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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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August 11, 2022

Opposition No. 91272735

Cosmetic Skin Solutions, LLC

v.

Cosmetic Sibeautesi LLC

M. Catherine Faint,
Interlocutory Attorney:

This case comes before the Board for consideration of Cosmetic Sibeautesi LLC's (Applicant) fully-briefed motion, filed April 13, 2022 to withdraw or amend its untimely responses to Cosmetic Skin Solutions, LLC's (Opposer) requests for admission; and Opposer's motion, filed April 25, 2022, to withdraw and replace its response brief.

I. Background

Applicant seeks to register three standard character marks: CSS and CSS SKIN for various cosmetics and CSS SKIN for dietary and nutritional supplements, based on intent to use the marks in commerce.[1]

[1] Application Serial Nos. 90150725, 90150731 and 90150734, each filed September 1, 2020.

By its first amended notice of opposition, Opposer opposes registration of the marks on the grounds of likelihood of confusion, dilution, fraud and lack of bona fide intent to use the marks in commerce.[2] Applicant filed its amended answer denying the salient allegations of the amended notice of opposition and purporting to plead several "affirmative defenses."[3] As reset by the Board's order of February 14, 2022, discovery was set to close on August 26, 2022.[4]

Opposer served its first requests for admission to Applicant on March 2, 2022.[5] Applicant served its responses and objections to admission requests together with its motion on April 13, 2022,[6] 12 days after the 30-day response deadline provided under the Rules.[7] Applicant did not seek an extension prior to the due date for its objections and responses.[8]

Requests for admission are governed by Fed. R. Civ. P. 36, which provides that a matter is deemed admitted unless, within 30 days after being served, the adverse party serves its answers and objections on the requesting party.

> A matter admitted under this rule is conclusively established unless the [Board], on motion, permits the admission to be withdrawn or amended.... [T]he [Board] may permit withdrawal or amendment if it would promote the presentation of the merits of the action and if the

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[2] 8 TTABVUE.

[3] 10 TTABVUE. The Board struck certain affirmative defenses during the discovery conference. *See* 12 TTABVUE 4-7.

[4] 12 TTABVUE 8.

[5] 13 TTABVUE 47.

[6] *Id.* at 41.

[7] *See* Trademark Rule 2.120(a)(3); 37 C.F.R. § 2.120(a)(3); *see also* Fed. R. Civ. P. 36(a)(3).

[8] 13 TTABVUE at 21.

> [Board] is not persuaded that it would prejudice the requesting party in maintaining or defending the action on the merits.

Fed. R. Civ. P. 36(b).

Applicant seeks to either reopen its time to serve its admission responses arguing there is excusable neglect for its late response; or to have the Board permit withdrawal or amendment of its deemed admissions. Applicant's arguments are supported by the declaration of Applicant's attorney.[9]

In response, Opposer argues that Applicant cannot show excusable neglect for failing to timely serve its responses and that the Board should exercise its discretion to "confirm" that the requests for admission have been admitted.[10] Opposer also argues that Applicant's objections to admission requests are waived, that certain of the admission responses are insufficient and that Applicant's counsel failed to timely respond to discovery in an unrelated third party proceeding. Opposer's arguments are supported by the declaration of Opposer's attorney.[11]

Opposer's motion, filed the same date,[12] to withdraw its response brief and replace it with a new one to correct typographical errors in the original is **granted** as conceded. Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a).

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[9] *Id.* at 20-21.

[10] 17 TTABVUE 5-9.

[11] *Id.* at 16-18.

[12] 16 TTABVUE.

II. Analysis

Applicant first argues there is excusable neglect for its failure to timely serve admission responses. Applicant's counsel admits in his declaration that the admission responses are late, and that Applicant's counsel did not reach out to Opposer's counsel to seek an extension of time to respond, but argues that counsel was, "dealing with a number of personal items at the end of March 2022, including kids being sick and preparing to move to a new house," which led Applicant's counsel to lose track of the deadline to serve discovery responses, and that there were delays in communicating with Applicant who resides in China.[13]

In the alternative, Applicant argues withdrawal or amendment of the deemed admissions will "subserve the presentation on the merits," of this action, and that Opposer will not be prejudiced thereby.

