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

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|------------------------|---|
| Proceeding             | 92058094  |
| Party                  | Plaintiff<br>The Zondervan Corporation L.L.C.   |
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| Date                   | 03/30/2015  |
| Attachments            | Opposition to Lightwave's Motion to Extend Discovery Deadline.pdf(64388 bytes )   |

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| <p>THE ZONDERVAN CORPORATION<br/>L.L.C.</p> <p style="text-align: center;">Petitioner,</p> <p style="text-align: center;">v.</p> <p>LIGHTWAVE PUBLISHING INC.,</p> <p style="text-align: center;">Respondent.</p> | <p>Cancellation No. 92058094</p><br><p>Reg. No. 4323349<br/>Filing Date: June 26, 2012<br/>Registration Date: April 23, 2013<br/>Mark: BOYS BIBLE</p> |
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**PETITIONER’S OPPOSITION TO RESPONDENT’S MOTION TO EXTEND EXPERT  
DISCLOSURES, DISCOVERY, AND TESTIMONY PERIOD**

The Zondervan Corporation L.L.C. (“Petitioner”) submits the following response to Lightwave Publishing Inc.’s (“Respondent”) Motion to Extend Expert Disclosures, Discovery, and Testimony Period (the “Motion”). Respondent has requested that all remaining dates, including the deadline for expert disclosures, close of discovery, and the parties’ respective trial periods be extended by sixty (60) days for both parties. Respondent contends that these dates should be extended because (1) the parties are engaged in a discovery dispute regarding Respondent’s objections and responses to Petitioner’s discovery requests and (2) Respondent’s attorney has been “involved in three contested Intellectual-Property-litigation matters that have required a substantial amount of his time over the last several months.” (Motion, TTABVUE 23, at ¶ 2.)

For the reasons detailed below and in Petitioner’s Motion to Extend Trial Dates (TTABVUE 21, 22), good cause exists to extend Petitioner’s deadlines for expert disclosures and the close of discovery, but not Respondent’s deadlines for expert disclosures and the close of discovery. Specifically, the delays resulting from the

discovery dispute between the parties have been caused entirely by Respondent, and Respondent's attorney's vague assertions about his involvement in other cases over the "last several months" does not explain how these matters have made it impossible to take any discovery over an eight-month discovery period. Accordingly, Petitioner respectfully requests that the Board deny the Motion in part, namely, Respondent's request to extend its expert disclosures and discovery deadlines.

**I. The Discovery Dispute Between the Parties Does Not Constitute Good Cause for Extending Respondent's Deadlines Because the Delays Have Been Caused Entirely by Respondent**

**a. The Parties' Discovery Dispute**

Pursuant to the Board's June 30, 2014 Order, discovery was originally set to close in this proceeding on February 4, 2015. (TTABVUE 16.) Within the first two months of discovery, on September 29, 2014, Petitioner served written discovery requests on Respondent, including interrogatories, document requests, and requests for admissions. (Declaration of Stephanie H. Bald in Support of Petitioner's Motion to Extend Trial Dates ("Bald Decl. 1") TTABVUE 22, at ¶ 2).<sup>1</sup>

Respondent served non-substantive "responses" and objections to Petitioner's written discovery requests on November 3, 2014. Specifically, in response to virtually every discovery request (including requests for admissions), Respondent indicated that it was "conducting a search and analysis for relevant information" and it "will serve a supplemental response as soon as possible." (Bald Decl. 1 TTABVUE 22, at ¶ 3, Ex. B.)

Notwithstanding its promise to serve supplemental responses "as soon as

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<sup>1</sup> Petitioner incorporates by reference Bald Decl. 1 in its entirety. Because Bald Decl. 1 is already of record at TTABVUE 22, Petitioner has not refiled it with this opposition brief. {405551;v1 }

possible,” nearly two months passed and Respondent had not served any supplemental responses. Accordingly, on December 29, 2014, Petitioner sent a detailed discovery deficiency letter to Respondent. Relying on relevant case-law authority, the letter outlined the deficiencies in Respondent’s discovery responses, including the lack of any substantive answers, Respondent’s numerous inappropriate objections, and its delay in serving the supplemental responses. The letter also identified numerous deficiencies in Respondent’s initial disclosures.<sup>2</sup> Petitioner requested that Respondent serve its supplemental initial disclosures by January 12, 2015 and that Respondent promptly advise Petitioner as to when it would be serving its supplemental written discovery responses. (Bald Decl. 1 TTABVUE 22, at ¶¶4, 5 Exs. C, D.)

