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

Proceeding	92044660
Party	Plaintiff KAMAN MUSIC CORP  ,
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**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 2,860,682: LPX

Date of Issue: July 6, 2004

KAMAN MUSIC CORPORATION,	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No. 92044660
	)	
GIBSON GUITAR CORP.	)	
	)	
Respondent.	)	

**PETITIONER’S MOTION AND MEMORANDUM IN SUPPORT OF MOTION FOR  
RECONSIDERATION OF THE FINAL DECISION DISMISSING THE PROCEEDING  
WITH PREJUDICE**

Kaman Music Corporation (“Kaman Music”) hereby submits its Motion and Memorandum In Support Of Motion for Reconsideration of the Final Decision Dismissing the Proceeding With Prejudice. Kaman Music seeks an order vacating the Board’s August 5, 2006, Order (the “Order”) denying Kaman Music’s Motion To Reopen Discovery Period And To Compel Production Of Documents (the “Motion to Reopen”) and dismissing Kaman Music’s Petition, with prejudice. Kaman further seeks to reopen the testimony and briefing periods. The instant Motion is filed pursuant to 37 C.F.R. § 2.129(c) and TBMP § 543.

Kaman Music respectfully requests reconsideration of the Order because the Order is based upon the incorrect conclusion that Kaman Music failed to demonstrate excusable neglect, as required by TBMP § 509.01(b)(1) and *Pioneer Investment Services Co. v. Brunswick Assoc. Ltd. Partnership*, 507 U.S. 380, 395 (1993). More particularly, the evidence of record does not support the findings in the Order that:

- Kaman Music failed to sufficiently explain why it did not seek to extend the discovery and testimony periods prior to their expiration, Order, p. 5;
- Kaman Music sought to reopen the discovery period for an unspecified time, which would unreasonably delay disposition of this matter, Order, pp. 2, 5 – 6;
- Kaman Music and Respondent Gibson Guitar Corp. (“Gibson”) are not in a position to present evidence and proceed with this case, Order, p. 6, p. 7 n. 3;
- Respondent Gibson Guitar Corp. (“Gibson”) will be prejudiced if the discovery period is reopened because Kaman Music will have an opportunity to conduct additional discovery.

Instead, the evidence of record supports a finding that Kaman Music promulgated timely discovery, worked with Gibson in a good faith attempt to resolve the discovery disputes that had arisen between them without involving the Board and only sought the Board’s assistance when it appeared that negotiations had failed. When considered as a whole, Kaman Music’s actions demonstrate excusable neglect.

After the Motion to Compel was filed, Kaman Music and Gibson resolved their discovery dispute.<sup>1</sup> As a result, Kaman Music produced Three Thousand Fifty (3,050) pages of responsive documents, representing the documents upon which Kaman Music intends to rely during the testimony periods, while Gibson produced the seventeen (17) pages of previously withheld documents.<sup>2</sup>

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<sup>1</sup> The discovery dispute revolved around two issues. First, Gibson disagreed with Kaman Music’s decision, based upon the very large number of responsive documents, to produce its documents for inspection instead of producing copies. Second, Gibson was withholding certain key documents that it claimed were confidential.

<sup>2</sup> The seventeen (17) pages of documents Gibson withheld from its original production were critical to the central issue of this proceeding, as they contained information relating to sales Gibson may have made of products bearing the LPX mark.

Kaman Music did not seek the Board’s assistance prior to the filing of the Motion to Compel because it was attempting to resolve this matter without involving the Board. Kaman Music anticipated that a resolution of the discovery dispute would include an agreement regarding the testimony periods and, if necessary, the discovery deadline. It was only after the parties appeared unable to resolve their dispute that Kaman Music resorted to seeking Board involvement. In other words, Kaman Music’s failure to act earlier was the product of its good faith efforts to resolve the discovery dispute.

With the discovery dispute resolved, Kaman Music seeks to prosecute its claims based on the documents produced by both parties.<sup>3</sup> For that reason, Kaman Music respectfully requests that the Board reconsider the Order by vacating the dismissal and allowing Kaman Music and Gibson to present respective testimony and briefs.

