UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: April 17, 2018

Opposition No. 91233968

Esurance Insurance Services, Inc.

v.

Besurance Corporation

Michael Webster, Interlocutory Attorney:

This case now comes up for consideration of Opposer's combined motion, filed December 29, 2017, (1) for leave to amend its pleading to add a claim that Applicant lacked a bona fide intent to use the mark; (2) to extend the deadline to make expert disclosures to sixty (60) days from the Board's order; and (3) to extend the deadline of the discovery period to ninety (90) days from the date of the Board's order.[1] In its response, Applicant consents to Opposer's request for leave to amend its pleading and to extend the discovery deadline by ninety (90) days. However, Applicant opposes the motion to extend the expert disclosure period.

Because Applicant has consented to the motions, Opposer's motion to amend its pleading and motion to extend the discovery period are **granted**. Accordingly, Opposer's amended pleading is the operative pleading.[2]

[1] Opposer further requests suspension of the proceedings pending determination of the combined motions.
[2] Applicant's time to file an answer to the amended notice is set forth in Section II below.

I. Opposer's Motion to Extend/Reopen Expert Disclosures

In opposition to the motion to extend the expert disclosure deadline, Applicant argues that Opposer offers no support for its request to reopen the expert disclosure period and offers no nexus connecting its request to reopen the expert disclosure period to its motion for leave to amend the complaint. In addition, Applicant argues that Opposer has failed to meet the excusable neglect standard required to reopen a period that has previously closed. Applicant further argues that it would be prejudiced if the Board grants that motion because "expert-related costs will negatively impact Applicant's ability to mount a defense should this case proceed to trial." 10 TTABVUE 6.

In reply, Opposer argues that Applicant's answer to the new ground for opposition will inform Opposer as to whether to retain an expert witness; that the new claim may determine which expert, if any, Opposer should retain; and that an expert witness "may be helpful to adjudicate issues related to Opposer's new claim …." 11 TTABVUE 4. With respect to the excusable neglect standard, Opposer argues that Applicant will suffer no prejudice, that the length of the delay is "exceedingly short," *id.* at 5, and that there will be no impact on the Board's proceedings if the expert disclosure deadline is reset in addition to resetting all other deadliness, to which Applicant has consented.

With respect to the reason for the delay, Opposer states that its request for a new scheduling order was filed with its motion for leave to amend its pleading in the interest of judicial economy because the request to extend the expert disclosure

deadline is "inextricably intertwined with its request for leave to amend," *id.* at 6, and that "it would be premature to make expert disclosures at this stage with so much of the case in flux." *Id.*

Pursuant to Fed. R. Civ. P. 6(b), made applicable to Board proceedings by Trademark Rule 2.116(a), a party seeking to extend the time in which an act must be done after the time for taking action has expired must show that its failure to act during the previously allotted time was the result of excusable neglect. The motion is generally referred to as a motion to reopen the time period. In order to determine whether a party has shown excusable neglect, the Board must take into account all relevant circumstances surrounding the party's omission or delay, including (1) the danger of 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, including whether it was within the reasonable control of movant; and (4) whether movant acted in good faith. *Pioneer Inv. Serv. Co. v. Brunswick Assoc. Ltd. P'ship et. al.*, 507 U.S. 380, 396-97 (1993); *Pumpkin Ltd. v. Seed Corps*, 43 USPQ2d 1582, 1585-86 (TTAB 1997) (explaining Supreme Court's analysis in *Pioneer*). The reason for the delay may be considered the most important factor in the analysis. *See Luster Prods. Inc. v. Van Zandt*, 104 USPQ2d 1877, 1879 (TTAB 2012); *Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1702 (TTAB 2002); *Pumpkin Ltd.*, 43 USPQ2d at 1586 n.7.

In this case, the deadline to serve expert dislosures, as reset, was December 18, 2017.[3] Because Opposer's combined motion, including its request to extend the deadline, was filed after the expert disclosure deadline expired the Board must construe Opposer's request to extend the expert disclosure deadline as a motion to reopen time to serve expert disclosures.

In its brief on the motion, Opposer does not set forth the reason for its failure to timely serve expert disclosures or, in the alternative, file a timely motion to extend the expert disclosure deadline. Opposer merely requests an extension of the deadline in view of the new claim. The lack of explanation regarding the specific reasons for the inaction weighs heavily against finding excusable neglect. *See Gaylord Entm't Co. v. Calvin Gilmore Prods. Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000).

