UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

JK

Mailed: September 10, 2015

Cancellation No. 92058280

APU XK

v.

Tenggis Co., Ltd.

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of Respondent's May 9, 2015 motion to withdraw admissions pursuant to Fed. R. Civ. P. 36(b). The motion is fully briefed.[1]

As brief relevant background, on November 7, 2014, Petitioner served, by U.S. mail, its first set of requests for admissions.[2] Pursuant to Trademark Rules 2.120(a)(3) and 2.119(c), Respondent's responses to said requests would have been timely if served by December 12, 2014. Respondent relied on its own misunderstanding of applicable rules of procedure, elected to maintain that Petitioner's discovery was untimely served, and did not serve responses by

[1] Although the proofs of service included with Respondent's brief and reply brief are substantively compliant with applicable authorities, they are miscaptioned as "Certificate of Mailing." The Board directs Respondent's counsel to TBMP §§ 110.08 and 113.06 (2015), which explain the difference between a "Certificate of Service" and a "Certificate of Mailing."

[2] Respondent's statement in the preamble to its motion that Petitioner served this discovery on November 7, 2015 is presumed to be a typographical error.

December 12, 2014.[3] Respondent's erroneous objection was due to counsel's unawareness or lack of understanding of the fact that, because discovery may be served until the closing date of discovery, a responding party *may not object to discovery requests on the ground that responses would be due after the close of discovery*. *See* TBMP § 403.03 (2015) (emphasis added).

Pursuant to Fed. R. Civ. P. 36(a)(3), which is applicable to *inter partes* Board proceedings by operation of Trademark Rule 2.116(a), the matter in a request for admission is deemed admitted unless a written answer or objection addressed to the matter is served on the requesting party within thirty days after service of the request, or within such time to which the parties stipulate.[4] *See also* TBMP § 525 (2015), and cases cited therein. The request(s) will stand conclusively established by operation of law unless the non-responding party is able to show that its failure to timely respond was the result of excusable neglect, or unless a motion to withdraw the admissions is filed pursuant to Fed. R. Civ. P. 36(b) and granted by the Board. *See* TBMP § 407.03(a) (2015), and cases cited therein.

Upon motion under Fed. R. Civ. P. 36(b), the Board may permit withdrawal or amendment of an admission if 1) it would promote the presentation of the merits of the proceeding, and 2) the Board is not persuaded that allowing withdrawal

---

[3] If the Board were to apply Respondent's position that Petitioner served the first requests for admission on November 14, 2014, Respondent's responses still were not timely.

[4] Respondent's position that Petitioner's counsel flatly refused to accept the untimely responses that Respondent served is inapposite. The characterization that this motion was necessitated by Petitioner's refusal to stipulate to the withdrawal of the admissions is also inapposite. To be clear, Petitioner's first set of requests for admission were deemed admitted by operation of Fed. R. Civ. P. 36(a)(3).

and amendment would prejudice the requesting (propounding) party in maintaining or defending the action on the merits. *See* TBMP § 525 (2015).

Inasmuch as Respondent failed to serve responses to Petitioner's first set of requests for admissions by the due date therefor, said requests are deemed admitted. Respondent now moves, under Red. R. Civ. P. 36(b), for an order permitting it to withdraw the matters deemed admitted and to amend its admissions (brief on motion, p. 2).

For efficiency in determining the merits of Respondent's motion, the Board does not restate herein all arguments made by both parties. In brief summary, Respondent's counsel acknowledges that he made an error in objecting on the basis that Petitioner's first requests for admission had been "served too late," and in not serving timely responses. After having been contacted by Petitioner's counsel, Respondent served late responses to the requests for admissions on December 22, 2014 (Gordon decl., para. 7, exh. 7).

For Petitioner's part, Petitioner's counsel states, *inter alia*, that he had to clarify and explain applicable rules governing discovery to Respondent's counsel (*e.g.* on November 19, 2014), and that Respondent's counsel ignored this explanation and lodged a frivolous objection under the erroneous belief that Petitioner's discovery requests had been untimely served.

Regarding the first factor to be considered under Fed. R. Civ. P. 36(b), emphasized throughout the Federal Rules of Civil Procedure is the importance of resolving actions on the merits whenever possible. *See Johnston Pump/General*

Valve Inc. v. Chromalloy American Corp., 13 USPQ2d 1719, 1720 (TTAB 1989). The Board has adopted the perspective that, "[T]he decision to allow a party to withdraw its admission is quintessentially an equitable one, balancing the rights to a full trial on the merits, including the presentation of all relevant evidence, with the necessity of justified reliance by parties on pre-trial procedures and finality as to issues deemed no longer in dispute." *See Giersch v. Scripps Networks Inc.,* 85 USPQ2d 1306, 1308 (TTAB 2007) (citation omitted).