## I. ARGUMENT

37 CFR § 2.129(c) and TBMP § 543 provide that “[a]ny request for rehearing or reconsideration or modification of a decision issued after final hearing must be filed within one month from the date of the decision.” The purpose of a Motion for Reconsideration is to demonstrate that, “based on the evidence properly of record and the applicable law, the Board’s ruling is in error and requires appropriate change.” TBMP § 543.

The evidence of record and applicable law support reconsideration of the Order. Kaman Music’s Motion to Reopen was governed by the provisions of TBMP § 509.01(b)(1), which provides that

[w]here the time for take required action, as originally set for as previously reset, has expired, a party desiring to take the required action must file a motion to reopen the time for taking that action.

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<sup>3</sup> Neither Kaman Music nor Gibson noticed **any** discovery or trial depositions.

The movant must show that its failure to act during the time previously allotted therefore was the result of excusable neglect.

TBMP § 509.01(b)(1).

In order to establish the excusable neglect needed to reopen an expired period, the moving party must take into account (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 Assoc. Ltd. Partnership*, 507 U.S. 380, 395 (1993); *see also* TBMP § 509.01(b)(1) (articulating the *Pioneer* factors and expressly adopting them in the context of a proceeding before the Board).

The Board found no evidence that Kaman Music had acted in bad faith. Order, p. 7. However, the Board gave little weight to this factor, focusing instead on the reason for the delay, its impact upon the proceeding and the potential prejudice to Gibson. *Id.* at pp. 4 – 6. In view of the Board’s finding that Kaman Music did not act in bad faith, dismissal with prejudice is too harsh a disposition, particularly where, as here, the evidence of record supports a finding of excusable neglect.

The evidence of record before the Board establishes that the delay was caused by a discovery dispute between the parties. Motion to Reopen, p. 2 – 5. The evidence of record further reflects that Kaman Music did not seek to involve the Board earlier because it was attempting to resolve the discovery dispute without the necessity of involving the Board. *Id.* Kaman Music’s good faith efforts recognize that the Board prefers that parties resolve discovery disputes themselves, instead of involving it in time-consuming and expensive discovery disputes.

The parties continued their negotiations even after Kaman Music filed the Motion to Compel. As a result, the parties resolved their dispute. Kaman Music produced copies of three

thousand fifty (3,050) documents, representing the documents upon which it intends to rely. Gibson has produced the seventeen (17) documents it withheld. As a result, both parties are in a position to proceed with the testimony and briefing periods. The resolution and document exchange occurred before the Board's Order, which reflects Kaman Music's continuing attempts to resolve the discovery dispute in good faith.

The resolution of the discovery dispute addresses the Board's concerns regarding the delay that will arise if the discovery period is reopened, and the prejudice that will befall Gibson if Kaman is allowed a second round of discovery. Order, pp. 5 – 6. Kaman Music sought to reopen the discovery period in order to compel production of Gibson's withheld documents. Kaman Music did not, and does not, seek any additional discovery; rather, it merely seeks to argue the merits of its case based upon the discovery conducted to date. Gibson will have the opportunity to do the same. Thus, Gibson will not be prejudiced if the Board vacates the Order.

The evidence does not support a finding that Gibson will suffer any other prejudice if the Board vacates the Order. Under this Board's decisions, prejudice is more than mere inconvenience or delay, or even the lack of tactical advantage occasioned by the delay or omission. Instead, prejudice occurs where the delay results in the unavailability of witnesses or evidence that would otherwise have been available to the nonmovant.

Kaman Music has complied with the parties' agreement to resolve the discovery by producing copies of three thousand fifty (3,050) documents, comprising the documents upon which it intends to rely during the testimony and briefing periods. All of the witnesses who were available at the start of the discovery dispute remain available. Consequently, under the Board's own definition of prejudice, none has occurred.

The Board focused upon the impact that a reopened discovery period would have upon the proceeding. Order, p. 5. Due to the resolution of the discovery dispute and the parties' exchange of their documents, it is no longer necessary to reopen the discovery period. Instead, the parties may proceed directly to the testimony and briefing period. Thus, while the proceeding was delayed by the discovery dispute, it may still proceed in an efficient manner that allows a just adjudication on the merits.

