

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

EJW

Mailed: September 19, 2013

Opposition No. 91197266 (parent)
Opposition No. 91197267

Classic Ink, Inc.

v.

Jacksonville Sports
Group, LLC

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

These consolidated cases now come upon on applicant's motion (filed May 30, 2013) for sanctions; and opposer's motion (filed May 31, 2013) to extend time to serve its supplemental discovery responses.¹ Both motions are fully briefed.

By way of background, in its order dated April 5, 2013, the Board granted in part applicant's motion to compel, and allowed opposer thirty days to supplement opposer's responses to applicant's interrogatories and requests for production of documents and things. Additionally, opposer

¹ Applicant's consented motion (filed on May 31, 2013) to extend the discovery period is granted. See Trademark Rule 2.127(a). In view thereof, applicant's uncontested motion (also filed May 31, 2013) to extend its discovery period shall be given no further consideration. Trial dates shall be set accordingly at the conclusion of this order.

was advised that should it not comply with the requirements of the order, opposer may be subject to sanctions, potentially including entry of judgment against it (order at 22). The Board also cautioned opposer that "any indication of further document dumps or persistence in its game of 'hide the ball' will not be tolerated" (*Id.*). In accordance with said order, the deadline for opposer to provide its supplementary responses to applicant was May 5, 2013. Applicant has filed the instant motion for sanctions in view of opposer's failure to timely serve its supplementary responses. Inasmuch as the Board's decision with respect to applicant's motion to extend its time to respond to the Board's previous order may affect the decision on the motion for sanctions, the Board turns first to applicant's motion.

Opposer's Motion to Extend Time

Opposer requests that the Board extend its time to respond to the Board's April 5, 2013 order until June 14, 2013. As a threshold matter, insofar as opposer's motion was filed after the deadline for responding to the Board's order, namely, May 5, 2013, the Board treats opposer's motion as one seeking to reopen the period in which to respond to said order. 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"). Accordingly, the appropriate standard for considering opposer's motion is whether opposer has shown excusable neglect for its failure to timely respond to the Board's order.

In *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), the Supreme Court stated that a 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. In *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), 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).

Opposer does not address in its motion the excusable neglect standard discussed in *Pioneer*. Nonetheless, the

Board shall consider in turn each *Pioneer* factor with respect to applicant's motion.

In regard to the first *Pioneer* factor, there does not appear to be any measurable prejudice to applicant should the Board reopen opposer's time to serve its supplementary responses. Here, applicant states that it has no knowledge of the availability of opposer's witnesses or spoliation of evidence in this case. Regarding the fourth *Pioneer* factor, there is no evidence of record that opposer's failure to timely respond to the Board's order was the result of bad faith. Thus, the first and fourth factors weigh in favor of opposer.

As to the second *Pioneer* factor, the Board must evaluate the total length of the delay incurred as a result of opposer's failure to respond in a timely manner to the Board's order, 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 opposer's delay on the proceeding.

Here, opposer filed its motion to extend time three days after learning from applicant that the Board had issued an order requiring opposer to serve supplementary responses

on applicant, that is, less than four weeks after it was required to supplement its responses. In addition, the Board is considering the instant motions less than three months from the time the motions were fully briefed. In view of the foregoing, the Board finds that the time delay caused by opposer's failure to timely respond to the Board's order is relatively insignificant, and concludes that the second *Pioneer* factor for finding excusable neglect weighs in favor of opposer.

The Board turns now to the third *Pioneer* factor, namely, the reason for the delay, including whether it was within the reasonable control of opposer.

Opposer explains that its counsel did not receive the Board's order either by first class mail or by email because, as to the former, counsel had relocated over one year ago and had only submitted a change of correspondence address to the Trademark Office (rather than to the Board); and, as to the latter, the computer server at counsel's "IT firm" (which services counsel's "@hemlaw.org" domain account) had a technical problem. Thus, not all the circumstances which caused opposer's delay were within the reasonable control of opposer. In view thereof, the Board finds that the third *Pioneer* factor is neutral insofar as the computer difficulties suffered by opposer appear to have been beyond the control of opposer's counsel, yet, counsel

failed to update opposer's correspondence address with the Board.² Nonetheless, the Board must balance the reason for the delay with the other factors enumerated by the Supreme Court in *Pioneer* to take into account all of the relevant circumstances in determining whether opposer's actions constitute a sufficient showing of excusable neglect.