On January 5, 2015, Petitioner filed a consented motion to extend the discovery and trial dates in this proceeding. (TTABVUE 18.) In the motion, Petitioner explained that the parties were “engaged in a discovery dispute relating to Respondent’s objections and responses to Petitioner’s written discovery requests and Respondent’s initial disclosures” and that additional time was needed to allow the parties to “continue their good faith efforts to resolve the discovery dispute.” (*Id.*) The Board subsequently granted the motion, entering the current discovery and trial schedule, which sets the expert disclosure deadline for both parties as March 6, 2015 and their discovery deadline as April 5, 2015. (TTABVUE 19.)

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<sup>2</sup> Respondent’s initial disclosures did not include even the most basic required information under Fed. R. Civ. P. 26(a)(1), including addresses and telephone numbers for the identified witnesses, the subject matter(s) about which each identified witness is likely to have discoverable information, and a description of all documents and things by category and their location.

On January 5, 2015, in exchanging correspondence regarding the consented motion for extension of time, Respondent's counsel indicated that he would get back to Petitioner's counsel on the outstanding discovery matters later that same day, but he never did. (Bald Decl. 1 TTABVUE 22, at ¶ 6, Ex. E.) Rather, another three weeks went by without Petitioner receiving any response to its December 29, 2014 deficiency letter or Respondent's supplemental initial disclosures (which Petitioner had requested by January 12, 2015). (Bald Decl. 1 TTABVUE 22, at ¶ 6.) Accordingly, on January 29, 2015, Petitioner sent Respondent a *second* deficiency email, noting that the January 12 deadline had passed and requesting that Respondent serve the supplemental initial disclosures "immediately." Petitioner also asked Respondent to confirm that it would serve supplemental responses to Petitioner's discovery requests and produce responsive documents by February 6, 2015. (Bald Decl. 1 TTABVUE 22, at ¶ 7, Ex. F.)

On February 5, 2015, Respondent sent Petitioner an email advising that it would serve its supplemental initial disclosures on February 6, 2015 and "follow up" with a proposed schedule for supplementing Respondent's discovery responses. (Bald Decl. 1 TTABVUE 22, at ¶ 8, Ex. G.) On February 6, 2015, counsel for Petitioner and Respondent held a teleconference in which Respondent's counsel again promised to serve the supplemental initial disclosures that same day, on February 6, or at the latest, February 9, 2015. During this call, counsel also discussed Respondent's proposal to extend all case deadlines by 60 days, including the March 6, 2015 expert disclosure deadline and the April 5, 2015 discovery close deadline. Petitioner's counsel indicated that Petitioner believed it was entitled to a further extension of those deadlines, but that Respondent was not entitled to an extension of its deadlines because Respondent had

caused all of the delays and had already been granted a 60-day extension of its deadlines. (Bald Decl. 1 TTABVUE 22, at ¶ 9.)

On February 9, 2015, Respondent did not serve its supplemental initial disclosures as promised. Nor did it provide the promised schedule for serving supplemental responses to Petitioner's discovery requests. (Bald Decl. 1 TTABVUE 22, at ¶ 10.) Accordingly, on February 10, 2015, Petitioner sent its *third* deficiency email to Respondent inquiring as to the status of the supplemental initial disclosures and schedule for serving supplemental discovery responses. Respondent's counsel responded that he would be in communication later that same day (February 9), but he yet again failed to contact Petitioner's counsel as promised. (Bald Decl. 1 TTABVUE 22, at ¶ 11, Ex. H.)

After waiting more than two weeks for a response, on February 25, 2015, Petitioner sent a *fourth* deficiency email to Respondent inquiring into the status of the supplemental initial disclosures, supplemental written discovery responses, and the document production. (Bald Decl. 1 TTABVUE 22, at ¶ 12, Ex. I.) On March 2, 2015, Respondent sent Petitioner a response promising to serve supplemental initial disclosures by March 6, 2015 and supplemental written discovery responses and documents by March 16, 2015. (Bald Decl. 1 TTABVUE 22, at ¶ 13, Ex. J.)

On March 6, 2015, Petitioner filed its Motion to Extend Trial Dates (TTABVUE 21, 22), seeking a 60-day extension of its expert disclosures and discovery close deadlines, but not Respondent's expert disclosures and discovery close deadlines. In that motion, Petitioner detailed Respondent's repeated delays and dilatory tactics during discovery. (TTABVUE 21, 22.) The same day, March 6, 2015, Respondent filed the subject Motion

seeking a 60-day extension of time of both parties' expert disclosures and discovery period deadlines.<sup>3</sup> (TTABVUE 23.) Among other things, Respondent indicated that it "intend[ed] to resolve the current discovery disputes with Petitioner over the next two weeks" (i.e., by March 20, 2015). (*Id.* at 2.)