Based on the foregoing, Kaman Music respectfully requests that the Board vacate the Order, reset the testimony and briefing periods and allow this matter to proceed on its merits.

**A. KAMAN MUSIC DID NOT SEEK THE BOARD'S ASSISTANCE IN RESOLVING THE PARTIES' DISCOVERY DISPUTE BECAUSE IT WAS MAKING A GOOD FAITH ATTEMPT TO RESOLVE THE DISPUTE WITHOUT INVOLVING THE BOARD.**

The Order questions the reasons that Kaman Music did not seek the Board's assistance in resolving the dispute, or seek to extend the discovery period, prior to its expiration. Order, p. 5 (second *Pioneer* factor requires the moving party to demonstrate the reason for the delay and whether it was under the party's control). As set forth in the Motion to Compel, Kaman Music did not seek the Board's assistance prior to filing the Motion to Compel because it was attempting to resolve this matter without involving the Board. Kaman Music is cognizant of the Board's statement that "[t]he Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, and looks with extreme disfavor on those that do not." TBMP § 401. Kaman Music also sought to comply with the provisions of 37 C.F.R. 2.120(e) and TBMP § 523.02, which require the moving party in a discovery dispute to certify that they have made a good faith attempt to resolve the issues presented in the motion, and that their efforts have been unsuccessful.

Kaman Music is pleased to report to the Board that the parties' good faith efforts were successful. In particular, on May 30, 2006, Gibson agreed to limit its document requests to the documents that Kaman Music intended to rely upon during the testimony periods. Kaman Music worked diligently to separate these documents from the tens of thousand of documents that could have been responsive to Gibson's original document requests, and to copy and Bates stamp them. As a result, on June 18, 2006, Kaman Music produced copies of approximately Three Thousand Fifty (3,050) documents to Gibson. These documents, together with the documents produced by Gibson, comprise the documents upon which Kaman Music intends to rely.

Kaman Music apologizes to the Board for the inconvenience it created. In its defense, Kaman Music agrees that may have relied too much on the parties' obligations to negotiate discovery disputes in good faith, and its expectation that the parties would be able to resolve their dispute, but Kaman Music did so in an attempt to resolve this matter without Board involvement, and ultimately succeeded.<sup>4</sup> Kaman Music did not intend to delay the proceeding, or to violate Board procedures. Instead, Kaman Music was motivated by a desire to resolve the discovery dispute efficiently and without engaging in protracted motion practice. Kaman Music did not want to prematurely request extension or reopening of the testimony period when Kaman Music could not predict when and if the discovery dispute would be resolved, but Kaman Music now understands that the Board would have preferred such a request regardless.

Dismissing the proceeding with prejudice will deny Kaman Music the opportunity to present its case, and utterly negate its good faith efforts to comply with the Board's admonitions

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<sup>4</sup> Kaman did not agree to Gibson's proposed sixty (60) day suspension and resetting of the discovery and testimony periods because, in Kaman Music's view, the proposal still did not resolve the dispute. While it is true that the discovery and testimony periods would have reopened, the parties still had not agreed upon a resolution of the discovery dispute. Kaman Music sought to avoid the further delay that would have arisen if the parties had suspended the proceeding, reset the discovery and testimony deadlines, and **still** been unable to resolve their dispute.



regarding parties' conduct during discovery disputes. For that reason, Kaman Music respectfully requests that the Board vacate the dismissal.

The resolution of the discovery dispute eliminates the need to reopen the discovery period. Accordingly, if the Board vacates the Order, the Board need only reopen and reset the testimony periods to allow this matter to proceed on its merits.

**B. KAMAN MUSIC DID NOT SEEK TO REOPEN THE DISCOVERY PERIOD FOR THE PURPOSE OF CONDUCTING ADDITIONAL DISCOVERY; RATHER, IT MERELY SOUGHT TO COMPEL PRODUCTION OF DOCUMENTS PREVIOUSLY REQUESTED.**

The Order states that that Kaman Music seeks to reopen discovery for an “unspecified time,” Order, p. 2, and finds that doing so would cause an undue delay in the proceeding. *Id.* at p. 5 – 6 (second *Pioneer* factor is the length and impact of the delay on the proceeding). Kaman Music respectfully suggests that the evidence of record does not support a finding that the length of the delay supports dismissal of the proceeding with prejudice.

