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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91253873
Party	Plaintiff The Procter & Gamble Company
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 88524984
Published on November 26, 2019

The Procter & Gamble Company,)	
)	
Opposer,)	Opposition No. 91253873
v.)	Mark: HAIR CODES
)	
Hair Codes,)	
)	
Applicant.)	
_____)	

**OPPOSER’S OPPOSITION TO APPLICANT’S
MOTION TO EXTEND THE DISCOVERY PERIOD**

Opposer The Procter & Gamble Company (“P&G”) respectfully opposes the Motion to Extend filed by Hair Codes (“Applicant”) (D.N. 20). The Board should deny Applicant’s motion to extend the discovery deadline because Applicant has failed to show good cause in support of its motion. Applicant also attempted to serve untimely discovery requests that did not provide P&G enough time to respond during the discovery period. Since P&G has no obligation to respond to the untimely discovery requests, Applicant now seeks relief from the Board to extend the discovery period even though there is no good cause to do so. Tellingly, Applicant’s discussion of the factual background does nothing more than demonstrate its own carelessness and failure to comply with the Trademark Rules. Applicant’s shortcomings do not constitute good cause; in fact, they preclude it. The Board, therefore, should deny Applicant’s motion to extend the discovery deadline.

I. Factual and Procedural Background.

P&G filed the instant opposition against Applicant’s trademark on February 4, 2020 (D.N. 1). Shortly thereafter, the parties began discussing a potential resolution to this matter. The parties

agreed to a consented extension of time for Applicant to file its answer. Several months later, the undersigned law firm of Dinsmore & Shohl LLP entered its appearance as counsel for P&G in this opposition. (D.N. 10). Settlement discussions did resume between counsel for Applicant and P&G's counsel and the parties agreed to additional consented suspensions of the opposition.

The parties held their mandatory discovery conference on June 16, 2020. *See* Declaration of Govinda M. Davis ("Davis Declaration" attached as **Exhibit A** at ¶ 4). P&G served its initial disclosures July 15, 2020. *See* Davis Declaration at ¶ 5. Prior to the discovery cut-off deadline, P&G's counsel contacted Applicant's counsel to inquire whether Applicant was amenable to an extension of the deadlines by sixty days to provide time to consider an alternative settlement proposal. *See* Davis Declaration at ¶ 6. When P&G did not receive a response on the potential extension, P&G then served its first set of discovery requests on January 12, 2021. *See* Davis Declaration at ¶ 7 and 8.

The next day, Applicant's counsel responded and indicated that Applicant would only consent to a thirty-day suspension rather than a sixty-day extension. *See* Davis Declaration at ¶ 9. Counsel for P&G responded to indicate that she would have to confirm the suspension with P&G before providing consent. *See* Davis Declaration at ¶ 10. Applicant, in turn, filed an unconsented motion to suspend by thirty days on January 20, 2021. (*See* D.N. 16). Applicant withdrew its unconsented motion and the parties agreed to and filed their most recent consented suspension request on January 21, 2021, which the Board granted the same day. (*See* D.N. 17-19). Per the Board's most recent order, proceedings were suspended from January 21, 2021 to February 21, 2021, and the Board set the close of discovery for March 15, 2021. (*See* D.N. 19).

Several days after the most recent suspension was granted, Applicant improperly attempted to serve its first set of discovery requests and a deposition notice **during** the suspension on January

27, 2021. *See* Davis Declaration at ¶ 11. In response to the inappropriate discovery requests and deposition notice, P&G indicated that the requests and deposition notice were improperly served during the suspension period. *See* Davis Declaration at ¶ 12. P&G further indicated that once the proceedings resumed, Applicant would not be able to serve discovery requests early enough in the discovery period to permit P&G time to respond within the discovery period. *See* Davis Declaration at ¶ 13; *see* 37 C.F.R. § 2.120(a)(3) (requiring a party to serve discovery requests at least thirty days before the close of discovery).

The proceedings resumed on February 21, 2021. (D.N. 19). When the opposition resumed, there were twenty two days left in the discovery period. Applicant simply let the deadline to serve discovery pass without taking action. Since there is no way that Applicant could serve its discovery requests with enough time for P&G to respond, as required by the Trademark Rules, and because Applicant has **not** shown good cause for an extension, the Board should deny Applicant's motion to extend the discovery deadline as further described below.

II. Applicant Has Failed To Show Good Cause for the Requested Extension.

The Board should deny Applicant's motion because it fails to show good cause for the extension. The Trademark Rules require that a party seeking an extension show good cause. Applicant presents facts that demonstrate nothing more than its own carelessness and lack of diligence in serving discovery. These facts do not constitute good cause and, therefore, the Board should deny Applicant's motion.

A party moving to extend discovery deadlines “must set forth with particularity the facts said to constitute good cause for the requested extension[.]” TBMP § 509.01(a). The moving party “must demonstrate that the requested extension of time is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the time period previously allotted therefor.” *Id.*

Applicant has not and cannot provide any facts that would support a finding of good cause. Applicant fails, therefore, to “set for *with particularity* the facts said to constitute good cause[.]” *Id.* (emphasis added). Nevertheless, Applicant’s allegations demonstrate nothing more than its own lack of diligence and Applicant’s motion fails both logically and as a matter of law.

A. Applicant’s Lack of Diligence Regarding its Failure to Serve Discovery Does Not Constitute “Good Cause.”

The existence of settlement discussions does not provide good cause to grant a motion to extend. Applicant attempts to argue that it “believed that it would not need to go forward with discovery or trial because a mutually acceptable settlement agreement between the Parties would be reached.” (D.N. 20 at p. 4). However, this argument fails both logically and as a matter of law.