Notwithstanding Petitioner's promises in its March 2, 2015 email to serve its supplemental initial disclosures by March 6, 2015 and supplemental written discovery responses and documents by March 16, 2015, Petitioner again failed to respond by those deadlines and still has not served its amended initial disclosures or discovery responses and documents. (Declaration of Stephanie H. Bald in Support of Petitioner's Opposition to Respondent's Motion to Extend Expert Disclosures, Discovery, and Testimony Period ("Bald Decl. 2"), at ¶ 2.) Moreover, notwithstanding its representations to the Board in the Motion that Respondent intended to resolve the discovery dispute by March 20, 2015, Petitioner has heard nothing from Respondent since it filed the Motion. (Bald Decl. 2, at ¶¶ 3, 4.) Accordingly, as of the date of filing this opposition brief, it has been almost *five months* since Respondent's discovery responses were due pursuant to the Federal Rules of Civil Procedure and Petitioner has yet to receive substantive written responses to its written discovery requests or any documents. Respondent has also failed to serve its supplemental initial disclosures, after Petitioner brought the deficiencies in these disclosures to Respondent's attention more than three months ago.

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<sup>3</sup> Petitioner notes that the Motion was not properly served by Respondent until March 9, 2015, such that this opposition brief is timely filed. The parties have not agreed to email service as a substitute for formal service under the rules in this case. (Bald Decl. 2 at ¶ 5.)

**b. Petitioner Has Established Good Cause for Extending Its Deadlines, But Respondent Is Not Entitled to Any Further Extensions**

For the reasons detailed in Petitioner's Motion to Extend Trial Dates (TTABVUE 21, 22), good cause exists for extending Petitioner's deadlines.<sup>4</sup> Respondent, however, has not established good cause for extending Respondent's expert disclosures and discovery deadlines. As discussed above, Respondent's expert disclosure and discovery deadlines were already extended 60 days in this case, despite the fact that all of the delays in discovery have been caused by Respondent. Additionally, Petitioner advised Respondent on February 6, 2015, nearly two months before the current April 5, 2015 close of discovery deadline, that Petitioner was not entitled to a further extension of the discovery period for Respondent. Nevertheless, to date, Respondent has not served any discovery in this case. (Bald Decl. 2, at ¶ 6.)

It is well settled that mere delay in initiating discovery does not constitute good cause for an extension of the discovery period. TMBP § 403.04; *see also Luehrmann v. Kwik Kipy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987). Thus, because Respondent failed to take any discovery during the past eight months, there is no basis for granting Respondent a further 60-day extension of the discovery period. This is especially true because Respondent had notice that Petitioner intended to oppose any further motion for extension of Respondent's discovery period as early as February 5, 2015, two months before the close of discovery. Respondent's alleged

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<sup>4</sup> Respondent has not contested that Petitioner has established good cause for an extension of its expert disclosures and discovery deadlines. Indeed, Respondent's Motion requests the extension of those deadlines for Petitioner and Respondent did not oppose Petitioner's Motion to Extend Trial Dates (TTABVUE 21, 22).

inability to complete discovery is clearly the result of Respondent's own lack of diligence, which does not constitute good cause for an extension.

## **II. Respondent's Counsel's Other Litigation Matters Do Not Establish Good Cause for Extending Respondent's Deadlines**

Respondent's counsel contends that Respondent is entitled to its requested extension because he personally has been "involved in three contested, Intellectual-Property-litigation matters that have required a substantial amount of his time over the last several months." (Motion, TTABVUE 23, at ¶ 2.) Respondent's counsel identifies these matters and provides vague assertions about the nature of his involvement in the cases in the Motion, but Respondent has not submitted a Declaration supporting those assertions. Respondent's counsel also indicates that he has recently "added staff to assist in connection with this cancellation proceeding." (Motion, TTABVUE 23, at ¶ 3.)

"A motion to extend must set forth with particularity the facts said to constitute good cause for the requested extension; mere conclusory allegations lacking in factual detail are not sufficient" and the Board will "scrutinize carefully" any motion to extend time, to determine whether the requisite good cause has been shown. TBMP § 509.01(a). Here, Respondent's counsel has failed to explain how specifically his litigation matters over the "last several months" have made it impossible for Respondent to take any discovery during the eight-month discovery period from August 8, 2014 to April 5, 2015 (which is two months longer than the traditional discovery period in TTAB cases). Even assuming Respondent's counsel could not

engage in discovery from January 1, 2015 through April 5, 2015,<sup>5</sup> Respondent's counsel has provided no explanation for why Respondent could not have engaged in discovery from August 8, 2014 through January 1, 2015—a period of more than four and a half months. Indeed, discovery was originally scheduled to close February 4, 2015, and the Board has made clear that parties should initiate discovery early in the discovery period for various reasons. TBMP § 403.05.