Kaman Music sought to reopen the discovery period for the **limited** purpose of seeking an order compelling Gibson to produce documents responsive to Kaman Music's pre-existing discovery<sup>5</sup>, and which Gibson had refused to produce. Kaman Music did not seek, and does not intend to seek, permission to conduct additional discovery. Rather, all that Kaman Music sought was the Board's assistance in obtaining documents that it requested before the close of the original discovery period.

With the discovery dispute resolved, reopening the discovery period is not necessary. Instead, having received Gibson's documents and provided its own, Kaman Music is fully prepared to proceed with its testimony period. Kaman Music respectfully requests that the Board

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<sup>5</sup> Requesting that the discovery period be reopened was necessary for obtaining an order to compel production of documents. *See* TBMP § 523.03.

vacate the Order so that the testimony periods may be reopened and reset and Kaman Music may have the opportunity to present the merits of its case.

**C. THE RESOLUTION OF THE PARTIES' DISCOVERY DISPUTE PLACES KAMAN MUSIC AND GIBSON IN A POSITION TO PROCEED ON THE MERITS OF THEIR CASE.**

The Order states that Kaman Music's alleged failure to produce copies of responsive documents would prohibit it from relying upon those documents at trial. Order, p. 7 n. 3. Kaman Music respectfully suggests that the statements regarding Kaman Music's production of documents do not reflect the events that lead to the discovery dispute.

Kaman Music **never** refused to produce documents. Kaman Music's Responses to Gibson's Documents Requests, which were served in November 2005, indicate that Kaman Music would produce documents for inspection at a mutually convenient time. *See* Motion to Compel, Exhibit B; *see also* Motion to Compel, Exhibit G (letter reiterating that Kaman Music would make responsive documents available for inspection. Gibson never provided any dates for a document inspection, instead demanding that Kaman Music prepare and provide photocopies of all responsive documents.

Kaman Music's offer to produce documents for inspection, rather than producing copies, fully complies with the Board's rules. In particular, 37 CFR § 2.120(d)(2) and TBMP § 406.03, which provides that document requests shall comply with Fed. R. Civ. P. 34, provides that

[t]he production of documents and things under the provisions of Rule 34 of the Federal Rules of Civil Procedure **will be made at the place where the documents and things are usually kept**, or where the parties agree, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.

37 C.F.R. § 2.120(d)(2); TBMP § 406.03 (emphasis supplied).

Gibson's discovery requests sought tens of thousands of documents generated over several decades. Kaman Music's offer to allow inspection of the documents complies with this Board's rules, and was intended to minimize the burden and tremendous expense that all parties would incur if the documents were copied. This was particularly true since there appears to be no dispute that Kaman Music's family of "LP" marks predates Gibson's LPX mark by decades, or that Kaman Music and its predecessor were using the family of "LP" marks across a broad range of musical products.

Kaman Music served its discovery responses on November 15, 2005. Gibson never provided or requested dates for an inspection, and thus did not receive documents until the parties resolved their discovery dispute. It is manifestly unfair to penalize Kaman Music because of this, particularly since Kaman Music stood ready to produce its documents for inspection from the time of its initial discovery responses, and, upon resolution of the discovery dispute, promptly produced copies of the agreed upon documents.

**D. GIBSON WILL NOT BE PREJUDICED IF THE ORDER IS VACATED.**

The Order states that dismissal is appropriate because Gibson may be prejudiced if Kaman Music is "offered a second opportunity to offer testimony and evidence, which may be time consuming and costly to respondent." Order, p. 6. Kaman Music respectfully disagrees that Gibson will suffer any prejudice if the Order is vacated.

The Board found that Gibson would suffer prejudice if Kaman Music is allowed "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." Order, p. 6.