Opposer subsequently identifies the reason for the delay in its reply brief. However, the reason for the delay should be set forth in detail in the motion, not the reply brief, so that the opposing party may have an opportunity to address the arguments in its response to the motion. *See Johnston Pump/General Valve Inc. v. Chromalloy Am. Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) ("The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto"). Even considering Opposer's arguments in its reply brief, the third *Pioneer* factor weighs against finding excusable neglect. Opposer indicates that it chose not to file its disclosures within the deadline "in the interest of judicial economy," 11 TTABVUE 6, because, in view of the new claim, "[i]t would be

[3] 7 TTABVUE 2.

premature to make expert disclosures." However, Opposer's reasoning does not adequately explain why it did not timely file a motion to extend the expert disclosure deadline. In particular, the Board finds Opposer's explanation of the alleged relationship between the motion for leave to amend and expert disclosures insufficient reason to ignore the disclosure deadline and file a motion to extend eleven days passed the deadline. Based on Opposer's arguments, the failure to timely file a motion to extend the deadline was clearly within Opposer's reasonable control.[4]

With respect to the first and fourth *Pioneer* factors, there is no evidence in the record that Applicant will suffer any prejudice due to the delay or that Opposer acted in bad faith in waiting to file its extension request. The mere fact that Applicant may incur costs in the event Opposer discloses an expert is insufficient to find prejudice, *see Paolo's Assoc. LP v. Bodo*, 21 USPQ2d 1899, 1904 (Comm'r 1990), and is unrelated to the delay caused by Opposer's failure to timely file an extension.

Turning to the second *Pioneer* factor, the length of the delay and its potential impact on the proceedings, the Board notes that, in addition to the time between the expert disclosure deadline and the filing of the motion to reopen, the Board must take into account the additional, unavoidable delay arising from the time required for briefing and deciding the motion. *PolyJohn Enter. Corp. v. 1-800-Toilets, Inc.*, 61 USPQ2d 1860, 1862 (TTAB 2002). In addition, the Board and parties to Board proceedings have a significant interest in minimizing the amount of the Board's time and resources expended on motions, such as the motion herein, that are the result of

[4] Further, based on Opposer's explanation, Opposer willfully chose to delay its filing of the motion to extend in order to file it when it filed the motion to amend its pleading.

the failure to meet deadlines or sloppy practice. *Pumpkin Ltd. v. Seed Corps*, 43 USPQ2d 1582, 1588 (TTAB 1997). Here, the amount of time and resources spent on Opposer's contested motion to reopen is not insignificant and has had an impact on the proceeding.

In view of the foregoing and weighing all the relevant facts and circumstances discussed herein, the Board finds that Opposer has failed to demonstrate excusable neglect for its failure to timely file a motion to extend the expert disclosure deadline. As noted above, Opposer failed to explain the reason for the delay in its motion and, even if the Board considers Opposer's explanation in its reply, the delay was wholly within Opposer's control. In this case, the reason, or lack thereof, outweighs the lack of evidence of prejudice or bad faith. *See, e.g., Luster Prods. Inc. v. Van Zandt*, 104 USPQ2d 1877, 1879 (TTAB 2012) (applicant made a calculated strategic decision, within its control, not to take discovery in the hope opposer had lost interest in the case); *Pumpkin Ltd.*, 43 USPQ2d at 1588 (absence of prejudice and bad faith outweighed by the circumstances under the second and third factors).

Accordingly, Opposer's motion to reopen the time for serving expert disclosures is **DENIED**.

II. Proceeding Schedule

Proceedings herein are resumed, dates are reset as follows in accordance with Opposer's consented motion to extend discovery.

Applicant's answer to the amended notice of opposition is due **May 9, 2018**.

Discovery Closes	7/17/2018
Plaintiff's Pretrial Disclosures Due	8/31/2018

Plaintiff's 30-day Trial Period Ends	10/15/2018
Defendant's Pretrial Disclosures Due	10/30/2018
Defendant's 30-day Trial Period Ends	12/14/2018
Plaintiff's Rebuttal Disclosures Due	12/29/2018
Plaintiff's 15-day Rebuttal Period Ends	1/28/2019
Plaintiff's Opening Brief Due	3/29/2019
Defendant's Brief Due	4/28/2019
Plaintiff's Reply Brief Due	5/13/2019
Request for Oral Hearing (optional) Due	10/29/2019

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.