

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451

Butler

Mailed: July 18, 2007

Cancellation No. 92045530

P22 TYPE FOUNDRY, INC.

v.

BERTHOLD TYPES LTD./BERTHOD LLC

Before Bucher, Holtzman and Mermelstein, Administrative Trademark Judges.

By the Board:

In accordance with the institution order dated March 3, 2006, petitioner's first testimony period closed on December 18, 2006. This case now comes up on respondent's fully briefed motion, filed January 11, 2007, for involuntary dismissal pursuant to Trademark Rule 2.132(a), 37 C.F.R. 2.132(a).¹

In support of its motion, respondent argues that petitioner has not taken any testimony or offered any other evidence in this case.

In response, petitioner argues that its omission arose from a series of events beginning with communications initiated by respondent with the apparent intent to amicably resolve this trademark registration dispute compounded by unexpected technical

¹ Petitioner's consented motion, filed January 22, 2007, for an extension of time to file its response to respondent's motion for involuntary dismissal is granted. See Fed. R. Civ. P. 6(b)(1).

failures encountered as a consequence of the relocation of the office of petitioner's attorney. As background, petitioner indicates that shortly after commencing this cancellation proceeding its attorney was contacted by respondent's president to discuss settlement;² that petitioner prepared and forwarded a proposed settlement agreement; that a response, including a proposed amended settlement agreement, was received from one of respondent's principals whom petitioner believed was in-house counsel; and that telephone communications took place as well. Petitioner also notes that it served responses to respondent's discovery requests in mid-May 2006, though it delayed serving its own requests.

Petitioner's attorney states that he relocated his office May, 25 2006; that the relocation required about 35 days; that during this time period he experienced construction delays, computer crashes, and technical mishaps with the firewalls, data wiring, servers, and computer and telephone systems; and that the technical difficulties involved corruption of data files,

² Petitioner also recounts its difficulty in commencing a cancellation proceeding against the involved registrations. According to petitioner, its first petition to cancel, filed April 5, 2005, was either lost or misdirected. Petitioner refiled on March 3, 2006, resulting in the commencement of the instant action. In the meantime, petitioner was trying to remedy the problem with the first filing. Petitioner supports its experiences, in part, with copies of post cards with USPTO receipt dates stamped thereon and written correspondence with Board personnel. The Board instituted a duplicate cancellation proceeding, No. 92045583, which was eventually dismissed as a duplicate.

While petitioner's experiences in commencing this proceedings are no doubt regrettable, they are not relevant to its failure to take testimony or submit evidence during its assigned testimony period, scheduled approximately nine months after the commencement of this proceeding.

including those related to the docketing software. Petitioner notes that the various systems became inoperative or required repairs and that "they had to be partially reconstituted and errors arose." Petitioner indicates it acted promptly upon learning of the delay by contacting opposing counsel to seek an extension to file its response to respondent's motion.³

Petitioner contends, thus, that its failure to act was due to circumstances outside its reasonable control and, thus, due to excusable neglect.

Petitioner requests that the discovery period and its testimony period be reopened and all subsequent dates be reset. In addition, petitioner informs the Board that after the filing of the first petition to cancel but before the filing of the second, duplicate petition to cancel, respondent filed its combined Trademark Act §§8 and 15 affidavit, accepted and acknowledged by the Office, for Registration No. 2360169 (MICHELANGELO). Petitioner asks that the acceptance and acknowledgement be withdrawn. Petitioner also informs the Board that Registration No. 2290867 (ELF DEEPDENE) was cancelled for failure to file a Trademark Act §8 affidavit after commencement of the instant cancellation proceeding. Petitioner asks that the proceeding be dismissed as moot with respect to Registration No. 2290867.

Trademark Rule 2.132(a) provides that when the party in the position of plaintiff fails to take testimony during the time allowed, judgment may be entered against it in the absence of a showing of good and sufficient cause. The "good and sufficient cause" standard, in the context of this rule, is equivalent to the "excusable neglect" standard, which would have to be met by any motion under Fed. R. Civ. P. 6(b)(2) to reopen the plaintiff's testimony period. See *Grobet File Co. of America Inc. v. Associated Distributors Inc.*, 12 USPQ2d 1649 (TTAB 1989); and *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 216 USPQ 617 (TTAB 1982). See also TBMP §534 (2d ed. rev. 2004).

In *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin, Ltd. v. The Seeds 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

³ At that time, petitioner's attorney was advised that neither principal of respondent had informed respondent's outside counsel that the principals had been involved in settlement discussions.

of the movant, and [4] whether the movant acted in good faith." *Pioneer*, 507 U.S. at 395. In subsequent applications of this test by the Circuit Courts of Appeal, several courts have stated that the third factor must be considered the most important factor in a particular case. See *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 at fn.7 (TTAB 1997). It is true that this does not mean that the standard will be applied restrictively or that the movant's conduct must be faultless. See *Wright & Miller*, 4B Fed. Prac. & Pro. Civ.3d §1165 (2007). However, the party seeking the enlargement of time must present facts demonstrating excusable neglect, including that its failure to act was not due to circumstances within its reasonable control.

We look first at the first, second and fourth *Pioneer* factors. Except for the delay occasioned herein, there does not appear to be any measurable prejudice to respondent should the Board grant a reopening of the discovery period and reset the testimony periods. Respondent has made no showing of lost evidence or unavailable witnesses. Respondent will bear no significantly greater cost in defending this matter than it would have if petitioner had properly presented its case. See *HGK Industries, Inc. v. Perma-Pipe, Inc.*, 49 USPQ2d 1156 (TTAB 1998). In the meantime, respondent's registrations remain registered. The length of delay and impact to this proceeding are not inconsequential, however. There is no evidence that petitioner is acting in bad faith.

