2008) (sanction of dismissal denied as premature when no Board order compelling discovery present); and *Nobelle.com LLC v. Qwest Communications Int'l Inc.*, 66 USPQ2d 1300, 1303 (TTAB 2003) (trial evidence not stricken as discovery sanctions when no order to compel discovery had been violated). Rather, in view of the withdrawal of applicants' counsel after opposer's discovery was served,

the Board denied opposer's motion to compel and set forth instead a scheduling order, requiring applicants to respond to opposer's interrogatories and produce their responses to opposer's requests for production of documents by a date certain (see order at 9, 17).

Nonetheless, the Board finds it appropriate to sanction applicants' conduct under the Board's inherent authority to manage its own docket as applicants' failure to respond to opposer's discovery in the first instance, failure to follow the Board's scheduling order to respond to said discovery requests, and submission of meritless motions have greatly delayed this proceeding. *See Carrini, Inc. v. Carla Carini S.R.L.*, 57 USQP2d 1067 (TTAB 2000) (The Board has the inherent authority to schedule the disposition of cases on its own docket); and *Optician's Ass'n of America v. Independent Opticians of America, Inc.*, 734 F.Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990).

In view of the foregoing, applicants are sanctioned as follows: (1) applicants are prohibited from filing *any* motions or submissions with the Board without first obtaining the written authorization of the Board to make any such filing;[4] (2) applicants are required to respond

[4] Applicants must contact the assigned Interlocutory Attorney to request an *inter partes* conference in order to discuss any proposed motion or filing and the rationale for filing any such document. The Interlocutory Attorney may be contacted at the following telephone number: 571-272-9240.

completely to all of opposer's requests for production of documents[5] *without objection* and to copy said documents and materials and mail them to opposer's counsel by overnight courier at applicants' expense, and are allowed until **THIRTY DAYS** from the mailing date of this order to do so; and (3) applicants may not introduce at trial on *any* documents or other materials which they should have produced to opposer in accordance with the Board's August 19, 2011 order. Further, (4) if applicants do not have responsive documents to any of opposer's requests for production of documents, applicants must explicitly state that "no responsive documents exists." SHOULD APPLICANTS NOT ADHERE TO ANY OF THE BOARD'S ORDERS HEREIN, THE BOARD MAY ENTER JUDGMENT AGAINST APPLICANTS AND SUSTAIN THE OPPOSITION.

Scheduling Order; Proceeding Resumed; Trial Dates Reset

As discussed, applicants are allowed until **THIRTY DAYS** from the mailing date of this order (1) to serve on opposer's counsel adequate responses to the four designated requests for admission (served on April 21, 2011), and (2) to serve complete responses and documents or materials in response to opposer's requests for production of documents (served on February 7, 2011); and opposer is allowed until

[5] This is an order compelling production of documents and is not merely a scheduling order.

FIFTEEN DAYS from the mailing date of this order to submit an executed amended notice of opposition.

Additionally, applicants are allowed until **THIRTY DAYS** from the mailing date of this order to file an amended answer to the amended notice of opposition.

This proceeding is **resumed**. Trial dates are reset as set forth in the following schedule:[6]

Applicants' Discovery Responses and Amended Answer is Due	6/12/2013
Plaintiff's Pretrial Disclosures Due	7/27/2013
Plaintiff's 30-day Trial Period Ends	9/10/2013
Defendant's Pretrial Disclosures Due	9/25/2013
Defendant's 30-day Trial Period Ends	11/9/2013
Plaintiff's Rebuttal Disclosures Due	11/24/2013
Plaintiff's 15-day Rebuttal Period Ends	12/24/2013

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. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

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[6] Insofar as only one day remained in the discovery period when opposer's motions were filed, the Board deems the discovery period closed.

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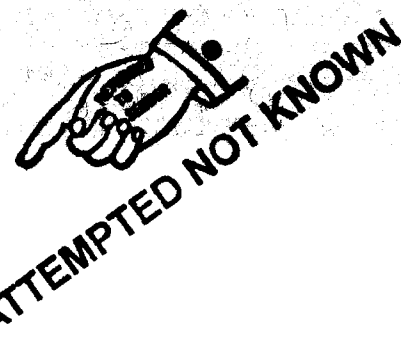
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