A. Legal Standard

Requests for admission that are not responded to within the 30-day timeframe are deemed admitted by operation of Fed. R. Civ. P. 36(a). *Fram Trak Indus. v. Wiretracks LLC*, 77 USPQ2d 2000, 2005 (TTAB 2006) (requests for admissions deemed admitted by respondent's failure to respond to petitioner's requests for admissions). The Board has previously distinguished between the two separate avenues for requesting relief where admissions have been deemed admitted, namely a motion to reopen the time to respond to the requests for admission upon a showing of excusable neglect pursuant to Fed. R. Civ. P. 6(b)(1)(B); or a tacit admission that the responses are late,

[13] 13 TTABVUE 5 and 21.

and thus deemed admitted, but the party seeks to withdraw and amend the deemed admissions pursuant to Fed. R. Civ. P. 36(b). *See Giersch v. Scripps Networks, Inc.*, 85 USPQ2d 1306, 1307 (TTAB 2007).

B. Applicant Has Not Shown Excusable Neglect

Applicant first seeks to reopen its time for serving its responses to requests for admission, arguing its failure to timely respond is the result of excusable neglect. A showing of excusable neglect under Fed. R. Civ. P. 6(b) requires a showing that the proper steps were not taken at the proper time due to some unexpected or unavoidable circumstance or accident, or in reliance on counsel or promises made by the adverse party. A party's, or its counsel's, own carelessness, inattention or willful disregard of the Rules will not suffice. *See Gaylord Entm't Co. v. Calvin Gilmore Prods., Inc.*, 59 USPQ2d 1369, 1373 (TTAB 2000) (counsel's inaction was within party's reasonable control and does not constitute excusable neglect).

The Board analyzes excusable neglect as set forth by the Supreme Court in *Pioneer Inv. Svcs. Co. v. Brunswick Assocs. L.P.*, 507 U.S. 380, 395 (1993), adopted by the Board in *Pumpkin Ltd. v. Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997). These cases hold that the excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay, including (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.

In this instance, the length of the delay is not significant, nor is there prejudice to Opposer. Opposer alleges bad faith in Applicant's counsel's "pattern" of failing to timely respond to discovery requests based on alleged inaction in a single separate Board proceeding involving unrelated third parties. The record is not sufficient to establish Applicant acted in bad faith, and there is no evidence that Applicant's failure to timely serve its admission responses was in bad faith. Accordingly, the first, second and fourth factors are neutral.

The Board, in its discretion, can consider the circumstances of the case when weighing and balancing the factors, and need not necessarily weigh the factors equally. *See. e.g., FirstHealth of the Carolinas, Inc. v. CareFirst of Maryland, Inc.,* 479 F.3d 825, 81 USPQ2d 1919, 1921-22 (Fed. Cir. 2007) (affirming Board's finding of no excusable neglect based on second and third Pioneer factors, with third weighted heavily in the analysis).

In this case, the Board finds Applicant has not shown excusable neglect. Applicant's counsel's "personal" reasons for delay, sick children and preparation for a move, are insufficient to establish excusable neglect for counsel's failure to timely respond to admission requests, nor has counsel explained why others in the firm could not have taken responsibility. *See Id.*, 81 USPQ2d at 1922 (to extent attorney's family matters caused delay, no excusable neglect where no explanation as to why other members of firm could not assume responsibility).

Counsel knew the deadlines under the Rules, and should, at a minimum, have sought an extension prior to the deadline, either from adverse counsel or through a

filing with the Board. *See Vital Pharmaceuticals, Inc. v. Kronholm*, 99 USPQ2d 1708, 1711 (TTAB 2011) (party's inaction or delay will not excuse compliance with Rules); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (counsel's press of other business, docketing errors and misreading of relevant rule are circumstances wholly within counsel's control). Balancing all of the factors, the Board finds that Applicant has not shown excusable neglect.

Accordingly, Applicant's motion based on excusable neglect pursuant to Fed. R. Civ. P. 6(b) is **denied**.

