

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Baxley

Mailed: August 5, 2006

Cancellation No. 92044660

Kaman Music Corp.

v.

Gibson Guitar Corp.

Before Hohein, Drost and Cataldo,
Administrative Trademark Judges

By the Board:

Pursuant to the Board notice (issued June 22, 2005) instituting the above captioned proceeding, the discovery period in this proceeding closed on January 9, 2006 and petitioner's testimony period herein closed on April 9, 2006.¹

On May 12, 2006, i.e., after the commencement of respondent's testimony period, petitioner filed a combined motion to compel discovery and to reopen the discovery period. The Board, in a May 16, 2006 order, denied the

¹ The Board notice instituting this proceeding erroneously identified Fleet Capital Corporation as the party defendant herein. In a June 28, 2005 order, the Board substituted respondent, the record owner of the involved registration, as the party defendant. Although the June 28, 2005 order set forth a discovery and trial schedule that called for an earlier close of discovery and testimony periods, the parties have followed the discovery and trial schedule set forth in the June 22, 2005 institution order throughout this proceeding.

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motion to compel as untimely because it was filed after the commencement of trial herein and suspended proceedings pending disposition of the motion to reopen the discovery period. Respondent has filed a brief in response to opposer's combined motion.

In support of its motion, petitioner contends that it served its first set of interrogatories, document requests and requests for admission on December 22, 2005; that respondent served responses to the interrogatories and requests for admission on January 20, 2006 and served responses to the document requests on January 23, 2006; that respondent produced copies of certain documents and agreed to produce certain other documents withheld upon claim of privilege once an acceptable protective order had been executed; and that, after respondent executed the protective order on February 22, 2006, respondent refused to produce the documents at issue; that, "in the latter half of April, 2006," respondent indicated that it would agree to reopen the discovery period and produce the documents at issue, provided that petitioner agreed to a sixty-day suspension of proceedings; and that, when petitioner refused to agree to such suspension, respondent refused to produce the documents at issue. Based on the foregoing, petitioner asks that the Board reopen the discovery period for an unspecified time.

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In response, respondent contends that it has produced 408 pages of documents and withheld only seventeen pages of documents under claim of privilege, while petitioner has yet to produce any documents in this proceeding; that petitioner is not entitled to a reopened discovery period because petitioner waited until the waning days of the discovery period to serve its first written discovery requests; that petitioner has failed to explain why it took no action with regard to the withheld documents until after its testimony period closed; that petitioner took no testimony and filed no evidence during its testimony period; that petitioner's characterization of respondent's actions as a "broken promise" and an attempt to coerce respondent into a suspension is "inaccurate and insulting;" that petitioner only requested that respondent agree to reopening the discovery period after the close of petitioner's testimony period; that, in response, respondent indicated that it would agree to such reopening, provided that proceedings were first suspended for sixty days for settlement negotiations; and that petitioner would not agree to such suspension. Based on the foregoing, respondent contends that petitioner has failed to make the requisite showing that its failure to timely act was the result of excusable neglect.

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Inasmuch as the discovery period and petitioner's testimony period had closed when petitioner filed its motion, petitioner must show that its failure to timely act was the result of excusable neglect. In *Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), the Supreme Court clarified the meaning and scope of "excusable neglect," as used in the Federal Rules of Civil Procedure and elsewhere. The Court held that the determination of whether a party's neglect is excusable is:

at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include. . . [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.

Pioneer Investment Services Co. v. Brunswick Associates L.P., 507 U.S. at 395. In subsequent applications of this test, several courts have stated that the third *Pioneer* factor, namely the reason for the delay and whether it was within the reasonable control of the movant, might be considered the most important factor in a particular case. See *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 at 1586, fn.7 and cases cited therein.

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With regard to the third *Pioneer* factor, petitioner could have sought Board intervention with regard to respondent's failure to produce the documents at issue by filing a motion to compel prior to the commencement of trial on March 11, 2006. See Trademark Rule 2.120(e)(1); TBMP Section 523 (2d ed. rev. 2004). In addition, petitioner could have filed a motion to extend testimony periods prior to the close of its testimony period on April 9, 2006 so that the parties could attempt to resolve the discovery dispute without Board intervention. See Fed. R. Civ. P. 6(b); TBMP Section 509.01 (2d ed. rev. 2004). However, petitioner did not file either such motion at the appropriate time and has not explained why it failed to so file.² Thus, the third *Pioneer* weighs against a finding of excusable neglect.

We turn next to the second *Pioneer* factor, the length of the delay and its impact upon this proceeding. If the Board were to reopen the discovery period for two months, final briefing on the merits would be delayed by roughly one year. Even if the Board were to reopen only petitioner's

² After the close of petitioner's testimony period, respondent offered petitioner a means of avoiding the consequences of petitioner's failure to take testimony or file evidence during such period when it indicated that it would agree to reopening the discovery period so long as proceedings herein were first suspended for sixty days for settlement negotiations. Inasmuch as respondent made such offer after this proceeding had become ripe for dismissal under Trademark Rule 2.132(a) due to petitioner's failure to prosecute, we are puzzled by petitioner's rejection of that offer.

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testimony period, final briefing on the merits would be delayed by several months. As such, the impact of petitioner's failure to take appropriate action in a timely manner is significant in that such failure has disrupted the orderly administration of this case. Accordingly, the second *Pioneer* factor weighs against a finding of excusable neglect.

With regard to the first *Pioneer* factor, we note that petitioner waited until less than three weeks remained in the discovery period to serve its first written discovery requests in this proceeding and that, accordingly, respondent's responses thereto were not due until after the close of the discovery period. As such, we find that reopening the discovery period would prejudice respondent by permitting petitioner to take follow-up discovery that would not have been allowed because of the timing of service of petitioner's first written discovery requests.

Further, reopening only petitioner's testimony period would allow petitioner a second opportunity to offer testimony and evidence, which may be time consuming and costly to respondent. Respondent will also have lost any advantage that respondent gained due to petitioner's failure to take testimony or present other evidence during its testimony period. Thus, the first *Pioneer* factor weighs against a finding of excusable neglect.

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With regard to the fourth *Pioneer* factor, we find that there is no evidence of bad faith on the part of petitioner. Thus, the fourth factor is neutral.

Based on the foregoing, we find that petitioner has failed to show that its failure to timely act was the result of excusable neglect. The motion to reopen the discovery period is therefore denied.

Petitioner's testimony period has expired, and petitioner has taken no testimony or submitted any other evidence.³ Accordingly, the petition to cancel is hereby dismissed with prejudice. See *Gaylord Entertainment Co. v. Calvin Gilmore Productions, Inc.*, 59 USPQ2d 1369 (TTAB 2000).

³ Moreover, we note that petitioner has failed to produce any documents in response to respondent's document requests. When a party, without substantial justification, fails to disclose information required, that party may be prohibited at trial from using as evidence the information not so disclosed. See Fed. R. Civ. P. 37(c)(1).