

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  
General Email: [TTABInfo@uspto.gov](mailto:TTABInfo@uspto.gov)

February 14, 2019

Opposition No. 91239222

*Sterling Jewelers Inc.*

*v.*

*Tat Lee*

**Geoffrey M. McNutt, Interlocutory Attorney:**

This case comes up for consideration of Opposer's December 21, 2018, contested motion for a 60-day extension of the remaining discovery and trial deadlines in this proceeding.<sup>1</sup>

**1. Background and the Parties' Arguments**

In its motion, Opposer maintains, inter alia, that it served written discovery requests on Applicant on August 31, 2018; Applicant's counsel requested an extension of time to respond until October 12, 2018,<sup>2</sup> to which Opposer agreed; on October 12, 2018, Applicant served his written discovery responses but did not produce any documents; between October 21–26, 2018, Applicant served amended responses to

---

<sup>1</sup> The Board addresses the record only to the extent necessary to set forth its analysis and findings. The Board does not repeat or address all of the parties' arguments and evidence. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

<sup>2</sup> Absent the extension, Applicants' responses and objections would have been due by September 30, 2018. See Trademark Rule 2.120(a)(3); Fed. R. Civ. P. 33(b)(2) and 34(b)(2)(a).

Opposer's interrogatories and document requests, and produced nine pages of documents; on November 26, 2018, Opposer's counsel sent Applicant's counsel a deficiency letter seeking clarification of Applicant's written responses, requesting a supplemental document production, and proposing that the parties' attorneys meet and confer to discuss the matters raised in the deficiency letter; between November 28, 2018, and December 20, 2018, the parties' counsel exchanged correspondence and ultimately met and conferred by telephone; on December 20, 2018, Applicant provided a response to Opposer's deficiency letter and a supplemental production of twenty pages. *See* 15 TTABVUE 3–4.

In response, Applicant contends that Opposer has not been diligent in pursuing its case, and therefore has not shown good cause for the requested extension. 16 TTABVUE 5–6. Applicant also contends that with his October 12, 2018, discovery responses he “referenc[ed] literally thousands of pages disclosing virtually the entire history of Applicants use of the [subject] mark, the goods offered under that mark; a time line of when those goods were introduced and withdrawn from being offered since use of that mark commenced in 2004, fourteen years earlier.”<sup>3</sup> *Id.* at 4–5. Applicant characterizes his December 20, 2018, supplemental document production as “produc[ing] several additional documents supporting information previously provided and referenced in the letter [responding to Opposer's deficiency letter].” *Id.* at 5.

---

<sup>3</sup> Applicant's written discovery responses are not of record, and it is not clear from Applicant's response to Opposer's motion whether Applicant actually produced thousands of pages of documents, or merely referred to the documents in his written discovery responses.

## **2. Standard for Motion to Extend**

The discovery period may be extended upon motion granted by the Board. Trademark Rule 2.120(a)(2); TBMP § 403.04 (2018).

The party requesting the extension must set forth with particularity the facts said to constitute good cause for the extension and that the extension is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor. Fed. R. Civ. P. 6(b)(1); TBMP § 509.01(a).

The Board generally is liberal in granting extensions of time so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. *See, e.g., American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313 (TTAB 1992).

## **3. Analysis and Determination**

This is the first extension sought by Opposer, and therefore Opposer has not abused the privilege of extensions.

Additionally, the requested extension is not necessitated by Opposer's lack of diligence or unreasonable delay in taking discovery. In this regard, Applicant's arguments that Opposer has not diligently pursued its case are not well-taken. As an initial matter, it borders on frivolous for Applicant to characterize as dilatory Opposer's conduct in obtaining a 90-day extension of its deadline to file a notice of opposition, and contesting Applicant's motion to set aside the notice of default that issued when Applicant failed to timely answer the notice of opposition. Opposer was

acting within its rights when it took these actions, neither of which have any bearing on Opposer's diligence in seeking discovery within the discovery period.

Additionally, the Board perceives no dilatory conduct on the part of Opposer in serving its discovery requests 36 days after the discovery opened, or sending its first deficiency letter to Applicant's counsel "nearly 30 days" after Applicant served amended responses to Opposer's interrogatories and document requests, and produced nine pages of documents.

A party which receives discovery requests early in the discovery period may not, by delaying its response thereto, or by responding improperly so that its adversary is forced to file a motion to compel discovery, deprive its adversary of the opportunity to take follow-up discovery. Such a delay or improper response constitutes good cause for an extension of the discovery period. Therefore, the Board will, at the request of the propounding party, extend the discovery period (at least for the propounding party) so as to restore that amount of time which would have remained in the discovery period had the discovery responses been made in a timely and proper fashion. *See Miss Am. Pageant v. Petite Prods., Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990); *Neville Chem. Co. v. Lubrizol Corp.*, 184 USPQ 689, 690 (TTAB 1975). Additionally, where parties are engaged in efforts to resolve a discovery dispute without Board intervention, a motion to extend time for such purpose generally is appropriate. *See Sentrol, Inc. v. Sentex Sys., Inc.*, 231 USPQ 666, 667-668 (TTAB 1986) (opposer's contested motion to extend granted).

As last reset, the discovery period in this case was scheduled to close on January 21, 2019. *See* 12 TTABVUE 6. If Applicant had provided its complete document production by the parties' agreed-upon deadline of October 12, 2018, Opposer would have had ample time to take follow-up written discovery. Moreover, Opposer maintains, and Applicant does not dispute,<sup>4</sup> that Applicant responded to Opposer's November 26, 2018, deficiency letter and request to meet and confer by requesting an extension of time to respond to the letter until December 21, 2018. *See* 15 TTABVUE 3–4. When Applicant provided a response to Opposer's deficiency letter and a supplemental document production of twenty pages on December 20, 2018, Opposer had only two days (and only one business day) to review Applicant's response and supplemental documents, and prepare and timely serve follow-up written discovery requests.<sup>5</sup>

Based on the foregoing, Opposer has established good cause for its requested 60-day extension of remaining discovery and trial dates, and its motion to extend is **granted**.

---

<sup>4</sup> The Board notes, however, that Applicant contends that the additional documents produced on December 20, 2018, "support[ed] information previously provided" by Applicant. 16 TTABVUE 5.

<sup>5</sup> Pursuant to Trademark Rule 2.120(a)(3), "[d]iscovery depositions must be properly noticed and taken during the discovery period" and "[i]nterrogatories, requests for production of documents and things, and requests for admission must be served early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses will be due no later than the close of discovery."

#### 4. Case Schedule

In view of the time that elapsed since the motion was filed, and to provide adequate time for follow-up discovery, remaining dates are reset as shown in the schedule below.

Expert Disclosures Due	3/16/2019
Discovery Closes	4/15/2019
Plaintiff's Pretrial Disclosures Due	5/30/2019
Plaintiff's 30-day Trial Period Ends	7/14/2019
Defendant's Pretrial Disclosures Due	7/29/2019
Defendant's 30-day Trial Period Ends	9/12/2019
Plaintiff's Rebuttal Disclosures Due	9/27/2019
Plaintiff's 15-day Rebuttal Period Ends	10/27/2019
Plaintiff's Opening Brief Due	12/26/2019
Defendant's Brief Due	1/25/2020
Plaintiff's Reply Brief Due	2/9/2020
Request for Oral Hearing (optional) Due	2/19/2020

The Federal Rules of Evidence generally apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).