C. Applicant's Effective Admissions May Be Withdrawn and Amended

Turning next to Applicant's motion to withdraw its effective admissions and substitute its new responses, the Board may permit withdrawal or amendment of the admissions if it would promote presentation of the case on the merits and would not prejudice the requesting party in maintaining the action. Fed. R. Civ. P. 36(b). Rule 36 is unconcerned with the circumstances giving rise to excusable neglect and focuses instead on the consequences of allowing withdrawal of the deemed admissions. *See Hobie Designs, Inc. v. Fred Hayman Beverly Hills, Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (Fed. R. Civ. P. 36(b) provides method for obtaining relief where failure to timely respond to admission requests has harsh result).

In applying the first part of the test under Fed. R. Civ. P. 36(b), the Board looks to whether withdrawal of the admissions "facilitates the development of the case in reaching the truth." *Giersch*, 85 USPQ2d at 1308 (quoting *Farr Man & Co. v. M/V Rozita*, 903 F.2d 871, 876 (1st Cir. 1990)). When applying the second part of the test,

whether withdrawal or amendment would prejudice the party requesting the admissions, the type of prejudice contemplated by the Rule relates to "special difficulties," such as the unavailability of witnesses or evidence. *Giersch*, 85 USPQ2d at 1308 (quoting *Kerry Steel, Inc. v. Paragon Indus., Inc.*, 106 F.3d 147 (6th Cir. 1997)). Increased expenses caused by the need for discovery or additional time to seek discovery, are not by themselves considered prejudicial. *Id.* However, even where a party has satisfied the two-factor test, discretion remains with the Board to deny a request to withdraw or amend an admission. *SARL Corexco v. Webid Consulting Ltd.*, 110 USPQ2d 1587, 1589 (TTAB 2014).

In this instance, the Board finds that the merits of the action will be subserved by allowing withdrawal and amendment of the admissions since those admissions largely form the factual and legal basis for the case. *See Johnston Pump/Gen. Valve, Inc. v. Chromalloy Am. Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989) (presentation of merits of case aided by withdrawal of effective admissions). To allow the effective admissions to remain where this proceeding is in the early stages would have a harsh result. Further, the Board finds that Opposer will not be prejudiced by withdrawing the effective admissions and allowing substitution of the later-served responses given the short time that has elapsed and that discovery is still ongoing. *Id.* (motion to withdraw admissions granted where case was still in pretrial stage).

Accordingly, Applicant's motion to withdraw or amend its admission responses under Fed. R. Civ. P. 36(b) is **granted**.

D. Opposer's Arguments Regarding Waiver of Objections and Sufficiency of Substituted Admissions

Opposer argues in the alternative that the Board should find Applicant's objections are waived and that the substituted admission responses are insufficient. In reply, Applicant argues that the waiver of objections is not automatic and Opposer should not be allowed to treat its response to the motion as a motion to test the sufficiency of the admissions as Applicant cannot properly respond in a reply brief.

The Board declines to treat Opposer's arguments as a cross-motion to test the sufficiency of Applicant's responses because, as with motions to compel, such a motion requires a written statement from the moving party showing a good faith effort to resolve the issues presented in the motion. Trademark Rule 2.120(i)(1), 37 C.F.R. § 2.120(i)(1). As the amended admission responses were provided with the motion to withdraw and amend, Opposer has not had, nor does it allege, an opportunity to make an effort to resolve the issues.

III. Schedule

Proceedings are resumed. Dates are reset as set out below.

Expert Disclosures Due	12/7/2022
Discovery Closes	1/6/2023
Plaintiff's Pretrial Disclosures Due	2/20/2023
Plaintiff's 30-day Trial Period Ends	4/6/2023
Defendant's Pretrial Disclosures Due	4/21/2023
Defendant's 30-day Trial Period Ends	6/5/2023
Plaintiff's Rebuttal Disclosures Due	6/20/2023
Plaintiff's 15-day Rebuttal Period Ends	7/20/2023
Plaintiff's Opening Brief Due	9/18/2023
Defendant's Brief Due	10/18/2023
Plaintiff's Reply Brief Due	11/2/2023

Request for Oral Hearing (optional) Due 11/12/2023

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, 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).