

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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mbm

September 28, 2021

Opposition No. 91253873

The Procter & Gamble Company

v.

Hair Codes

Mary Beth Myles, Interlocutory Attorney:

This proceeding now comes before the Board for consideration of Applicant's motion (filed February 22, 2021) to extend discovery. The motion is fully briefed.

The Board has considered the parties' briefs on the contested motion, but does not repeat or discuss all of their arguments, except as necessary to explain the Board's order. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

As last reset by the Board's February 4, 2021 order, discovery was set to close on March 15, 2021. 19 TTABVUE. By way of its motion, Applicant seeks to extend discovery by sixty days. 20 TTABVUE. As the basis for its request, Applicant states that it has not taken discovery or depositions in this proceeding, because the parties were engaged in settlement discussions and "Applicant reasonably 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." *Id.* at 3.

In response, Opposer argues that Applicant's need for an extension was caused by Applicant's own lack of diligence. Specifically, Opposer states that Opposer requested a sixty-day extension of the discovery period from Applicant prior to the last day on which the parties could serve discovery requests; however, Applicant refused to consent to an extension of the discovery period and agreed instead to a thirty-day suspension of proceedings. 21 TTABVUE 10-11. Applicant filed the parties' consented motion to suspend on January 21, 2021. 18 TTABVUE. The Board granted the parties' motion to suspend on February 4, 2021 and proceedings were suspended through February 20, 2021. 19 TTABVUE. Opposer contends that Applicant then improperly served discovery requests and a deposition notice during the suspension period on January 27, 2021. 21 TTABVUE 11.

A party that seeks to extend the time in which an act may or must be done prior to the expiration of the period as originally set or as reset need only show good cause for the requested extension. *See* Fed. R. Civ. P. 6(b); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 509.01 (2021). To show good cause, the moving party must set forth with particularity the facts allegedly constituting good cause and must demonstrate that the extension is not necessitated by the moving party's own lack of diligence or unreasonable delay. *See Nat'l Football League v. DNH Mgmt. LLC*, 85 USPQ2d 1852, 1854 (TTAB 2008). "[T]he Board is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused." *Id.*

On the record, there is no evidence of bad faith on the part of Applicant. Additionally, although the parties' have filed numerous consented motions to extend or suspend for settlement discussions, this is Applicant's first unconsented motion to extend and the Board therefore finds that Applicant has not abused the privilege of extensions.¹ The Board finds, however, that Applicant has not established good cause for the requested extension and that the reason for the extension was necessitated by Applicant's own lack of diligence and delay.

Discovery initially opened in this proceeding on June 15, 2020. 8 TTABVUE. Applicant filed a consented motion to suspend proceedings on July 23, 2020—i.e., after over a month of discovery had passed. 12 TTABVUE. Proceedings were resumed on August 23, 2020, and neither party filed another consented motion to suspend for settlement until November 25, 2020—i.e., after an additional **three months** of the discovery period had passed. 13-15 TTABVUE. At the time the November 25, 2020 consented motion was filed, only a little over a month remained in the discovery period. Proceedings were again resumed on December 26, 2020. 15 TTABVUE. Applicant did not seek another suspension of proceedings for settlement until over three weeks later, when only a few weeks remained in discovery as last reset.

Although Applicant claims that it relied on Opposer's representations that it was considering settlement proposals, a review of the record clearly indicates that Applicant failed to take any action, either by serving discovery requests or by filing a

¹ Applicant previously filed a motion to suspend without consent for thirty days, which was withdrawn on January 21, 2021 when Opposer consented to the requested suspension. 16 and 17 TTABVUE.

request to suspend or extend dates, for well over five months total. Applicant has entirely failed to explain any basis for its delay during the periods of discovery when proceedings were not suspended for settlement. It is well established that, in the absence of a motion to suspend for settlement, the Board assumes the parties are working towards settlement simultaneously with doing the necessary work for discovery, trial, or any other pertinent deadlines. The mere existence of settlement discussions does not excuse a party's failure to act. *See Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000) (denying motion to extend, because "even if the parties had been discussing settlement, the mere existence of such negotiations or proposals, without more, would not justify petitioner's delay.").

Applicant contends that it had no reason to believe settlement was not imminent until Opposer served Applicant with discovery requests on January 12, 2021. 22 TTABVUE 7. However, at that time, proceedings were resumed and discovery remained open. It was therefore incumbent upon Applicant to either seek an appropriate extension or suspension for settlement **or** to proceed with discovery. Instead, Applicant allowed proceedings to resume and took no action. Indeed, it appears that Applicant **refused** Opposer's request to extend discovery for sixty days. 21 TTABVUE 11.

Applicant did not act diligently during the periods that proceedings were not suspended, either by timely and promptly filing additional motions to suspend, or by proceeding with discovery. Instead, Applicant allowed discovery to continue to run on numerous occasions after suspension periods expired. Applicant has not explained its

failure to act in between the consented periods of suspension, apart from the existence of settlement discussions. Accordingly, the existence of settlement negotiations is insufficient, standing alone, to constitute good cause for further extension of discovery.

On balance, the Board finds that Applicant has not established good cause and Applicant's motion to extend is **denied**.

Proceedings are resumed.² Remaining dates are reset as follows:

Discovery Closes	10/20/2021
Plaintiff's Pretrial Disclosures Due	12/4/2021
Plaintiff's 30-day Trial Period Ends	1/18/2022
Defendant's Pretrial Disclosures Due	2/2/2022
Defendant's 30-day Trial Period Ends	3/19/2022
Plaintiff's Rebuttal Disclosures Due	4/3/2022
Plaintiff's 15-day Rebuttal Period Ends	5/3/2022
Plaintiff's Opening Brief Due	7/2/2022
Defendant's Brief Due	8/1/2022
Plaintiff's Reply Brief Due	8/16/2022
Request for Oral Hearing (optional) Due	8/26/2022

Generally, the Federal Rules of Evidence 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,

² The Board considers proceedings retroactively suspended as of the filing date of the motion to extend.

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).

TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing. **Note:** Parties are strongly encouraged to check the entire document before filing.³ The Board will not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the [ESTTA help](#) webpage.

³ To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.