After careful consideration of the *Pioneer* factors and the relevant circumstances in this case, in view of the absence of prejudice to applicant, the lack of evidence of any bad faith on the part of opposer, the relatively brief length of the delay, and the circumstances which caused opposer's delay in responding to the Board's order, the Board, in its discretion, finds in balancing the four factors set forth in *Pioneer* that opposer has shown excusable neglect in support of its effective motion to reopen its time to respond to the Board's order dated April 5, 2013. Accordingly, opposer's motion is **granted**. Thus, opposer was allowed until June 14, 2013, to serve its supplemental discovery responses on applicant. See Fed. R. Civ. P. 6(b).

² Although the Board can be lenient on this single occasion, opposer is reminded that it is the responsibility of each party to a proceeding before the Board to ensure that the Board has the party's current correspondence address, including an e-mail address, if applicable. Opposer is advised that if it again fails to notify the Board of a change of address, with the result that the Board is unable to serve correspondence on opposer, default judgment may be entered against opposer. See TBMP § 117.07 (3d ed. rev.2 2013).

Motion for Sanctions

Applicant's motion for sanctions is grounded on opposer's failure to timely respond to the Board's April 5, 2013 order. Inasmuch as the Board has granted opposer's motion to reopen the period to serve its supplemental responses to applicant's discovery, and opposer has served its supplementary responses within the period requested, applicant's motion for sanctions is moot and will be given no further consideration.

Nonetheless, it appears from the parties' papers that opposer's supplementary discovery responses do not correspond to opposer's previous statements regarding its responsive and available information and documents, see, e.g., "the Category G, H, I, and J documents contain ... sales, orders, and fulfillment documents relating to the Jacksonville Sharks shirts and/or caps produced by [Opposer] and its predecessor-in-interest ... [and are those] requested in your document requests, and identified by Classic Ink to be responsive to the [Applicant's] interrogatories" (applicant's reply to motion for sanctions, at 6; opposer's response to applicant's motion to compel, at 14). For instance, it is noted with respect to applicant's requests for data and documents on opposer's advertising and sales, that opposer has responded that information specifically applicable to opposer's pleaded marks and goods "is not

information [in] the possession, custody or control of Opposer" (see opposer's responses to applicant's interrogatory nos. 4, 5 and 8, Exh. 6 to opposer's response to motion for sanctions). Thus, it appears that opposer has yet again engaged in the game of "hide the ball," notwithstanding the Board's cautionary warning to opposer in its April 5, 2013 order.

Accordingly, for the purpose of clarifying opposer's supplementary responses served on June 13, 2013, opposer is hereby **ORDERED** to supplement said supplementary discovery responses by stating unequivocally with respect to each interrogatory response which refers to documents and with respect to each request for production of documents, either that "opposer has no responsive documents" or "opposer has no other responsive documents," whichever is accurate. Opposer is allowed until **FIFTEEN DAYS** from the mailing date of this order to so supplement its previous discovery responses and serve them on applicant.

Additionally, the Board will entertain from applicant a motion to exclude the introduction of any evidence by opposer comprising materials or information that is responsive to applicant's discovery requests which has not previously been served on applicant by opposer.³ See *Panda*

³ Applicant is reminded that the Board will deny a motion to prospectively exclude evidence that might be introduced at trial and that might be inconsistent with discovery responses

Travel, Inc. v. Resort Option Enterprises, Inc., 94 USPQ2d 1789, 1792-93 (TTAB 2009) (documents not produced until after the start of trial stricken). See TBMP § 527.01(e) (3d ed. rev.2 2013). Should such a motion be filed, the Board will also consider the parties' compliance with the discovery rules, in particular, Fed. R. Civ. P. 26(e).

Proceeding Resumed; Trial Dates Reset

As noted *supra*, applicant's consent motion to reset its discovery period for ninety days is granted. In view thereof, trial dates, including applicant's discovery period, are reset as shown below:

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| Expert Disclosures Due | 11/18/2013 |
| Discovery Closes for Applicant | 12/18/2013 |
| Plaintiff's Pretrial Disclosures Due | 2/1/2014 |
| Plaintiff's 30-day Trial Period Ends | 3/18/2014 |
| Defendant's Pretrial Disclosures Due | 4/2/2014 |
| Defendant's 30-day Trial Period Ends | 5/17/2014 |
| Plaintiff's Rebuttal Disclosures Due | 6/1/2014 |
| Plaintiff's 15-day Rebuttal Period Ends | 7/1/2014 |

or other material not provided during discovery. See *Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 (TTAB 1995). The better practice is to file a motion to strike or otherwise object to such evidence after it is introduced, identifying the specific evidence objected to and the asserted basis for exclusion thereof. TBMP § 527.01(f) (3d ed. rev.2 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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