Here, Petitioner's first set of requests for admission are largely directed to issues of fact regarding Respondent's use or nonuse of its asserted mark in commerce. Allowing Respondent's admissions to stand would have a preclusive effect on the presentation of evidence and arguments on these issues of fact, which are relevant and central to Petitioner's claims. In view of this, allowing Respondent to enter its responses to Petitioner's first set of requests for admission would promote the presentation to the Board of the merits of this proceeding.

Turning to the second factor, the timing of a motion to withdraw or amend plays a significant role in the determination of whether the propounding party will be prejudiced by withdrawal or amendment. *See Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (motion to withdraw admissions granted when propounding party's testimony period had not yet opened); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 (TTAB 1989) (motion to withdraw admissions

granted when case was still in pretrial stage). The Board finds that Respondent did not unreasonably delay in filing its motion to withdraw admissions.

The Board also considers whether and to what extent withdrawal of the admissions would bring prejudice or difficulty to Petitioner in obtaining evidence and preparing its case. Petitioner's arguments, as well as the record itself, clearly reflect counsel's frustration in seeking to obtain timely information from Respondent, and in needing to educate and inform Respondent's counsel (*e.g.*, by way of a December 19, 2014 letter) of basic rules of Board procedure that govern timeliness and response deadlines for discovery. The record clearly reflects Respondent's unawareness of and/or misapprehension of applicable rules of procedure, and its consequential failure to take action in accordance with said rules. Nonetheless, Petitioner does not point to any particular manner in which it has been rendered unable to, or will now have difficulty in, continuing with discovery and preparing its case. Petitioner has subsequently served two additional sets of requests for admissions in an effort to meet its discovery needs and to advance this proceeding. Moreover, the record does not reflect that Petitioner proceeded to prepare its case for trial in reliance on the deemed admissions. Although the Board finds merit in Petitioner's position that it "is little closer to establishing the truth" (brief on motion, p. 11), allowing Respondent to serve responses may provide Petitioner with substantive information to which it has long been entitled.[5] In view of these circumstances,

---

[5] Notwithstanding the Board's ruling herein, in the event that Respondent's misapprehension of, misapplication of, or disregard for applicable Board rules or

the Board finds that allowing Respondent to enter its responses to Petitioner's first set of requests for admission would not prejudice Petitioner in maintaining and presenting this cancellation action on the merits.

In view of these findings, Respondent's motion to withdraw its deemed admissions to Petitioner's first set of requests for admissions is granted. Said admissions are withdrawn, and Respondent's untimely responses to Petitioner's first set of requests for admissions, served December 22, 2014, are entered as its responses thereto.

Other discovery issues

The Board notes Petitioner's request that the Board extend discovery and trial dates by three months to permit ongoing discovery. The request is granted for good cause shown, and is reflected in the reset schedule set forth below.[6] *See* TBMP § 509.01(a) (2015).

The Board further notes Petitioner's statements that it anticipates filing a motion to compel directed to its second and third sets of discovery requests. In the interest of avoiding further discovery-related impasses and potential additional delays to this proceeding, the Board allows Respondent until thirty days from the mailing date of this order to serve responses to Petitioner's third

---

procedure are relevant to the merits of any future motion, the Board will, as appropriate, weigh this as part of the totality of the record.

[6] Respondent's conditional willingness to stipulate to the extension of discovery "only if the Board determines that there is a substantial quantum of prejudice to Petitioner by granting the prayer for withdrawal of subject admissions" (Respondent's reply brief, p. 11) is misplaced and disingenuous. Respondent cites no authority for the request. More to the point, applicable authorities do not place on Petitioner an obligation to support its request for an extension in the manner stated by Respondent. *See* TBMP § 509.01(a) (2015).

set of requests for admission; said discovery was served April 17, 2015, which was fewer than thirty days before Respondent filed its motion to withdraw admissions directed to Petitioner's first set.[7]

For completeness, and in the event that Respondent's counsel is unaware, the parties in Board proceedings have a *continuing duty*, pursuant to Fed. R. Civ. P. 26(e)(1) and (2), to supplement discovery responses. A party that has responded to a request is under a *duty to supplement or correct the response in a timely* manner to include information under the particular circumstances specified in Fed. R. Civ. P. 26(e)(1) and (2). On this point Respondent's counsel is directed to TBMP § 408.03 (2015).

Schedule

Proceedings are resumed. Discovery and trial dates are reset as follows:

Expert Disclosures Due	**11/14/2015**
Discovery Closes	**12/14/2015**
Plaintiff's Pretrial Disclosures Due	**1/28/2016**
Plaintiff's 30-day Trial Period Ends	**3/13/2016**
Defendant's Pretrial Disclosures Due	**3/28/2016**
Defendant's 30-day Trial Period Ends	**5/12/2016**
Plaintiff's Rebuttal Disclosures Due	**5/27/2016**
Plaintiff's 15-day Rebuttal Period Ends	**6/26/2016**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall

[7] To be clear, this is not an order compelling discovery, but rather an effort to possibly avoid future discovery-related motions, and to impress upon Respondent the need to now be fully attentive to substantively meeting its discovery obligations.

be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.