We consider next the third *Pioneer* factor, the circumstances attributed to the delay. Petitioner's activities of engaging in settlement discussions and responding to respondent's discovery requests prior to the relocation of its attorney show petitioner's active interest in the case. However, such circumstances, and the cessation of activities just prior to the relocation of petitioner's attorney, are all within the reasonable control of petitioner, including petitioner's decision to defer serving its own discovery requests believing that settlement would occur. See *Atlanta-Fulton County Zoo, Inc. v. De Palma*, 45 USPQ2d 1858 (TTAB 1998) (mere existence of settlement negotiations did not justify party's inaction or delay). Cf. *American Vitamin Products, Inc. v. Dow Brands, Inc.*, 22 USPQ2d 1313 (TTAB 1992) (desire to take follow up discovery does not excuse failure to file a timely motion to extend discovery).

The Board notes that the relocation of petitioner's attorney's legal business *per se* does not give rise to excusable neglect. See *Pioneer Investment Services*, 507 U.S. at 398 ("...we give little weight to the fact that counsel was experiencing upheaval in his law practice at the time ..."). Cf. *In re William B. Kessler, Inc.*, 29 B.R. 358, 359 (Bankr. S.D.N.Y. 1983) (excusable neglect found where confusion and relocation of a law office as well as the serious illness of the partner in charge at the time). Thus, the Board must look at the circumstances

arising from the relocation of petitioner's attorney, which include the unexpected systems failures and other construction delays resulting in corruption of the databases notwithstanding "repair."

Petitioner's attorney states he moved his office on May 25, 2006 and experienced construction delays and technical problems over the next thirty-five days and that the technical failures required repairs and reconstitution of data. Thus, the problems encountered took place between the end of May and the beginning of July 2006. However, petitioner fails to explain what transpired subsequent to the thirty-five days over which the move occurred that prevented petitioner from acting. The discovery period remained open until September 18, 2006, at least two months after the move period, and petitioner's testimony period closed December 18, 2006, at least five months after the move period. Petitioner's attorney has not explained what was done in advance of his move to back up his active files and calendar. No information has been provided as to what steps were taken after the move to ascertain if the records in question were completely reconstituted, especially since it is acknowledged that "errors arose" by virtue of the corrupted systems. No information has been provided as to what steps were taken subsequent to the repairs to find out what files remained corrupted and to minimize the effects of lost data in view of the recognition that "errors arose" during the move. For example, no mention has been made of

whether paper records were kept for active files and what happened to the hard copy of the Board's March 3, 2006 institution order setting all dates or whether petitioner or its attorney attempted to ascertain the status of pending matters by availing themselves of the USPTO's electronic systems.

It must be remembered that a plaintiff's failure to take testimony in Board proceedings is analogous to not showing up in court on the day of trial. In *Old Nutfield Brewing Company v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701 (TTAB 2002), no excusable neglect was found for the plaintiff's failure to take testimony and the plaintiff's motion to reopen its testimony period was denied. There was no question that the plaintiff knew about the proceeding. The plaintiff relied upon its failure to receive a copy of the defendant's answer and the parties' engagement in settlement discussions to excuse its failure to take testimony. However, plaintiff chose not to ascertain the status of the case until after its testimony period closed. The Board reminded the plaintiff that there are several avenues for ascertaining status of Board proceedings including the then-existing BISX information system maintained by the USPTO.

The Board has revised its status information database in recent years. BISX has been replaced with TTABVUE.⁴ In addition to the proceeding number, application number, and registration

⁴ TTABVUE is accessible at <http://ttabvue.uspto.gov/ttabvue/> and from the USPTO's home page, www.uspto.gov through numerous links, including "ebusiness."

number, status may be ascertained using various other search terms, including the name of any party, the name of the correspondent (attorney of record where applicable) and the name of the mark. This is an easy to use and free database maintained by the USPTO. It is urged that the status of Board proceedings be checked regularly by the parties and their attorneys using this system. Any party or practitioner experiencing a relocation or technical failures may avoid or minimize a situation such as that presented here if advantage is taken of the TTABVue information system.

In sum, though the Board has sympathy for petitioner and its attorney regarding the disruptions cause by the systems failures, insufficient information has been provided for the Board to conclude that the file for this case was permanently lost from the systems of petitioner's attorney and that steps taken to back up and retrieve the records without success during and after the move. Based on these circumstances of facts, we cannot find excusable neglect so as to warrant a reopening of petitioner's testimony period. Accordingly, petitioner's request to reopen the discovery and testimony periods is denied.

Insofar as Registration No. 2290867 (ELF DEEPDENE) was cancelled for failure to file a Trademark Act §8 affidavit after commencement of the instant cancellation proceeding, petitioner's request that this proceeding be dismissed as moot with respect to

such registration is granted. See Trademark Rule 2.134(b), 37 C.F.R. 2.134(b); and TBMP §535 (2d ed. rev. 2004). The petition to cancel is hereby dismissed as moot as to Registration No. 2290867.

Petitioner has taken no testimony and has offered no evidence of record upon which it may rely to prove its case. Accordingly, as to Registration Nos. 2289874 (EFL KENNERLY), 2360169 (MICHELANGELO) and 2624424 (MICHELANGELO), respondent's motion for involuntary dismissal is granted, and the petition to cancel is dismissed with prejudice.⁵

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⁵ In view of the dismissal, petitioner's request that the USPTO's acceptance and acknowledgement of respondent's combined Sections 8 and 15 affidavit for Registration No. 2360169 be withdrawn is denied.