While the Board has found that the “press of litigation” may constitute good cause of an extension of time “in appropriate circumstances,” this is not one of those circumstances. See *Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducale SCRL (Esportazione Vinicola Toscana)*, 59 USPQ2d 1383, 1383-84 (TTAB 2001). In *Esportazione Vinicola Toscana*, the Board denied opposer's request for a 60-day extension of its testimony period, but granted opposer a 30-day extension because opposer's counsel was involved in a heavy volume of litigation during opposer's 30-day testimony period and the preceding month. Unlike an eight-month discovery period, which provides counsel and the parties a wide range of dates and flexibility within which to pursue discovery, a 30-day testimony period allows only a 30-day window for a party to submit all of its trial evidence and take all of its testimony depositions. On these facts alone, *Esportazione Vinicola Toscana* is highly distinguishable from the present case. Moreover, unlike Respondent, the opposer in *Esportazione Vinicola Toscana* had not engaged in a systematic effort to thwart its adversary's discovery efforts during the same time

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<sup>5</sup> Respondent reiterates that there is no basis for making this assumption in the record; merely citing a few pending litigations is not sufficient to show why Respondent's counsel (or someone else from Respondent's firm) could not have pursued discovery on behalf of Respondent during the time in question.

period in question.

The Board's decision in *Luemme Inc. v. D.B. Plus Inc.*, however, is relevant and persuasive precedent in this case. 53 USPQ2d 1758 (TTAB 1999). In *Luemme*, the Board held that the vague assertions about a party's inability to take discovery over an extended period of time are insufficient to constitute good cause for an extension of the discovery period. The petitioner in *Luemme* claimed that it had been unavailable to pursue discovery during the entire discovery period, but provided no details of the specific nature and dates of petitioner's other obligations, or how those other obligations prevented petitioner from engaging in discovery. *Id.* at 1759-60. The Board rejected the petitioner's unsubstantiated claims and denied the extension request, finding that "it is difficult to imagine that petitioner was unavailable during the entire discovery period between June 10, 1998 and December 8, 1998." 53 USPQ2d 1758, 1761 (TTAB 1999).

Here, like in *Luemme*, it is "difficult to imagine" how Respondent's counsel was unavailable to pursue any discovery for an eight-month period and, in any event, Respondent has not "set forth with particularity" any facts supporting his alleged unavailability. Moreover, it is telling that Respondent's counsel indicated in the Motion that he recently "added staff to assist in connection with this cancellation proceeding," but that it is now 3 ½ weeks later and Respondent still has not engaged in any discovery or followed through on its promises to serve its amended initial disclosures by March 6, 2015 and discovery responses and documents by March 16, 2015. The history of this dispute makes clear that Petitioner and the Board simply cannot rely on Respondent's representations, and that Respondent has no intent to defend this

cancellation.

Finally, Respondent's delay of more than *five months* in providing substantive responses to Petitioner's discovery requests and documents and Respondent's assorted delay tactics (including repeatedly promising Petitioner that it would provide responses by a certain date to prevent Petitioner from filing a motion to compel and then repeatedly breaking those promises) also weigh heavily against granting Respondent a 60-day extension of its discovery period. Granting Respondent's request would reward Respondent for its dilatory discovery practice and essentially give Respondent a "do over," putting Respondent in the same place as it would be if it had properly served discovery on Petitioner early in the discovery period (as Petitioner did in this case). See *Luehrmann*, 2 USPQ2d at 1305 ("To allow an extension for all purposes herein would be to reward petitioner for its delay in initiating discovery, a result which is to be discouraged."); see also *SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372, 1373 (TTAB 2001) (referencing earlier Board decision finding that opposers' involvement in other litigation was not good cause for granting an extension of discovery because, among other reasons, opposers' choice to neglect the Board matter in favor of others should not prejudice the applicant).

Thus, for the reasons stated above, Petitioner respectfully requests that the Board deny Respondent's Motion in part, namely, Respondent's request to extend its expert disclosures and discovery deadlines.

Respectfully Submitted,

Dated: March 30, 2015

/Stephanie H. Bald/

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**CERTIFICATE OF SERVICE**

I certify that a true and correct copy of the foregoing PETITIONER'S  
OPPOSITION TO RESPONDENT'S MOTION TO EXTEND EXPERT DISCLOSURES,  
DISCOVERY, AND TESTIMONY PERIOD was served by overnight courier on March  
30, 2015 upon Respondent's counsel of record at the address below:

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