This argument fails logically because, if Applicant believed, as it claims, that the parties would not need to engage in discovery during this period, then it is nonsensical that it would serve requests and a deposition notice on January 27, 2021 while the opposition was suspended.¹

This argument also fails as a matter of law, because the existence of settlement discussions does not excuse a failure in serving discovery requests. In *National Football League v. DNH Management LLC*, 85 USPQ2d 1852 (TTAB 2008), a party argued that it “delayed taking discovery because the parties were engaged in settlement discussions.” *Id.* at 1854. The Board rejected this reasoning, noting that the party did not “point[] to any exigent circumstances that prevented them from serving discovery while they continued” attempted settlement discussions. *Id.* at 18545–55; see *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000) (“[T]he mere existence of [settlement] negotiations or proposals, without more,

¹ P&G notes that, in the event that Applicant attempts to argue that it did not understand the rules that apply to service of discovery in Board proceedings, perhaps the Board would have excused Applicant’s ignorance of the rules during the transition period when the rules went into effect in 2017, but such a lack of diligence **cannot** constitute good cause today.

would not justify petitioner’s delay in proceeding with testimony.”). In fact, P&G served discovery requests while settlement discussions were ongoing on January 12, 2021. Applicant merely let the deadline to serve discovery pass and did not take action, and its lack of diligence does not equate to good cause to grant an extension. In fact, P&G offered to extend dates prior to the discovery service deadline, and Applicant failed to respond to that offer until after P&G served its own discovery requests and the discovery service date passed. When Applicant did respond, Applicant did not simply agree to P&G’s extension proposal, but put forth a counterproposal for a suspension for a different length of time.

In this case, Applicant has failed to show good cause as to why it could not have served discovery requests, as P&G did, with enough response time before the close of discovery. Because Applicant has failed to show good cause, the Board should deny its motion to extend.

III. P&G Has No Obligation To Respond to Applicant’s Untimely Discovery.

The parties do not dispute that Applicant attempted to submit its discovery requests and deposition notice while the opposition was suspended. Since Applicant attempted to serve the documents in an untimely manner, P&G has no obligation to respond to the requests as they stand, nor is P&G obligated to appear for an improperly noticed deposition. The Trademark Rules require a party to serve requests “early enough in the discovery period . . . so that responses will be due no later than the close of discovery.” 37 C.F.R. § 2.120(a)(3). Since responses “must be served within thirty days from the date of service of such discovery requests,” that means that a propounding party must serve requests at least thirty days before the close of discovery. *See id.* “A party has no obligation to respond to the merits of an untimely request for discovery[.]” TBMP § 403.01; *Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268, 1271 (TTAB 2017)

(sustaining an objection to requests as untimely where the propounding party failed to serve requests thirty days prior to the close of discovery).²

P&G served its discovery requests on January 12, 2021 — thirty-one days before the then-current close of discovery. Applicant failed to do so. Because Applicant attempted to serve these requests outside of the time period required by the Trademark Rules, P&G, therefore, has no obligation to respond to these requests nor appear for the deposition. Therefore, P&G requests that the Board deny Applicant's motion to extend.

IV. Conclusion.

The Board should deny Applicant's motion to extend the deadline for the close of discovery because Applicant has failed to show good cause in support of its motion. Instead, Applicant attempts to argue that its own lack of diligence constitutes good cause. As shown above, these arguments fail logically and as matters of law, the discovery period should remain as set, and P&G should not have to respond to discovery requests served by Applicant nor appear for an improperly noticed deposition. P&G respectfully requests that the Board deny Applicant's motion to extend discovery.

² Note that in *Estudi* the Board reopened discovery to allow the propounding party's requests to "be considered timely," *because* the "case was pending as of the effective date of the revised rules and was initially filed under the prior rules" (under which file requests until the last date of discovery). *Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268, 1271.

Date: March 12, 2021

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **Opposer's Opposition to Applicant's Motion to Extend** has been served upon counsel of record, this 12th day of March, 2021 by e-mail addressed as follows:

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v.)	Mark: HAIR CODES
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)	
Applicant.)	
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DECLARATION OF GOVINDA M. DAVIS

I, Govinda M. Davis, declare the following:

1. I am a citizen of the United States of America and am over 18 years of age. I have personal knowledge of the matters stated in this declaration.
2. I am an associate at Dinsmore & Shohl LLP.
3. I represent The Procter & Gamble Company in the above-referenced matter.
4. On June 16, 2020, the parties held their mandatory discovery conference
5. P&G served its initial disclosures on July 15, 2020.
6. Prior to the discovery cut-off deadline, P&G's counsel contacted Hair Codes' ("Applicant") counsel to inquire whether Applicant was amenable to an extension of the deadlines by sixty days to provide time to consider an alternative settlement proposal.
7. When P&G did not receive a response on the potential extension, P&G then served its first set of discovery requests.
8. P&G served its first set of discovery requests on Applicant on January 12, 2021.

9. On January 13, 2021, Applicant's counsel responded to P&G's counsel's January 12, 2021 e-mail and indicated that Applicant would only consent to a thirty-day suspension rather than a sixty-day extension.

10. Counsel for P&G responded to Applicant's counsel's January 13, 2021 e-mail to indicate that she would have to confirm the suspension with P&G before providing consent.

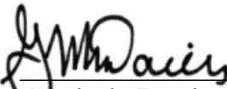
11. Applicant attempted to serve its first set of discovery requests and a deposition notice during the suspension on January 27, 2021.

12. In response to the inappropriate discovery requests and deposition notice, P&G indicated that the requests and deposition notice were improperly served during the suspension period.

13. P&G indicated to Applicant that once the proceedings resumed, Applicant would not be able to serve discovery requests early enough in the discovery period to permit P&G time to respond within the discovery period.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on March 12, 2021.


Govinda Davis