Prior decisions of this Board support a finding that delay, inconvenience and even the loss of a tactical advantage do not constitute prejudice within the meaning of the first *Pioneer* factor. See *Pumpkin Ltd. v. The Seed Corps*, 43 U.S.P.Q.2d 1582, 1587 (T.T.A.B. 1997); see also TBMP § 509.01(b). In *Pumpkin Ltd.*, the Board held that the “prejudice to the nonmovant” contemplated under the first *Pioneer* factor must be more than the mere inconvenience and delay caused by the movant’s previous failure to take timely action, and more than the nonmovant’s loss of any tactical advantage which it otherwise would enjoy as a result of the movant’s delay or omission. Rather, “prejudice to the nonmovant” is prejudice to the nonmovant’s ability to litigate the case, e.g., where the movant’s delay has resulted in a loss or unavailability of evidence or witnesses which otherwise would have been available to the nonmovant. TBMP § 509.01(b).

The evidence of record does not support a finding that Gibson has been prejudiced within the meaning of *Pumpkin Ltd.* In particular, there has been loss of evidence, and all of witnesses remain available. The fact that Gibson may lose a tactical advantage cause by the discovery dispute, as well as the delay and inconvenience that may arise if this matter proceeds on the merits, do not constitute prejudice under *Pumpkin*, *Pioneer* or the TBMP. Accordingly, the Board should find that Gibson will not be prejudiced if the Order is vacated.

The Order suggests that Gibson will be prejudiced if Kaman Music a second opportunity to offer testimony and evidence. Kaman Music respectfully suggests that this is not the case. Due to the discovery dispute, Kaman Music was not able to present testimony and evidence because it has not yet received crucial documents. Thus, there will be no opportunity for Kaman Music to obtain a second bite at the apple

Vacating the Order will not impose any additional costs upon Gibson. Instead, both parties will be permitted nothing more than what they would have been allowed to do if the

dispute had not occurred. Indeed, the resolution of the discovery dispute saved all of the parties the considerable expense of a lengthy inspection of tens of thousands of documents.

Accordingly, the evidence supports a finding that Gibson will not suffer any prejudice if the Board vacates the Order.

Kaman Music, on the other hand, will suffer extreme prejudice if the Order is not vacated. Kaman Music worked in good faith to resolve the discovery disputes, and promptly provided the relevant copies of its documents once the dispute was resolved. Kaman Music recognizes that it should have moved to compel, or to extend the discovery and testimony periods, at the same time that it was attempting to resolve the discovery dispute, and apologizes for not doing so earlier. However, dismissing Kaman Music's petition with prejudice, particularly in view of the parties' resolution of the discovery dispute, is too harsh. For that reason, Kaman Music respectfully requests that the Board vacate the Order, reopen and reset the testimony and briefing periods, and allow the case to proceed to a decision on the merits.

## **II. CONCLUSION**

The evidence of record and the law both support a finding that Kaman Music's failure to seek an extension of the discovery and testimony periods constitutes excusable neglect under *Pioneer* and TBMP § 509.01(b)(1). Kaman Music attempted to comply with the Board's clearly established policy of encouraging parties to resolve discovery disputes without involving the Board. Kaman Music accepts that it should have involved the Board earlier, and will do so in the future. However, dismissing the proceeding with prejudice due to this error is too harsh of a result, especially in view of the Board's recognition that Kaman Music has operated in good faith throughout this proceeding.

The discovery dispute that led to the dismissal has been resolved. Kaman Music and Gibson have exchanged their documents, and there is no reason that the case cannot proceed through the testimony and briefing periods. Gibson will not suffer any prejudice if this occurs. Accordingly, Kaman Music respectfully requests that the Board vacate the August 5, 2006, Order dismissing the case with prejudice, reopen and reset the testimony periods and allow the case to proceed on its merits.

THE PETITIONER  
KAMAN MUSIC CORP.

Date: September 4, 2006

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**CERTIFICATE OF SERVICE**

I, Daniel E. Bruso, Esq., counsel to Petitioner Kaman Music Corp. in the above-captioned proceeding, hereby certify that, on September 5, 2006, I served a copy of the foregoing document, via first class mail, postage prepaid, upon:

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/s/ Daniel E. Bruso